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Patent Office papers



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# Observations Pertaining to Examiners' Duties and Their Actions

Special Reference to Rules 62 and 63

A paper read March 22, 1915, before the *Examiners' Corps of the United States Patent Office*.

JAMES H. COLWELL,  
Principal Examiner, Division of Inventions,  
U. S. Patent Office.

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WASHINGTON, D. C.  
1915

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# Observations Pertaining to Examiners' Duties and Their Actions with Particular Reference to Rules 65 and 66.

By

J. H. COLWELL,

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The foundation of the present patent laws is the examination system, and the results that have been achieved are in large part due to that system.

The commercial and practical value of an invention, not infrequently hinges, and is dependent upon the careful preparation of the application papers, and the skilled prosecution of the case by the applicant, or his attorney on the one hand; but, on the other by an exhaustive and thorough search of the accessible art by the Patent Office. The first is beyond direct office control; the law, however, not only imposes upon the examining corps, in each individual case, the duty of exhausting every means at its disposal to protect the public, and give real value to a patent, by placing on the record the known art at its command; but also when an Examiner, by his experience and knowledge of the art, sees the real merits and novelty of the invention, it is due to an applicant to make any proper and legitimate suggestions that will expedite the prosecution of the case, and will aid him in securing adequate protection. A strict adherence to the requirements of the Rules of Practice by the examining corps in the examination of cases, would, to a large extent, lessen and alleviate the many evils and troubles which are multiplied by lack of proper office facilities, and insufficient force, while, at the same time, it would greatly aid an inventor who is honestly desirous of securing a patent for a practical and meritorious invention.



Compliance with Rule 68 on the part of the applicant, or his attorney, in the majority of cases, if honestly attempted, would tend to the rapid disposal of cases without unnecessarily burdening the record. Yet, the fact that by reason of ignorance, or deliberate purpose, a few applicants, or their agents, will take advantage of every technicality which the liberal patent laws allow to delay the prosecution, by confusing the record, and befuddling, and worrying the Examiner by all manner of irrelevant, and immaterial amendments and objections, should not influence the Examiner to adopt the graver, and even more fatal and reprehensible error of non-compliance with what the law requires of him irrespective of any annoyances, and obstructive tactics he may be subjected to. With this class of cases, the Examiner being only human, is frequently tempted to come back in like tenor, and thus involve himself in endless argument and controversy, which in no way leads to a quick disposal of the case, but merely overloads the record with foreign matter. The adoption of this course, and we are all at times liable to it, is the narrow and prejudiced road to take, resulting only in the long run in loss of patience, and the prolongation of the prosecution, with the ultimate consequence of imposing on the Examiner unnecessary labor and loss of time.

Neglecting entirely the question, whether an applicant, or his attorney, does, or does not comply strictly with the requirements of the rules, ignorantly or otherwise, it is an Examiner's duty, as well as the easier way in getting results, to follow the rules fully. By so doing, the total number of actions will be correspondingly reduced.

From experience in six or seven divisions in dealing with very differing arts, I am convinced that no one, whether an Examiner or not, is competent to express a correct ex parte opinion on a claim related to an art with which he is unfamiliar. Claims which apparently amount to nothing, and the subject-matter thereof obvious, have an entirely different significance to one conversant with the difficulties to be met and overcome to attain a much desired result sought in the art to which the device relates.

The question of patentability, when it comes before the court is entirely different from the question presented before the Principal Examiner, or the Examiners-in-Chief in a case pending in the office.

In an infringement suit the court has the benefit of testimony, as to the commercial and practical advantage and value of the device involved, based on the adoption and use of it, and the case is presented before the court fully and in detail, and from all angles by skilled lawyers, and practical and theoretical experts in the art on both sides of the issue. Thus the court is able to judge intelligently, for example, whether or not a patentee with a mere paper patent for an undemonstrated, and apparently practically worthless machine is endeavoring to stifle the efforts of real and meritorious inventors and exploiters.

In answering an appeal, the Examiner does, or should cite the best art at his command, and should clearly set forth his reasons. In doing this, he can not possibly foresee, in many cases, what line of argument an applicant may take. On no few occasions it has been found that details, elements, and structural features, all of which are more or less of common knowledge in a particular art, and for that reason have never been discussed, except inferentially, in the prosecution of the case, are seized upon by counsel for applicant in his brief and argument, which would be immaterial if the Board were conversant with what is old and common in the art. The members of the Board obviously can not be familiar with, or have the knowledge of the real difficulties to be overcome, nor discriminate between what is vital, and what is merely superficial, in the numerous arts, classified in forty-three different divisions of the Patent Office. The Examiner, fortified with the individual knowledge and experience of his assistants, is better able to pass upon questions of patentability. At least, he should be better able, if he is entitled to be in charge of the work entrusted to him.

For this reason I am convinced, and, although I may be treading on delicate grounds, I am strongly of the opinion that the Examiners-in-Chief should be extremely careful, when affirming a rejection of the Primary

Examiner, in suggesting a claim-as patentable without familiarizing themselves in some way with what may be a matter of common knowledge, and therefore immaterial so far as real and actual novelty is concerned.

In the treatment of an application, and as governing the Examiner's action, the most important and far-reaching rules in influencing the expeditious disposal of the case, are Rules 65 and 66.

Rule 65 provides:

"Whenever, on examination, any claim of an application is rejected for any reason whatever, the applicant will be notified thereof. The reasons for such rejection will be fully and precisely stated, and such information and references will be given as may be useful in aiding the applicant to judge of the propriety of prosecuting his application or of altering his specification; and if, after receiving such notice, he shall persist in his claim, with or without altering his specification, the application will be reexamined. If upon reexamination the claim shall be again rejected, the reasons therefor will be fully and precisely stated."

Rule 66 provides:

"Upon the rejection of an application for want of novelty, the Examiner must cite the best references at his command. When the reference shows or describes invention other than that claimed by the applicant, the particular part relied on will be designated as nearly as practicable. The pertinence of the reference, if not obvious, must be clearly explained and the anticipated claim specified," etc.

A departure from these rules in the early Office actions is often the source of numerous future troubles, and it is not going too far to state that fully 10 to 20 per cent of useless labor is due to this cause.

The importance of these rules should be one of the first things to be impressed on a newly appointed as-

sistant examiner. It would be greatly to the ultimate benefit, and welfare of the Patent Office, if some uniform scheme, or system could be devised, and adopted for imparting elementary instruction in the rudiments of office organization, and procedure, on his first entering the examining corps.

When a new assistant, and we have all been there, is assigned to a division, it should be remembered, and it is natural, that he is almost sure to have certain preconceived ideas, and opinions of invention and patents, which are erroneous, both as to law and fact. Some are in time overcome, others never completely, and it may be seriously doubted whether with any of us, the personal equation is ever entirely obliterated, however we may think so.

The almost universal practice in the various divisions, of putting a new assistant on examining work immediately, or within a week, before he has gotten his bearings, and when he does not yet recognize the distinction between a pending application, and a patent, or that between an interference proceeding in the Office, and an infringement suit in the courts, is obviously wrong. It is unfair to the assistant, and to the Office itself. A plan more effectual, expeditious, and satisfactory, so far as the real advancement of the work is concerned, would be to assign him to the clerk's desk, for at least six weeks, to assist in entering amendments, and the many duties daily attending that desk, in order to familiarize him with the rules applicable thereto, and the various clerical divisions of the Office, their jurisdiction, functions, and interconnecting relations, and at the same time to enable him to gain a working knowledge of the filing of the various papers in an examining division, as well as a general idea of the system of classification as practically demonstrated by the classes, and subclasses in his division, with which he will have to deal later on. With such a preliminary training, it is obvious that a new assistant could much more readily and intelligently take up examining work, than if he started in entirely in the dark and in complete ignorance of his duties, and of the Office procedure. The present general custom obviously must have a ten-

dency to create and implant in the mind erroneous ideas and impressions, which once adopted, it will be found extremely difficult, if not impossible, to eradicate.

A new assistant may be apt, bright, intelligent, and possibly brilliant; but before he recognizes clearly the distinction between abandonment, combination, division, forfeiture, renewal, revival, etc., he, not infrequently with the idea that it is a little above the dignity of his position to familiarize himself too intimately with the clerical and general Office work, proceeds to begin at the top and wrong end of the line, by diligently applying himself entirely to complex court decisions, hinging upon specific features and intricate points of law, with the result, that without necessary experience and elementary knowledge of patent law, he forms wrong impressions, and becomes imbued with the idea that orders, amendments, and purely Office matters are unimportant in themselves, and will be attended to by someone else. In this connection, I am firmly of the belief and opinion (and I do not think the statement is open to contradiction) that the value of the services of a competent and experienced examiner's clerk, if she, or he is up to the work of the desk, and has intelligent discrimination and judgment, can not be overestimated, and is most difficult to replace satisfactorily.

The first thing the average assistant can be relied upon to learn is how to dispose of a case by some short and expeditious route, without involving the apparent loss of time, which an exhaustive search of the art in the first instance necessarily involves. With this view, he takes up successively the question of getting the case transferred to another division, requiring division or rejection on the grounds of aggregation and lack of invention. The non-success of all these methods finally results in making necessary an examination of the art.

In rejecting a claim on the ground of aggregation, it is an easy matter to arm; and equip oneself with a vast array of decisions and authorities, that aggregations are not patentable, losing sight of the real question, whether, in a particular case before him, the claim is an aggregation, or a proper combination, though perhaps involving a mere substitution of one well-known equivalent for another.

Not infrequently, when a specification with the drawings are badly prepared, and confused, with claims extremely broad, vague and indefinite, the temptation is strong for an Examiner to make a general action, stating that the application is informal, unintelligible, and objectionable throughout, and thereupon to select one or two references which meet in terms the claims, and reject them. Such an action obviously does not in the slightest degree tend to advance the prosecution, but merely delays it. Many times, in cases of this kind, an Examiner through his knowledge of the art, but at the expense of some patience and a little time, can, by a careful reading of the specification in connection with the drawing, gain a complete understanding of the general features of the invention, and what it is intended to accomplish, and thereby be able to point out the particular part on which further information is necessary. At the same time he may intelligently search the nearest art, and consequently be able to reject the claims on the best references in the first action.

If a hasty action is made, the case, sometimes at the end of the year limit, comes back amended, not in the details as to which information is really needed, or with properly drawn claims, with the result that it will have to be examined precisely as if it were newly filed. New references will have to be cited, and another action made of record. So the prosecution is dragged, and continued, with the consequent delays, and possible interferences, until it is allowed or finally rejected; when the same result could have been attained with half the correspondence, if the first action had been as complete and thorough as possible.

When a specification is badly written, vague, and so indefinite as to make it impossible to act intelligently on the claims, it should not be objected to in its entirety, but the particular parts, and the operations thereof, on which further information is desired, and necessary, should be distinctly pointed out, thereby enabling an applicant to amend intelligently, and responsively, to the Office requirement. Sometimes, when this is not done, the applicant, or his attorney, intentionally or ignorantly, will make long amendments, with explana-

tions of features, which are perfectly obvious to the Examiner, while maintaining strict silence on the real and vital portions.

In each Office letter, every claim should be designated by number as allowable or rejected, and each reference should be cited by number as well as name, together with the class. A general rejection should not be made, such as stating that the claims are rejected on the references of record, or Smith and Jones of record. A great many future difficulties would be avoided if the words "of record," when used unqualifiedly in the rejection of claims, could be obliterated from the Patent Office vocabulary. On one occasion within the personal knowledge of the Examiner, an appealed case, which had been inherited from another division, and had never been acted upon in the new division, came up for action. The case originally contained a great number of claims, and had been amended many times, with the result of many changes in the numbering of old claims. On starting to answer the appeal, it was found that the claims were rejected on the references of record. On going back over the Office letters in an endeavor to find what references applied to certain claims, the same statement occurred throughout, with additional references added from time to time, and there were about fifty cited. After spending the greater part of a day in trying to find out what were the particular references, or combinations thereof, relied upon to anticipate the claims finally rejected, the attempt was given up in despair, and the applicant was informed that the appeal was premature. The claims were then rejected individually, the references applied, and the applicant informed why the references anticipated the claims. In the next action, the rejected claims were canceled and the case passed to issue.

Frequently a number of rejections are made on references which apparently meet the claims in terms, the applicant denying the pertinency of the references, or perhaps slightly amending, and the Examiner reiterating his rejection until finally the Examiner finds, by carefully reading the references and fully understanding them, that he was in error in rejecting some of them, and the

case is disposed of either by the Examiner withdrawing the references, or the applicant canceling the rejected claims, which could have been done previously with far less actions, if a little time had been devoted to the study of references before the first action.

Consideration of rejection on the ground of lack of invention, brings up the constantly recurring question of what is invention? After reading numerous court decisions based on specific cases, many of which have been quoted in previous lectures, and after searching the various authorities on patent law for a clear definition of this simple ground of rejection, I am forced to come to the conclusion that no definition exists and none ever *will* be formulated which will be an infallible guide in determining the question in each specific instance in any one of the numerous arts; and the same is true of aggregation.

If any one will discover, and give an accurate definition to guide the Patent Office in determining absolutely, and infallibly, by thumb rule, what this nebulous thing, invention is, its labors will be greatly reduced.

There are many authorities and decisions to the effect that a mere change of configuration, shape, or dimensions, is not patentable. While broadly this is true in the majority of cases, yet, if it were literally adopted, as an axiom, many inventors would be denied the protection which the patent laws are designed to afford for devices which may be of inestimable practical value and worth. Admittedly, it is obvious, and indisputable, that a mere change of form, or dimension in a structural feature which acts in the same manner, and produces the same result as in prior devices, without any new function, or unforeseen effect, is not patentable, and in fact, amounts to no more than the substitution of an equivalent.

Possibly it may not be a waste of time, and may be to a slight degree interesting to a few to refer in a general way to several patents illustrating the development of an art in which the question of invention hinged upon form, dimension, and apparent aggregation. If the rule held in all cases, that such changes do not involve patentability, many most valuable improvements in the



class of projectiles would never have been patented. Previous to 1905, it was apparently settled that a small arm projectile with a modern rifle, to have long flight, and penetration, must be pointed, but it was the opinion of experts that a short pointed head was a requisite. In other words, the pointed portion must be one-fourth or less, of the total length, because a long point would affect, and interfere with the ballistic qualities and spin, or rotation, causing the bullet to wobble, or tumble in flight, and thus destroy its accuracy.

With the object of increasing the range and penetration, Arthur Gleinich, a German engineer, applied for a patent for a bullet designed for use in small arms at high pressures and great velocities. Photographs of projectiles in flight at different velocities indicated the pointed nose as productive of the most desirable form of head wave for projectiles at high velocities, but it was apparent that any conclusion based thereon must be qualified by other requirements and conditions present as to flight, range, penetration and stopping effect, and these could only be satisfied by a proper construction of body, dimensions, distribution of mass, and form of body and head. Gleinich's experiments led him to the conclusion that a much longer pointed head than the one universally in use was necessary, and that the form for velocities in excess of 500 metres per second was one in which the head constituted about one half the total length. His bullet, in the language of claim 3 of his patent, is described as follows:

"A projectile having a pointed head of substantially one-half the total length of the projectile, curved upon a radius of four to nine fold the caliber."

In the early prosecution of the case, the Examiner failed to see any invention. He held that the device involved a mere change of form in the then existing bullet in common use. But after the filing of affidavits, voluminously setting forth in tabulated form the result attained in actual experiments with bullets, and showing the almost phenomenal increase in efficiency, as to range and penetration, amounting to from 15 to 25 per cent over that of the old form when used under similar

conditions, with the same explosive charge and type of fire arm, the Examiner reconsidered his action and patent 841,861, was granted January 12, 1907. Gleinich's contention and the practical value of his bullet were abundantly proved by its adoption by every civilized government and its use almost exclusively for big game hunting.

Of two engaged forces armed with the same rifle, one using the Gleinich bullet, and the other the old bullet, the former would be able to do effective execution at distances which would be beyond the range of the latter, who for all practical work, might just as well be armed at such ranges with spears or wooden guns.

Another device which has been equally far reaching in results, and in which the inventor's claim and contentions have been fully sustained by its universal adoption, is the projectile covered by patent No. 541,280, granted June 18, 1895, to E. M. Johnson of New York, on an application filed March 30, 1894, for an armor piercing projectile with a detachable soft nose cap. Johnson, in common with all ordnance experts, knew that the best form for an armor piercing projectile for flight and penetration was the conoidal pointed projectile in common use. But he found by experimenting and examining projectiles after firing, that as the hard point of a projectile strikes the surface of modern surface hardened armor, the point of the projectile becomes "upset" by the blow at the moment of impact, and thus loses the power of penetrating the softer metal underlying the hardened exterior. Reaching this conclusion, Johnson reasoned that if this upsetting of the hard point at the moment of impact with the hard surface of the armor plate could be avoided, and the shape of the point sustained and kept intact while piercing the hardened surface, then the projectile would penetrate the underlying softer metal and completely pierce the plate, so that if it were of explosive character it would have reached the point where it would do the most effectual damage prior to bursting or explosion.

Johnson's invention consisted in the simple expedient of enclosing the pointed end of the projectile in a soft metal, blunt, and solid ended nose cap. This at first sight appeared to experts to be fallacious and an apparent paradox. Its effect apparently would be to negative the

advantages of the pointed head in decreasing wind resistance, and seriously to interfere with the flight and trajectory, as it would undoubtedly be productive of an undesirable head wave; the very objection that the adoption of the conoidal head was intended to obviate. The Patent Office at first took this ground and rejected the claims for that reason, in connection with the art as it then existed. Johnson, however, by affidavits, supported with experiments, and notwithstanding the admitted objections, established the fact to the Examiner's satisfaction, that the employment of the blunt soft-nosed projectile secured a great increase in penetration over the non-capped projectile when fired under exactly similar conditions.

Having secured the best form for flight, and with a soft blunt nosed cap, getting the best penetration, the next thing to do was to combine both these features without counteracting the good qualities of either. To accomplish this result, Cleland Davis designed a hollow projectile contour cap, and filed an application April 21, 1908, resulting in patent 954492, granted January 4, 1910. His invention is described in the following language:

"It is now well known that there is a certain contour, or taper, which when given to the exterior of projectiles, causes them to meet with a minimum resistance from the air; and it is equally well known that this particular contour, or taper is not the best adapted for armor piercing qualities. In other words, if a projectile is given the best shape for piercing armor, it will not meet with a minimum air resistance during flight and if it is given the best shape for cleaving the air, it will not possess its best armor piercing qualities.

"My invention accordingly consists in providing a standard armor piercing or other projectile with a contour cap, which will during flight, give the projectile as a whole that contour best adapted for penetrating the air, and which upon impact is destroyed, thereby leaving the projectile with its best armor piercing contour unimpaired."

When Davis entered the field every element was separately, and in part combination, old. During the *ex parte* prosecution of the case, which was most diligently and persistently carried on by the applicant, the Examiner being impressed with the marked results attained, allowed claims for the three features in combination, and for the specific form of hollow contour cap per se. The Davis application, during its pendency in the Patent Office became involved in interference with a copending application which resulted in priority being awarded to Davis. The losing party acquired the rights of the Davis application, and subsequently to the grant of the patent, a rival company of the assignee was awarded a contract for furnishing several hundred thousand projectiles, the construction of which admittedly infringed the Davis patent. A suit was brought against the infringing company, decided September 10, 1914, in *Firth Sterling Steel Co. vs. Bethlehem Steel Co.*, 216 Fed., Rep., 753.

It is not thought inappropriate, and it may be instructive to quote a few extracts from this decision, as illustrating the court's line of reasoning, and the stand taken in sustaining a patent for a construction seemingly obvious to the average person unacquainted with the difficulties to be overcome, when the patent was attacked on the old ground of aggregation and lack of invention. The court stated:

"The type of projectile involved in the present discussion is the armor piercing projectile. If the doctrine that preparedness for war is a preservative of peace holds good, the inventive genius of the nation should be given every stimulus to apply itself in the direction here indicated. The history of the development of the art is in itself not uninteresting and throws light upon the points in controversy.

"The contest between armor piercing projectile producers and armor plate manufacturers is an approach to the old one between resistless force and immobility. The advance made by the armor plate makers made the task of the projectile designer include the achieving of two necessary results. The projectile must both reach the plate and pierce it. It must reach it to pierce it, and

must therefore have the property of long flight. It must pierce it when reached, and must therefore be given the greatest possible power of penetration. The property of prolonged flight was early found in contour of form, and could be reproduced at will. To overcome the tendency of the sharp point to upset or break, and thereby secure the greatest penetration, the Johnson soft nose cap, or jacketing the point was adopted. Thus to recapitulate, we had the contour of shape for length of flight known. We also had the property of fullest penetration secured. We had, however, no practical combined result, because the use of one of these known things was either to prevent or render futile the use of the other. No effective shot could as yet be fired, because if the flight contour was given the projectile, it would reach the mark, but would not do its work when there, and, if the penetrating device was employed, it could not do its appointed task because it would not reach its mark. The flight contour and penetrating form, although alike essential and required to be both potentially existing in the projectile when inserted in the gun, did not function simultaneously but successively. The one began where the other ended. If, therefore, a temporary flight form could be given the surface contour of the projectile which would inhere until the mark was reached, and would then be automatically discarded to make way for penetration form, the problem would be solved. There were two seemingly obvious means of its accomplishment. The one was to give to the enveloping metal which made penetration effective the form contour, which lengthened the flight. The other was to supply contour flight form by means of a hollow enveloping cap or casing which would be destroyed on impact. The seemingly obvious, however, is seldom true. Devices to accomplish the required result were tried, and the problem remained still unsolved. The solution was finally found which embodies the claims of the patent in suit. That it was at once attended with commercial suc

cess is undoubted. The failure of the solid form of point encasing metal was avoided by abandoning its use. The cap which failed was one which inclosed the naked point of the projectile proper. Its failure was escaped by the simple expedient of retaining the soft metal nose feature within an enveloping shell or cap having the required flight contour. The design had inventive merit. Its merit is in a happy combination which produced the required result.

"To deny to the Davis design, the merit of combination, as defendant's argument essays to do, is to refuse to follow the very definition of patentable combination. Most of the elements, indeed it may be said all the elements, except the idea of the combination itself, may be said to be old. Herein, however, lies the novelty, as well as the utility, and the consequent merit of what was accomplished. The aggregated elements were contour of flight, penetrating shape, supporting nose cap. Merely putting together these old elements produces at most the aggregated functions of them all. Bringing them into the contact of a mere aggregation may indeed destroy the operation of some of the elements considered separately, but the aggregated results can be no more than the sum of all. Its full product is a mathematical addition. A true combination produces a new and different, at least in the sense of an additional, result. The Davis device uses these old elements in a novel combination, not only were these elements, taken separately, old, but the idea of the combination was itself old. The failure of each of these attempted combinations consisted in the loss of function which the elements separately had. The flight function was retained, the ballistic quality was lost. The solid pointed soft nose doubtless failed because the mass of metal in front of the point destroyed its supporting function by crowding the metal which supported the point. The thought which saved the day was the simple one of combining with the other elements, not the hollow-nosed cap with the naked point of the projectile proper

but with the nose as well as the point. It is the simplicity of the combination which makes it look like mere aggregation. The Army and Navy experts had applied themselves to the task of doing just what Davis has done and failed. The prior art disclosed a cavity cap, into which the naked point of the projectile penetrated. It was able to show a projectile proper, in which the point was behind and surrounded with soft metal. It possessed no projectile as a whole in which there was interposed soft metal between the point and the cavity. In consequence, the Examiner allowed claims for the last and disallowed those for the first. He also disallowed claims for devices in which the soft metal was around, but not in front of, the point."

The Commissioner recently remarked that there were many persons, lawyers as well as laymen, who, while admitting the past usefulness of the patent system and its influence in the wonderful development of labor saving devices, and its consequent phenomenal effect on the country's industries, yet are sincere in their opinion that the present day conditions demand the substitution of a registration system. It, therefore, behooves every believer in the examination system, and especially those in this Office, conscientiously and impartially to carry out the duties imposed on them by law, and give every possible and legitimate aid to an inventor. If the time ever arrives in the future, when the general public, rightly or wrongly, views with suspicion the system, and believes that the Patent Office is antiquated, does not meet present conditions, that the examination is superficial, and that the grant of a patent is merely nominal, amounting to "a mere scrap of paper," then Congress, which is entrusted with enacting legislation for the public welfare, will seriously consider the question of abolishing the examination system. It will then be too late for the friends of this Office, by argument and reasoning, however well founded or based, on what the system has done for the public as well as individuals, to stay the tide of public opposition.

March 25, 1915.

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# The Development of Fundamental Principles Involved in the Patent System and Their Relation to the Examination of Applications for Letters Patent.

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A paper read September 28, 1916, before the Examiners  
Corps of the United States Patent Office

JAMES F. LIGHTFOOT,

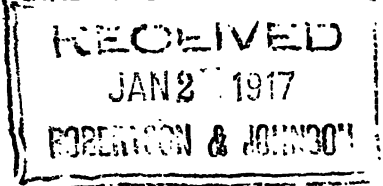
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WASHINGTON,  
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# The Development of Fundamental Principles Involved in the Patent System and Their Relation to the Examination of Applications for Letters Patent.

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## INTRODUCTION.

This paper is of a general elementary character, intended to be at least suggestive of a field of study which, because of its elementary character, may have been to some extent neglected and it contains reference to fundamental principles involved in the establishment of the patent system and in the grant and refusal of letters patent and some consideration of statutory provisions relating to the examination of patent applications which, it is thought, are in accord with elementary principles and fundamental law.

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In this the most remarkable of all industrial ages men are studying and seeking as never before to find fundamental truths in all departments of human knowledge and effort. Men well know that the deeper and the more profound the ascertained fundamental facts and principles upon which human knowledge is based, the higher will be the character and substance of the structure and system of human attainment based thereon.

In the more limited field of law and jurisprudence, there are clear indications that men of profound thought upon the bench and in the profession of the law, are of the opinion that existing law and procedure should be revised and simplified so that legal fiction and technicality may not stand in the way to prevent the rendition of

decisions that accord with fundamental truth and simple justice.

And in a very special way the investigation of fundamental truths involved in the development of industrial progress, if applied in the work which we as judicial officers of the government are called upon to do, should, in some measure at least, result in a fairer view of the matters of substance which must be considered in determining whether products of man's creative genius shall or shall not be published to the world as patented inventions.

Moreover, it is believed that the work of examining applications for patents should be vitalized and made of more lively and absorbing interest to the examiner, and it is submitted that the thorough study of fundamental principles and the full and deliberate application of them to the examination of alleged inventions, may to some extent at least, assist in attaining this much desired end.

It is believed that before an examiner can appreciate the full importance and true significance of the judicial and technical work that he has to do, he should be thoroughly familiar with all fundamental principles involved in the grant or refusal of letters patent for inventions.

He should know whether patents are in fact monopolistic or not monopolies in restraint of trade; he should know of the educational character of the grant and its bearing upon the question of patentability; he should know of the contractual character of the grant and how it is involved in the proper attitude and point of view of the examiner in considering cases before him; he should know the true meaning of the constitutional provision upon which our patent system is based and its true relation to the character of the grant that should be issued; he should know the real meaning of the statutes, and he should know that existing statutes are absolute controlling factors in determining the practices involved in the examination of patent applications; he should know the law of evidence and how to weigh evidences of patentability or the want of it, upon the scales of evenly balanced judgment and justice alike to the inventor and to the people; and he should know that he, himself, is a very important positive factor, in probably the greatest constructive, industrial educational

system that the world has ever known, designed to create and encourage the industrial progress of the nation, and that he is not a mere negative element standing as an obstruction to prevent the publication in patents of new discoveries and inventions that may promote the progress of the industrial arts and the consequent prosperity of the people.

### NON-MONOPOLISTIC FUNDAMENTAL PRINCIPLE.

It is believed to be a matter of some importance that it should be known in the first place that the rights conferred upon true inventors by valid patents are not in and of themselves monopolies in restraint of existing trade, although letters patent, like any other form of personal property, as coal, wheat, sugar or meat, may or may not be a basis for monopoly if all or a controlling number of patents in given arts be bought up and improperly manipulated.

In order to contrast the kind of industrial grants which have been held to be monopolistic and other grants under valid letters patent which have been held to be not monopolistic, your attention is invited to the foundation decision in the case of *Darcy vs. Allen*, Kings Bench, 1602, in which it was sought to enforce a grant of the exclusive right to import and sell playing cards within the realm.

In this case it was decided upon demurrer that the grant was *void* because against the existing rights of the people, and that it was a monopoly under the common law, the court holding that:

“There are three inseparable incidents of every monopoly against the commonwealth, (1st) that the price of the commodity will be raised, for he who has the sole selling of any commodity may and will make the price as he pleases; (2nd) that after the monopoly is granted, the commodity is not so good and merchantable as it was before, for the patentee having the sole trade regards only his private benefit and not that of the commonwealth, and (3rd) that it tends to the impoverishment of divers artificers and others who

before the grant, by the labor of their hands in their arts or trade, had maintained themselves and their families, but who now will of necessity be restrained to live in idleness and beggary."

Following this decision the same question came up in the well-known Clothworkers of Ipswich case Kings Bench (1615), and in this case it was held that the grant by the Crown of the exclusive right to work in the tailors' trade in the town of Ipswich was void as being a monopoly against the existing rights of the people who, it is held, "have the free and common right to work in any existing trade as the birthright of every subject."

However, in this same decision it was stated:

"But if a man hath brought in a new invention or if a man hath made *a new discovery of anything*—in such cases the King of his grace and favor, in recompense of his costs and travail, may grant by charter unto him that he shall use such a trade or traffic for a certain time, because at first the people are ignorant and have not knowledge or skill to use it; but when that patent is expired the King can not make a new grant thereof, for when the trade has become common and others have been bound as apprentices in the same trade, there is no reason why such should be forbidden to use it."

This decision may properly be termed, it is thought, about the first to sharply distinguish between those grants of industrial privileges conferred by the Government in derogation of the prior existing rights of the people and commonly called monopolies and those other grants to men for limited times of rights to the exclusive ownership of the products of their own genius for invention and discovery, which are not grants in derogation of prior existing rights of the people, but, on the contrary, create new forms of property for the education and benefit of the whole people for all time.

Following this decision the Statute of Monopolies, enacted in 1624, especially excepted from its provisions the grants to inventors of the exclusive ownership of

their inventions for a limited time and thereby legally established in England the non-monopolistic character of the grant.

In this connection your attention is invited to a decision rendered more than two hundred years later by Justice McLean in the case of *Parker vs. Haworth*, 4 McLean, 370, in which he said:

“The policy of the law which protects inventors is wise. It stimulates genius by endeavoring to secure a reasonable compensation to those who have spent their time and money in producing something of utility to the public. *It is not a monopoly the inventor receives.* Instead of taking anything from the public, he confers on it the greatest benefits; and all he asks and all he receives is that for a few years he shall realize some advantage from his own creation; not that he withholds his machine or discovery from the country, but that in distributing it he may receive a small compensation for the great benefit he confers. The triumphs of the inventor are intellectual triumphs. His demonstrations are made through mechanical agencies, but these in the highest degree are attributable to mind; and the same may be said of useful inventive mechanics generally. The usage of their thought embraces the system of natural philosophy in all its practical bearings; and, in carrying out their views, the highest degree of mechanical ingenuity. Through the labors of these men our country has been advanced by machinery on the land and on the water; in the saving of labor and in a rapid and increasing intercourse, and especially in the communication of intelligence in the last forty years more than could have been hoped for without their instrumentality, in many centuries.”

## FUNDAMENTAL EDUCATIONAL PRINCIPLE.

Besides bringing out the distinction between void grants of monopolies in restraint of trade and valid grants in letters patent for invention, this foundation decision

in the Clothworkers case indicates the fundamental reason why grants of letters patent should be issued, as shown in the following statement:

“because at first the people of the Kingdom are *ignorant* and have not the *knowledge* or *skill* to use it.”

Thus the education of the people in the practice of new and useful inventions, by the patented disclosures of inventors, is shown to lie at the very foundation of the patent system and to constitute the real reason for its establishment.

And although the fundamental object of the establishment of the patent system was to *educate the people* in the practice of new inventions and thereby to promote industrial progress and prosperity, and although the patent system has developed into an enormous industrial educational system in which should be interested every person, firm or corporation that may make, use, or sell manufactured commodities, it is probable that there is greater elementary ignorance among the people in relation to this great system than about almost any other important subject. And this leads to the conclusion that the people generally should be educated, in an elementary way at least, about the provisions of this system which was established in their interest.

### FUNDAMENTAL PRINCIPLE INVOLVING ANTICIPATION.

Referring again to the Clothworkers' case it will be seen that it contains also the first indication of the fundamental principle involved in the question of anticipation and the refusal of letters patent as shown by the following statement:

“But when that patent is expired the King can not make a new grant thereof, for when the trade has become common and others have been bound as apprentices in the same trade, there is no reason why such should be forbidden to use it.”

Thus it will be seen that not only is the education of the people in the practice of the new and useful inventions the fundamental object of the establishment of the patent system and the reason for the grant of letters patent, but the fact that the people have already been educated to practice alleged inventions is the fundamental reason for the refusal of grants therefor.

### FUNDAMENTAL CONTRACTUAL PRINCIPLE.

This early decision also brings out to distinct view the first conception of the contractual character of the grant, for therein it is stated that it would be lawful to issue such a grant because it would be "in recompense for the costs and travail" of the inventor. And two hundred and seventeen years later, in the familiar case of *Grant vs. Raymond*, Chief Justice Marshall said:

"To secure to inventors the exclusive rights to their discoveries is the reward stipulated for advantages derived by the public for the exertions of individuals and is intended as a stimulus to those exertions" and "The laws which are passed to give effect to this purpose ought to be considered in the light in which they have been made and to execute the *contract* fairly on the part of the United States where the benefit has been received."

### SOME OTHER FUNDAMENTAL DECISIONS.

In the interval of time between the enactment of the Statute of Monopolies in 1624 and the adoption of the Constitution of the United States, there were several recorded decisions in patent cases in England which contain some of the fundamentals upon which our own patent system was established and among these decisions may be briefly mentioned the following:

(1) *Edgeberry vs. Stevens* (K. B., 1691) containing reference in a rudimentary way to the later provision of law that prior knowledge abroad of an invention will not defeat the grant of a domestic patent for the same invention.



(2) *Dolland Case* (C. Pleas, 1766) in which prior secret use of an invention in England, by which the public could not have been taught to practice the invention, was held not to invalidate a patent to another for the same invention, because the later inventor and patentee and not the earlier secret inventor was the means by which the invention was made known to the public.

(3) *Roebuck vs. Stirling* (House of Lords, 1774) in which prior public use of the invention in England was held to invalidate a later patent to another for the same invention.

(4) *Arkwright vs. Nightingale* (Com. Pleas, 1775) in which it was held that—

“the specification is addressed to persons in the profession having skill in the subject, not to men of ignorance, and if it is understood by those whose business leads them to be conversant in such subjects, it is a sufficient specification under the law.”

(5) *Liardet vs. Johnson* (K. B., 1778) in which a patent was declared void because the specification did not constitute a complete description of the invention, the court holding that—

“the meaning of the specification is that others may be taught to do the thing for which the patent is granted and if the specification be false, the patent is void, for the meaning of the specification is that after the term, the people shall have the benefit of the discovery.”

These decisions, it is thought, indicate the first evidences of a system of fundamental laws involving patents at the dawn of the modern industrial era, in that, even at that early date across the seas, there were distinct indications of the industrial value to the people that resulted from granting to inventors the exclusive ownership of their inventions for limited times as a consideration for the publication thereof in the interest of the people and to educate them in the establishment and practice of new arts and industries.

## FUNDAMENTAL CONSTITUTIONAL PRINCIPLE.

It was probably with these facts in mind and having in mind also that the newly formed Union of States could not progress industrially without new means for solving the new industrial problems that lay before them, that Mr. James Madison on August 18, 1787, presented for the consideration of the committee of eleven of the constitutional convention, a memorandum of the several powers which he thought should be conferred upon Congress.

This memorandum contained the following two separate paragraphs:

- (1) "Congress shall have power to secure to literary authors their copyrights for a limited time" and
- (2) "Congress shall have power to encourage by premiums and provisions the advancement of useful *knowledge* and discoveries."

It will thus be seen that the fundamental conception in this country that is involved in the establishment of a system of industrial development is shown to have involved primarily the advancement and dissemination of *knowledge* of new discoveries and inventions and this conception of the educational character of such a system is clearly consistent with that earlier conception at first referred to in the Clothworkers case one hundred and seventy-two years prior thereto.

In the final form in which this matter was presented to the constitutional convention by the committee of eleven on September 5, 1787, the two separate paragraphs above referred to were combined into one and in the words so familiar to you all, it was adopted unanimously and without debate.

And sitting, as those men were in convention assembled, to invent and establish a new form of government consisting of the combination of executive, legislative and judicial elements which have cooperated to produce a new result in governmental machinery such as the world had not known before, it was but natural that they should have laid this foundation for the great industrial progress of this nation.

In plain and unmistakable terms, the constitutional provision tells the purpose and object of the establishment of the patent system in the words, "To promote the progress of science and the useful arts," and in so far as the writer has been able to discover, this is the only paragraph of the constitution which in terms provides for the promotion of industrial progress in the interest of the people.

As the phrase quoted clearly indicates the purpose and object of the establishment of the patent system, so also the only *means* provided by the constitution to be employed to carry that purpose and object into effect, is found in the words "by *securing* for limited times to inventors the exclusive rights to their discoveries."

It was to the ingenuity of the American inventors, then, that the founders of the Government looked to establish industrial enterprise and the fact that this nation today stands second to none in general industrial importance, is proof of the accuracy of the prophetic vision of those who placed the foundations of American material progress upon the shoulders of men who have been and are endowed with the power of original thought and the courage of original action.

### GENERAL OBSERVATIONS AS TO FUNDAMENTALS CONSIDERED.

With these general considerations in view with regard to the historical development of the educational, contractual and constitutional characters of the grant, it may be assumed that the first and most fundamental test to be applied to the examination of alleged inventions in patent applications is this: Would the subject-matter if patented or published educate the people to practice a new or improved industrial art or construct a new or improved industrial instrumentality.

A favorable opinion of this question should be very helpful to the examiner in deciding doubtful legal and technical problems in favor of the applicant.

Viewed also from the standpoint of their educational character, patents should be granted in the interest of the people in all cases except where evidences of prior public knowledge of the alleged invention make it clear

that those of ordinary skill in the arts are, constructively at least, already in possession of that knowledge and, in view of the fact that it is in the interest of the public that they should without delay obtain this instruction, it is a matter of much consideration that patents be expeditiously granted, due regard being had, however, to thoroughness of the examination which eventuates in the final refusal or grant of the patent.

Viewed from the standpoint of the contractual character of the grant, patents should be granted in all cases where the consideration offered by the applicant in the character of the disclosure of the inventive subject-matter would be "sufficiently useful and important" (R. S. 4893) to the public and would constitute an adequate consideration for the rights conferred by the public upon the inventor in the character of the exclusive ownership of the right thereto. The contract should be fair in its terms equally to the inventor and to the public, and for this reason, the examiner should learn to study each case before him both from the standpoint of the inventor and from the standpoint of the public. In this way only will the examiner acquire such an unprejudiced, judicial attitude as is essential to the rendition of fair and impartial decisions in matters relating to patentability.

It may be helpful to the examiner to view the application as having an inter-partes character and as if it were an executory contract and to consider that he sits as a judge to determine from all the facts and the law involved, what the terms of that contract shall be when executed; remembering full well that if the terms of the contract are to be fair, the scope and character of the claims allowed should be in direct correspondence with the extent to which the people will have been instructed by the disclosure.

In the earlier ages of the patent system, some examiners held that they represented the people only and that it was their duty in the interest of the people to prevent the allowance of patents to inventors. A deeper study of fundamental principles, however, now reveals a fairer and better conception of the examiner's duty, a conception that is helpful to the examiner in that it cultivates the habit of evenly balanced judgment and

relieves him of the monotonous strain of one-sided effort, a conception that lubricates the machinery of legal and technical labor and that results in fairness and fundamental justice alike to the people and to the inventor. This conception is—that the examiner as a judicial officer of the government of the people, represents equally the interests of the people on one hand and those of the inventors, who are of the people, on the other. And then, this judicial character of the examiner's work in considering the rights of inventors as well as the rights of the people in cases before him, if pursued with an open, fair mind, will more eminently qualify him for the more remunerative but less important work of the patent solicitor and lawyer, or the more responsible but less remunerative work of the Primary Examiner, Examiner-in-Chief or Commissioner of Patents.

Viewed from the standpoint of the constitutional provision, patents should not be granted except in those cases where the arts and sciences may be promoted thereby and only in those cases in which inventors may be made *secure* in the *exclusive* rights to their inventions. It constitutes an obvious violation of the constitution to grant patents for alleged inventions which do not promote the progress of the useful arts, which do not make the inventor *secure* in his rights and which do not confer upon the inventor the *exclusive* right to his invention. In this connection it should be borne in mind that inventors may not be made secure in the exclusive right to their inventions if the claims granted be so broad or so improperly drawn as to be invalid in view of the prior art, or if the claims patented contain useless or unrelated limitations in addition to a fair definition of the real invention. This indicates the fundamental importance of mature and earnest endeavor to make thorough searches to find statutory bars if they exist and to so act upon applications as to eliminate from claims limitations that may be unnecessary and unrelated to the real invention.

## ESSENTIALS IN THE APPLICATION OF FUNDAMENTAL PRINCIPLES.

Having now taken the liberty of inviting your attention generally to the non-monopolistic character, the educational character and the contractual character of the patent grant and to the constitutional provision relating thereto, it may be found of some little interest to consider some of the essentials that should be involved in the work of the examiner if applications are to be examined and patents granted in accordance with fundamental principles and fundamental law.

First, therefore, it would seem to be essential that the examiner should clearly appreciate the difficulty, dignity and importance of the work before him and the serious responsibility of deciding questions that may involve the material progress and prosperity of the nation and the failures or fortunes of men. Prominent jurists have expressed the opinion that the preparation and consideration of applications for letters patent involve the consideration of some of the most difficult legal and technical problems and that they themselves have ascertained from the judicial consideration of cases before them that the patent law constitutes what may be termed *the metaphysics of the law*. If this be the opinion of the justices of our Federal courts who, while maturely deliberating upon the questions at issue, are aided in rendering their decisions by the opinions of experts, by practical demonstrations, by the fullest possible presentation of facts bearing upon the question of validity both from the standpoint of the people and from the standpoint of the patentee, and by exhaustive briefs disclosing the law and the facts as presented by well qualified lawyers; if this judicial work under these helpful and favorable conditions be considered most difficult and metaphysical, then surely the work of the examiner, who must often be his own legal and technical expert, who must search and produce evidences of invalidity as well as legal precedent for his own judicial decisions, who is often without the assistance of proper disclosure and practical evidences of patentability and without sufficient time and facilities to permit proper consideration of the serious questions presented—surely such combined legal, technical and judicial work may properly be

termed still more difficult than that of the jurist and may justly be termed the super-metaphysics of the law.

Having been thus impressed with the serious importance of the work before him the examiner should realize that there is no easy or superficial process of properly examining applications, and that the interests of the people and the interests of inventors alike demand the mature and thoughtful examination of all subjects matter presented, and full and fair consideration of all legal questions before him.

## **Secondly, Matters of Substance and Matters of Form.**

If applications are to be granted in accordance with fundamental principles and fundamental law, the mind of the examiner should be trained and directed to an important consideration of all matters of substance and to relegate to a secondary position matters of form.

In order that the relative values of these questions may be gauged with some degree of accuracy, it must be determined in the first place what generally are matters of form and what generally are matters of substance.

The conclusion as to this question seems necessarily, under the law, to be that all matters that would affect the validity or the scope of the patent when granted may be considered matters of substance, and all matters which, according to statute and court precedent, have been considered *not* to affect the question of validity or scope of the patent may be considered matters of form.

If these holdings be accepted, it follows that matters of substance must be of material and controlling importance, and matters of form must be of secondary importance.

So far as the statutes are concerned it does not appear that they give prominence to any formal matter within the scope of the examiner's work, and in view of the fact that a court will presume that all such formal requirements have been complied with even where from the patent file it does not appear positively that such requirements were in fact complied with, the small, relative value of mere formal matters may be clearly seen.

However, it appears that in office practice and apparently without basis in fundamental law, there has developed some phases of the so-called question of "form" that should be considered. This is especially true of what have been termed claims "bad in form."

In so far as known neither does the statute nor does any controlling foundation decision prescribe any form for any claim.

Claims that have expressed elements in the alternative have been considered "bad in form" as likewise have claims which have been held to be ambiguous, and such claims as are indefinite and such as may not define sufficient elements to support functional expressions. Yet the only fundamental legal requirement as to claims is that they shall "particularly point out and distinctly claim the part, improvement or combination" which applicant claims to be his invention. (Revised Statutes 4888.)

The writer can see no fundamental distinction in general character between claims which in the past have been objected to because bad in form and other claims which have been rejected because indefinite, and it is submitted that it would be conducive to a more expeditious consideration of applications if both the claims hitherto held bad in form and those hitherto held indefinite or functional were grouped together and all rejected because not drawn in compliance with the provision of the statute.

### **Thirdly, Complete Disclosure of Alleged Invention and of All Matters of Fact Supporting Patentability.**

If applications are to be examined and patents granted in accordance with the educational, contractual and constitutional requirements, it is submitted that before, and as a condition precedent to the first consideration and examination thereof, there should be not only a full and fair disclosure of the alleged invention, which disclosure should be so clear and exact as to enable any one skilled in the art without further experimentation and without the exercise of higher than ordinary skill to produce the invention and practice the same, but also as a condition precedent to the first consideration of a case there should



be a full presentation of facts and matters of truth substantiating the patentability of the alleged invention presented just as it is a condition precedent to a *reconsideration* of an application that facts and reasons supporting patentability be presented. The writer is not unmindful of the difficulties experienced by solicitors in extracting from their clients all matters of fact relating to the substance of the invention, but this condition does not alter the fact that frequently the examiner, whether through ignorance or preconceived design of the applicant, has only the skeleton of the alleged invention to consider and examine, while the meat and the spirit of the invention are withheld from his consideration.

The consideration of applications has shown that only after a threat of final rejection, or after five or more years of prosecution of cases, have the real facts as evidence substantiating patentability been revealed to the examiner, whereas if these facts had been presented to the examiner in advance of his first consideration of the cases, it is probable that but one or two actions in these cases would have been necessary. What new result the alleged invention actually accomplishes in the art, whether the invention is practical or not, whether the invention accomplishes in fact the new results claimed therefor as indicated by a practical working of the invented subject-matter, and whether it does in fact promote science and the useful arts, are all material factors often already within the knowledge of the applicants and their attorneys at the time of filing applications, and it is submitted that as an essential condition precedent to a full first examination of applications, such matters of fact should be presented to the examiner in proper form as evidence along with the application when filed.

It is a known fact that upon appeals to the Board of Examiners-in-Chief fuller disclosures of facts bearing upon the question of patentability are presented than had been presented for the consideration of the examiner, and the longer the course of appeal the fuller the disclosure of these pertinent facts, and finally when, after the patent has been granted litigation ensues, then, may be, for the first time all the real reasons substantiating

validity that can be marshalled by the plaintiff are presented for the consideration of the court.

Besides the fact that both a disclosure of the alleged invention in such full, clear and exact terms as to enable those of ordinary skill in the art to practice the invention, and also a full presentation of facts as evidence substantiating patentability are essential to a full first consideration of an application by the examiner in accordance with fundamental principle, it seems clear that the public who permit the grant of patents and who are mainly interested and benefited by the grant of the patent should be advised of all facts bearing upon the matter of patentability, and these facts should be made a matter of record in each case whether they be presented before the first examination by the examiner or in response to official actions. There is no place in the proper prosecution and examination of cases for the allowance of claims in view of mere oral interviews, or in view of any reasons not of record of which the people may not be informed. See *ex parte Eckbo*, 116 M.S. Dec., 60.

In the case of every judicial tribunal known to the writer, excepting the examiners of patents themselves, the trial judge has all attainable affirmative and negative evidence before him *before* he renders his first decision, and no reason is seen why the examiners should be made an exception to this well established general rule.

#### **Fourthly, Examination of the Alleged Invention. (Rev. Stat. 4893.)**

If patents are to be granted with due regard to the rights of inventors as well as the rights of the people and in harmony with constitutional provisions, it is essential that a full and complete examination of applications such as is contemplated by Revised Statute 4893 be made. This examination should include not only a mature and critical reading and study of the specification and claims; and also drawings, if there be drawings, to determine whether the disclosure is as full, clear and exact as the statute (4888) requires, and to determine whether the matter as disclosed is operative or may lack utility, but the examination should also include a *fair*

*search for patentable subject-matter* in the disclosure as well as a full and complete search for references and other statutory bars, not only to the claimed subject-matter, but also to the disclosed subject-matter upon which the claims may be based, thereby forestalling the common practice of solicitors of shifting from one claimed subject-matter to another within the attainable prior art.

Were it true that claims presented in applications always are directed to the patentable subject-matter disclosed therein, the practice of searching for and examining only the matter claimed would obviously be the proper practice, but it is a conservatively stated fact in a fair proportion of applications presented, that the claims drawn are not directed to the patentable matter that may be disclosed in the specification and drawing. To substantiate the view that the whole application should be examined with a view to ascertaining what is the real essence and scope of the invention, if any therein, your attention is invited to Revised Statutes 4893 which provides that:

“On filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of *the alleged new invention or discovery*; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is *sufficiently useful and important*, the Commissioner shall issue a patent therefor.”

From a fair interpretation of this statute it would appear, it is thought, that not only the claims, but the subject-matter upon which the claims are based and all allegations in the specification should be examined and considered with a view to ascertaining what is the real invention, if any, and it is to be noted that this provision is mandatory and not discretionary.

In this connection it appears to be contrary to a plain rule of reason that the word “examination” in Revised Statutes 4893 be given any peculiar, unusual or hyper-technical meaning.

In every other line of work wherein analysis, diagnosis,

examination or judicial determination may be involved, the matter considered is generally subjected to thorough investigation from all points of view. In all such cases, not merely one-sided statements or claims as to the matter under consideration, but the result of the investigation itself, determines the exact character of the matter being examined. Accordingly it is submitted that applications for letters patent should be subjected to such analysis and investigation as generally are all other kinds of work subject to investigation and analytical research.

In further support of the view that, under Revised Statutes 4893, a proper examination of an application should be directed to finding out what is the real invention disclosed therein in view of the prior art, your attention is invited to Vol. 1, page 155, Robinson on Patents, in which it is stated that:

*"The claim is to define what the Patent Office, after due examination, has ascertained to be the real discovery of the inventor, and it must be amended or withdrawn according to the judgment of the officers to whom this duty is committed."*

In still further support of the view that the proper examination of an application should extend through and beyond the claim made to the "alleged invention," to the real invention, if any, that may be disclosed, attention may be directed to the fact that there are clear indications that judges of the Federal courts, who are best grounded in fundamental patent law, are looking beyond the claims in suit, through mere "environments," to the real essence of the invention made and, where the terms of the claims make it possible, are construing patented claims so as to give them the scope and meaning necessary to cover the real invention made by the patentee. In this connection see the very able decision recently rendered by Judge Dennison in the case of Davis Sewing Machine Co. *vs.* New Departure Manufacturing Co., 212 O. G., 1057.

And if it becomes thus necessary for the courts to construe claims and go beyond them to find the real invention in order that the patentee may be given protection for that which he really has invented, it would

appear all the more important for the examiner to so examine applications as to ascertain what the real invention is and what are needless limitations, before the patent is granted, in order that the patent when issued may show upon its face what the real invention is and in order that this legal construction of the patent through and beyond the terms of improperly granted claims may be made unnecessary.

Aside from these considerations, if searches be made through and beyond the claim presented it may result in finding matter disclosed that would be of value to the public and which may form the subject-matter of patentable claims, but which would not have been found and claimed if the claims alone as drawn by applicant or solicitor had been examined, and if no search beyond the claim had been made for patentable matter.

It would appear to be quite clear, therefore, that only by a thorough search for patentable matter in applications as well as for statutory bars to the granting of patents will the grant be fair in its contractual terms and will it be made in accordance with the constitutional provision; and, moreover, this full first examination of matter in and beyond the claims would doubtless render subsequent searches largely unnecessary and would necessarily expedite the final disposition of applications.

#### **Fifthly, Information in the Interest of Inventors and References in the Interest of the People Including Inventors (Rev. Stat. 4903).**

If patents are to be granted in accordance with fundamental law, and also with fair regard to the interests of the two real parties to the contract, it is submitted that after examinations have been made of applications in accordance with an interpretation of the meaning of the Revised Statutes 4893 that is in harmony with the fundamental principles that have been referred to at length, official decisions rendered as the result of such an examination should be made in accordance with such an interpretation of Revised Statutes 4903 as will be in harmony with the contractual and constitutional principles involved.

Revised Statutes 4903 provides:

"Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such *information* and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specification, the Commissioner shall order a re-examination of the case."

It is to be noted that this statute contains a mandatory provision to the effect that *information* as well as references shall be furnished to applicants, and it is submitted that this information should be such as to aid in determining the true scope of the real invention disclosed in order that claims may be presented that may make the inventor secure in the exclusive right to his invention.

The term "references" doubtless applies to all matters of fact constituting, under the statute, evidences of want of novelty and also references to all matters of law and fact constituting evidences of lack of invention under the statute.

And since such references to matters of facts and law under the statute are to be cited in official decisions in the interest of the people to prevent the granting of patents that invade the existing rights of the people, and in order that the people as well as inventors may not be deceived by the grant of inoperative or invalid patents, it would seem only fair and reasonable to assume that "information" under the statute should be given in official decisions both as to matters of fact and matters of law that will aid applicants in securing patents that will conform to the elementary principles involved in the contractual and constitutional characters of the grant.

### **SOME APPLICATIONS OF ELEMENTARY PRINCIPLES.**

It may now be of some little interest to apply, in a simple way, the elementary and fundamental principles to which reference has been made, to some familiar

cases that frequently come before the examiner for consideration.

(1) Let us consider a case involving mill construction in which upon a thorough examination of the alleged invention as required by the statute the examiner finds that the claims for a crushing roll *per se* as presented are anticipated by the prior art, but upon search for patentable subject-matter finds a new and patentable invention disclosed in the relation that one crushing roll bears to another crushing roll. It is submitted that it is in accordance with fundamental requirements involved in the educational, contractual and constitutional character of the instrument under consideration and in accordance with a fair interpretation of Revised Statutes 4903 in harmony with these fundamental principles that information be given to the applicant of this patentable matter in order that it may be published in a patent to instruct and educate the people.

(2) Let us now consider another case involving the alleged combination of a grinding element having a new grinding dress with a new means of fastening the element upon its shaft. This claim may be patentable in so far as the prior art is concerned and it may be in the selfish interest of the people as one party to the contract that such a restricted claim be allowed. But the interests of the inventor are of equal weight and value with those of the people and viewed from the inventor's standpoint, such a claim should not be allowed, because it does not make the inventor secure in the exclusive right to what he has really invented and because the contract would not be fair in its terms to the inventor if granted for this subject-matter. It is submitted that in such a case as this the claim should be rejected for want of patentable combination between the grinding element with its particular dress on one hand and the particular means of fastening the element to the shaft on the other, and in accordance with the provisions of Revised Statutes 4903 applicant should be informed that separate claims, some to the grinding element with its dress and others to the means of fastening the element to its shaft may be allowed and that it is a useless limitation to claim such features in combination. It is submitted that there is just as much warrant in fundamental law for the refusal

of claims which by reason of unnecessary and unrelated **limitations** (whether they be new or old), may make inventors **insecure** and unexclusive in their rights, as there is for the refusal of **claims which would deceive** the public and be worthless to inventors, because invalid in view of the prior art.

(3) Let us consider a case for mill construction in which the claims for a crushing roll having a special crushing dress and made, say, of manganese steel, are found to be patentable in view of the prior art, but upon a thorough examination of the alleged invention the examiner ascertains that the claims contain useless limitations by reason of the needless restriction as to the material of which the roll is made. The examiner knows the fundamental principles involved in the contractual character of the grant in that the claims granted should be commensurate in scope and character with the scope and character of the disclosure made in the interest of the public, and the examiner knows that the presence of useless limitations in these claims may prevent the inventor from being made secure in the exclusive right to the real invention (the roll provided with the crushing dress) covered thereby as provided by the constitution, and accordingly in order that the patent may be granted in accordance with the provisions of fundamental law it is submitted that under the provisions of Revised Statutes 4903 the applicant should be given this information which has been acquired by the examiner, and he should point out to the applicant the true scope of his invention and what are the useless limitations in his claims.

(4) A case for, say, a grain thrashing mechanism is now considered in which is presented claims for alleged combinations of distinct and separate subjects-matter, for instance, the feeder and the cylinder threshing mechanism. The examiner in examining this case finds that the combination broadly is old and that each element is old as claimed. Both from his own study of the law relating to patentable combination and from a careful study of the very able but conflicting opinions expressed in papers read by examiners during the past year, the examiner has a very clear conception of the law relating to the patentability of combinations of old



devices. He therefore cites references to show that the combination claimed is old and that the separate devices are old and rejects the claims for want of invention in assembling the old devices in one structure, if no new relation or result appear to the examiner. However, in order that the decision of the examiner may be in conformity with the elementary principles referred to and comply with a fair interpretation of Revised Statutes 4903, it is submitted that the applicant should be given information as to the law points involved, to the effect that the rejection is made in the absence of evidence of patentable combination among the parts indicating the production of a new or improved result, the production of an old result in a better way or in the absence of a showing that one or more of the parts are caused to operate differently in the alleged combination than it or they did before in their separate capacities; and as indicating what is meant by a "new result" under the law, it is suggested that the decision in the case of *Deere & Co. vs. Rock Island Plow Co.*, 82 O. G., 1561, be studied. In this case the judge said:

"The new result of a patentable combination is a result which is new and distinguishable as compared with results produced by the elements in their separated state or as assembled in a mere aggregation without functional relations to each other. A combination is not unpatentable merely because its results may also have been accomplished by other combinations."

If, in searching for patentable matter, however, in the above noted case it appears from the disclosure that, for instance, there is a new relation of the feeder to the thresher in that the material is so fed and controlled by the feeder as to prevent choking the thresher cylinder, it is submitted that information as to the matter should be given under the statute.

(5) Another case involving mill construction may now be considered in which a thorough examination under Revised Statutes 4893 discloses the fact that the claims define a new and distinct subject-matter patentable in itself in view of the prior art, in the character of new grinding mechanism *per se*, in alleged combination with

feed mechanism, screens, and discharge mechanism which, together with the grinding mechanism, constitute the whole machine.

In such a case as this, it is submitted, references should be cited to show that the general combination is old; that therefore the people need no further instruction as to how such devices should be combined and such claims should be rejected because it is shown that applicant did not invent the combination, but he should be informed that he did invent the crushing mechanism *per se*.

There are several reasons why such claims as this, whether they be the only class of claims in the case, or are claims needlessly drawn in addition to other claims which properly define the real invention in view of the prior art, should not be presented or granted, some of which reasons are the following:

(1) Because, if such claims be presented for examination they complicate the work of the examiner by requiring searches for and examination of a plurality of distinct and often unrelated inventive subjects-matter in each claim and thus materially prolong the examination and prosecution of applications in this office.

(2) Because, if granted, such grant would be violative of the basic principle involved in the educational character of the grant in that the public having been once educated to make such combinations there is no reason or warrant in fundamental law for granting a subsequent patent to again educate the people to combine such devices.

(3) Because such claims are violative of the contractual agreement of the applicant to comply with the terms of the statute (4888) which provides that:

“Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall . . . particularly point out and distinctly claim the part or improvement . . . which he claims as his invention or discovery.”

(4) Because such claims in patents are violative of the contractual character of the grant, in that they do not define the real invention in terms coextensive with a less limited inventive subject-matter disclosed and in

that being thus unduly limited they constitute invitations to the patent expert freely to extract the essence of the real invention and conceal it in other material embodiments thereof.

(5) Because such claims in patents are violative of the constitutional provision in that they may not make inventors secure in the exclusive rights to their real inventions.

(6) Because such claims in patents have confused the minds of the trial justices and have led to many inconsistent and conflicting decisions in the various judicial circuits.

(7) Because such claims in patents make more difficult the task of the highest and best type of legal practitioner, who in more modern times, in the interest of their clients, seek to prevent litigation where possible, whereas, such claims constitute an obvious means of promoting prolonged entangling litigation so harmful alike to the public and to inventors.

(8) Because such claims if granted in patents may deceive the public in the belief that the patentee had invented the whole defined subject-matter; and in this connection your attention is invited to the foundation decision in the case of *Evans vs. Eaton*, 7 Wheaton, 356. In this case the plaintiff brought suit upon a patent for hopper-boy construction in a mill. The claim in this case covered inferentially, at least, the whole of the hopper-boy construction though the plaintiff had in fact made merely an improvement upon prior general machines. The plaintiff held that his patent was to be construed for either the whole machine or, if not susceptible of this construction, it should be construed as being for an improvement. So, thus early in the judicial consideration of patents we find the court confronted with one of the now familiar claims in the character of a nose of wax in which the real invention is so obscured in "environments" or additional matter as to permit the plaintiff to conceal his real invention and then, if his patent be litigated, he may seek to have it construed in one way to suit one condition, or in another way to suit another condition.

Justice Story, the famous patent jurist of the early days of the patent system, in deciding this case after

referring to the claim drawn as having "a double aspect" said:

"The very terms of the patent, as they have been already considered, and as they have been construed at the bar by the plaintiff's counsel, at the present argument, seem almost conclusively to establish that the patent is for the whole machine, that is, for the whole of the improved hopper-boy, and not for a mere improvement upon the old hopper-boy.

"It is clear that the party can not entitle himself to a patent for more than his own invention; and if his patent includes things before known, or before in use, as his invention, he is not entitled to recover, for his patent is broader than his invention. If, therefore, the patent be for the whole of a machine, the party can maintain a title to it only by establishing that it is substantially new in its structure and mode of operation. If the same combinations existed before in machines of the same nature, up to a certain point, and the party's invention consists in adding some new machinery, or some improved mode of operation, to the old, the patent should be limited to such improvement, for if it includes the whole machinery, it includes more than his invention, and therefore can not be supported.

"The specification has two objects: one is to make known the manner of constructing the machine (if the invention is of a machine), so as to enable artisans to make and use it, and thus to give the public the benefit of the discovery after the expiration of the patent. It is not pretended that the plaintiff's patent is not in this respect sufficiently exact and minute in the description. But whether it be so or not, is not material to the present inquiry. The other object of the specification is, to put the public in possession of what the party claims as his own invention, so as to ascertain if he claims anything that is in common use, or is already known, and to guard against prejudice or injury from the use of an invention which the party may otherwise

innocently suppose not to be patented. It is, therefore, for the purpose of warning an innocent purchaser, or other person using a machine, of his infringement of the patent, and at the same time of taking from the inventor the means of practicing upon the credulity or the fears of other persons, by pretending that his invention is more than what it really is, or different from its ostensible objects, that the patentee is required to distinguish his invention in his specification. How can that be a sufficient specification of an improvement in a machine which does not distinguish what the improvement is, nor state in what it consists, nor how far the invention extends—which describes the machine fully and accurately as a whole, mixing up the new and old, but does not in the slightest degree explain what is the nature or limit of the improvement which the party claims as his own? It seems to us perfectly clear that such a specification is indispensable, and we are of opinion that the inventor ought to describe what his own improvement is, and to limit his patent to such improvement."

The concealment of the real invention in alleged combination claims, whether through ignorance or by design, constitutes at the present time, as it did in 1822, one of the most serious abuses existing in patent practice, and unless the allowance of such claims be discontinued, it will constitute one of the most potent causes in impairing the usefulness of the patent system. These views in relation to the inclusion of useless limitation in claims containing patentable subject-matter are not only those of the best informed of the jurists of the early period of the patent system, but are also those of a thorough student of patent law upon the Federal bench and of two of the foremost patent lawyers of today, as have been evidenced by addresses made by them before this body of men, and the fact that examiners have been deciding cases for some years in accordance with these fundamental principles in order that patents granted by them may make inventors secure in the exclusive right

to their inventions, constitutes conclusive evidence that the opinions of Justice Story and those of the able gentlemen who have appeared before us are absolutely correct.

It is submitted that in decisions by the examiners in such cases as this, references showing the general combination should be cited, references to the fundamental law should be cited, and "information" under the statute should also be given to the applicant to show that his real invention may consist in the distinct inventive subject-matter that is original with himself and not in the alleged combination and, moreover, that it is a needless limitation to claim other matter in alleged combination with the real inventive subject-matter.

This does not mean that in all cases where novel inventive subject-matter of a distinct character is claimed with other matter, the claim should be rejected for reasons above stated. In many cases the novel subject-matter is in such relation with the other matter as to cause it to operate differently than it did before, and this may be termed a patentable combination of a new subject-matter and other devices. In such cases if claims for the patentable combination only be presented, it is submitted that, in the interest of the inventor he should be informed that claims for the patentable improvement *per se*, as well as for the patentable combination including the same may be allowed, for only in this way may the contractual and constitutional essentials be embodied in the grant of the patent therefor.

It is believed that a sufficient number of cases has been referred to, in order to indicate to some extent the writer's impression of the true meaning of Revised Statute 4903 and of its accord with fundamentally right principles as applied in rendering decisions as to patentability, and accordingly more extended specific references to cases will not be given. The examiners well know the law relating to all of the other grounds of rejection constituting bars to grants of claims, whether they involve the question of change of material, substitution of equivalents, duplication of parts, omission of parts, mere mechanical skill, etc., and it is submitted that, in decisions in all of such cases, not only references to prior

art and references to legal precedent unfavorable to the grant should be cited, but also "information" under the statute that will aid inventors as to how to overcome statutory bars, should also be given therein.

#### **Sixthly, Notice of Prior Pending Art Under Revised Statutes 4904.**

If patents are to be examined and granted with a view to making inventors secure in the exclusive rights to their inventions, in accordance with constitutional requirements, it is essential that notices of the prior unpublished pending interfering art be sent in all applications which would be anticipated or interfered with by the prior pending art disclosure, just as notices of prior published art are sent in *ex parte* cases.

Your attention is now called to Revised Statutes 4904 which is as follows:

"Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give *notice* thereof to the applicants, or applicant or patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe."

It is to be noted that the statute refers to interfering "applications" and "interfering applications and patents," and not to mere *claims* for substantially the same invention, as per Rule 93.

Now, since it is essential that patentable matter be found in alleged interfering applications before an interference can be declared, and if a proper determination of the fundamental meaning of Revised Statutes 4893 and 4903 resides in the requirement that the examiner search for patentable matter as well as search

for statutory bars if they exist, and to furnish helpful information to inventors as well as to cite references, and if it be fundamentally right to set aside legal fiction in favor of fundamental fact and truth, then the essential is that an application interferes with another application or patent under the statute when the real invention in one application interferes with the real invention in another application or patent without reference to the particular claims which may happen to be drawn, whether by those who, having proper qualifications, draw claims to the real invention disclosed, or by those who by reason of ignorance, inadvertence, accident or mistake draw claims that are not directed to the real invention disclosed. It is believed that under the plain broad terms of the statute interference exists whenever co-pending applications or applications and patents contain common patentable subject-matter, and whenever the allowance of patentable matter in one case would interfere with the exclusive rights granted in another case. The terms "application" and "interfere" should be given their broad, plain and ordinary meaning and not a forced meaning based upon the legal fiction that the claim already presented defines the real invention and that the question of interference must be decided upon the claims that happen to be drawn in the respective cases no matter how ignorant the claimant may be in one case or how skilled the applicant may be in another case. An invention properly claimed in one case is not a different invention when, through inadvertence, accident or mistake, it is improperly claimed in another case or even when disclosed but not claimed at all therein. Proper prosecution and examination of both of such cases would necessarily result in finally allowing claims to the same real invention in both cases, and it seems quite reasonable to assume, therefore, that in determining the matter of the declaration of interference, consideration should be given through and beyond the claims already drawn to the real invention in each case.

It is believed that, in the past, when considering whether an interference should be declared, much error and consequent injury has been occasioned by determining this important question before one or more of the applications under consideration have been fully



prosecuted and examined with a view to ascertaining what is the real invention made by the applicant, and it is believed that before an interference is to be declared, it should be fully determined by proper examination and prosecution what is the real common invention in all cases involved.

The view that applications or applications and patents interfere when the right to the real invention in one case interferes with the right to the real invention in the other case without reference to the particular claims that may be drawn, does not mean that interferences should be declared in all such cases, but it does mean that in all such cases "notice" under the statute should be given to each party of the real interfering invention of the other party.

The importance of this *notice* under the statute can not be over estimated, because if notice be withheld and patents be granted without notice of anticipating prior pending art or pending art that would render insecure the rights already granted in the patent, the fundamental contractual rights, the constitutional rights of the patentee and the plain broad terms of the statute would be violated.

A case in illustration may be given by referring to claims involving a crushing roll having a novel crushing dress as an element of an organized mill. In one application filed by one inventor merely the roll *per se* having a particular new grinding dress is disclosed and claimed. In a later application disclosing the same roll having the same dress filed by another inventor, through ignorance, inadvertence, accident or mistake, merely the alleged combination of a roll with a grinding dress together with the elements of one of the several different forms of general mill construction is claimed. Claims to the crushing roll *per se* having the particular dress if they were presented would be allowable in the second application in view of the prior art, and if an interference were declared, evidence might be produced to prove that the second applicant was the first inventor thereof. However, no interference is declared, and the combination claim is patented without notice to this later applicant of the existence of the prior application in which the roll *per se* is claimed. This patentee has constructive

notice of all published anticipatory matter affecting this claimed matter and having no actual notice of prior interfering pending matter he presumes that there is no pending anticipatory matter that would prevent him from enjoying the exclusive right under the constitution to his invention that has been granted him, and may be he has established a plant and has procured others to make investments therein. Then afterwards the grant of the patent upon the roll *per se* soon convinces him that there is an interference with this right to practice his real invention and that he has no secure and exclusive right to make the invention made by him and much business disturbance and financial loss results.

It may be said that this fundamental wrong may be righted by a reissue of the patent first granted or by filing a divisional application, but in such cases if either the reissue or divisional application eventuate in a patent for the roll *per se* there would be two patents for the same invention which is plainly in violation of the fundamental principles which have been referred to in so much detail in this paper and would doubtless result in injury to the public.

In order further to illustrate the broad fundamental principle thought to be involved in a fair interpretation of Revised Statute 4904, let it be presumed that case "A" is filed in which is claimed "A tablet of wax-like material having a record of sound vibrations *cut therein*." The applicant in this case being skilled in the proper practice of drafting claims for the real substance of inventions and having in mind correct fundamental principles, does not conceal this broad invention in an alleged combination of elements of a sound reproducing machine, but distinctly defines his real invention in order that the people may clearly know the precise scope and character of the invention newly made. The examiner upon examining the alleged invention presented finds that the claim is clearly patentable in view of the prior published art. But upon investigation of the pending art the examiner finds an application "B" long pending and disclosing and claiming a method of duplicating sound records, the first step of a claim therein being: The method of duplicating sound records which consists first, in cutting in a tablet of wax-like material

an undulatory record of sound vibrations and then electroplating, etc. There are no claims in this case "B" for the process of making records of sound *per se*, or for the record made as claimed, but this new and patentable matter is covered up in the complicated claim referred to and accordingly no interference may be declared between cases "A" and "B" under the terms of Rule 93. Application "A" is allowed and is patented for the *exclusive* right to make, use and sell the record tablet as claimed therein, notwithstanding the fact that the Government when granting this exclusive right has full knowledge of the prior pending art as in case "B," which would necessarily invalidate the patent and make it *unexclusive* when afterwards the patent in case "B" is issued. The patentee in case "A" then knows for the first time practically, if this office did not know technically, that there was and is interference between case "B" and his case and that the grant by this Government has been not only valueless, but has occasioned much loss and business disturbance.

It is submitted that the grant of a patent to "A" without *notice* under 4904 of the Prior pending art that would interfere with the rights granted therein is not only clearly in violation of the contractual and constitutional character of the grant, but also is in plain violation of the express terms of the grant.

It is submitted that in all cases in which the real invention in pending applications or applications and patents interfere, notices should be sent to the parties whose interests would be affected without reference to the particular claims in the cases and that interferences should be declared in all such cases.

While these elementary observations have been made with reference to the question of interference with a view to inducing the examiner to study the fundamentals involved in the matter of interference under the statute, yet in order that this general question may be pursued a step further, the practice under Rule 75 will now be considered.

We have in former lectures been well informed of the essentials of affidavits under Rule 75 filed in order that the bar of prior patents granted within two years prior to the application may be avoided.

It is, however, with reference to its relation to the matter of interference under section 4904 that consideration will now be given. And to illustrate the fundamental point sought to be made resort will again be made to the crushing roll and the machine including the crushing roll, for illustration. Let it be assumed that the application filed by one inventor for the alleged combination including the novel crushing roll was filed first and the application by another inventor for the novel crushing roll *per se* has been later filed. And let it be assumed that the application for the alleged combination has gone to patent without notice to the later applicant and the claim for the roll *per se* has been afterwards rejected upon the patent. The inventor of the roll *per se* files an affidavit under Rule 75 in which he states facts showing that he completed the invention in this country prior to the date of filing of the patentee's earlier application and his patent issues for the novel roll *per se*, so that we now have two patents granted, one for the combination including the novel roll, and one for the novel roll *per se* and the exclusive rights granted to the first patentee are thus interfered with by the superior exclusive rights granted to the second patentee without notice to the first patentee. The real invention in these two cases is the same, for as we have seen in considering the educational and the contractual character of the grant, the real invention is that embodiment of the inventive disclosure which corresponds in scope and character with the extent to which the people will have been educated thereby and in both of these cases the people will have been taught to make a new and useful crushing roll and if it be that the real invention is the same in both of these cases and that the invention in one case does not become a different invention in another case because in may be improperly claimed therein, then it is submitted as a matter for elementary consideration and study whether under Revised Statutes 4904 before the allowance of the later application the prior patentee should not have been notified of said later application, the grant of which would interfere with the already existing exclusive rights granted to him. Not only in order to prevent violation of exclusive rights in the patent when granted, but also to prevent double patenting and to prevent harmful

litigation, notices under Revised Statutes 4904 should be sent both under Rule 75 and Rule 96 to applicants and to patentees advising them of the pending art containing claims that would interfere with the exclusive rights to which they would otherwise be entitled, without reference to whether the properly or improperly drawn claims be directed to the same matter or not.

These are some of the fundamentals which, it is thought, should be considered by those who may be unfamiliar with the elementary principles involved in the establishment of the Patent System and in the grant or refusal of Letters Patent for inventions, and the deeper and more thorough the consideration of these fundamental truths involved in the study and application of the principles to which reference has been made, the clearer will be the course to be pursued, not only in facilitating, expediting and improving the examiners' work, but also in avoiding criticism of, and in dissipating opposition to, the Patent System and to the present system of prosecution and official examination of patent applications.

If at any time, however, criticism or opposition to the Patent System appear among the people in whose interest it was established, the attitude of those concerned will doubtless be attributable to the following causes:

1st. Because the people generally have not been informed and do not know that letters patent for inventions are not monopolies in restraint of the existing right of the people, but that they create new forms of property for the whole people to be freely enjoyed by them after a period of exclusive ownership by the patentees.

2nd. Because the people generally have not been informed and do not know that the Patent System was established in the interest of the people as an industrial educational system, to educate the people to establish and practice new or improved industrial arts and enterprises and thereby to promote the industrial progress and material welfare of the whole people.

3rd. Because the people generally have not been informed and do not know that Letters Patent for inventions, are contracts made in the ultimate interest of the people, between the people on one hand and inventors on the other hand, the terms of this contract being that

inventors agree to publish complete disclosures and distinct definitions of their inventions, which otherwise may be kept secret by them, and that the people in consideration of the disclosure and publication thereof agree to make inventors secure in the exclusive rights to their inventions, the Government through its designated officials being charged with the duty of seeing that the terms of these contracts are fair alike to the people and to inventors.

4th. Because the people have not been informed and do not know that the only means provided in terms by the constitution to promote industrial progress and prosperity, are the rights granted to inventors of the secure and exclusive ownership of their inventions for limited times.

And if criticism of or opposition to the present system of prosecution and official examination of patent applications at any time develop, this attitude of those concerned may be found to exist because of the following conditions:

1st. Because some of those who solicit patents are known to prosecute patent applications solely to obtain patents and the incidental fees, without regard to whether the alleged inventions may promote the progress of the useful arts in the interest of the people and without reference to whether inventors are made secure or exclusive in the rights to their inventions and,

2nd. Because we examiners, in some instances at least, have granted some patents the examination record of which shows the distinct need of:

1st. A uniform standardized system of instruction for assistant examiners (possibly in a single Division of Instruction), and,

2nd. A uniform standardized system of examination of applications consisting of:

1st. A mature and deliberate examination of the alleged invention in the whole disclosure to find patentable matter, in the interest of the inventor, and thorough search in the prior art to find statutory bars in the interest of the people as indicated in Revised Statute 4893.

2nd. Standardized official actions giving full information in the interest of the inventor and full citation of

references in the interest of the people as indicated in Revised Statute 4903.

3rd. Due and timely notice of all pending applications which would, if granted for the real inventions therein, interfere with and make insecure and unexclusive the rights to inventions in other applications or patents, as indicated in Revised Statute 4904.

It is submitted that only by some such uniform standardized system of examination of applications as this, may the work of examiners be made to conform to the fundamental principles involved in the educational character and in the contractual character of the grant and possibly only by such a system as this may the examiner's work be made to comply with constitutional requirements which are controlling.

September 28, 1916.

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# COMBINATION VS. AGGREGATION

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*A question decided January 14, 1912, before the Examining  
Board of the United States Patent Office*

by  
**LOUIS W. MARSH,**  
Patent Examiner, Division Fourteen,  
U. S. Patent Office.

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WASHINGTON, D. C.





# Combination vs. Aggregation

By

LOUIS W. MAXSON,  
Principal Examiner, Division Fourteen,  
United States Patent Office.

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The constitution of the United States provides that "Congress shall have power . . . to promote the Progress of Science and Useful Arts by securing for limited times to Authors and Inventors the exclusive right to their respective writings and discoveries."

R. S. 4886 states that a patent may be obtained by "any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, etc."

It is therefore clear that Congress has limited the subject-matter of a patent to an invention, novelty and utility alone being insufficient to justify the grant.

Where a device is composed of but a single element, the question of patentability is simple, depending on whether the element is the result of invention or the product of mere mechanical skill; but, when two or more elements are grouped together, as in combined tools, machines, or the several steps of a process, a new question arises. Are the several elementary parts so related as to produce a legitimate combination and, if so, under what circumstances do they constitute a patentable invention?

The decisions of the Federal Courts, from the beginning of our patent system, have been remarkably uniform in respect to this matter, yet, judged by the nature of the patents granted, the practical distinction between patentable and unpatentable combinations or aggregations seems to be little understood by many. I therefore base the remarks which I shall make on a few of the decisions

which I have found most useful in determining the many cases which have come before me.

These are:

(3) "To make a valid claim for a combination it is not necessary that the several elementary parts of the combination should act simultaneously. If those elementary parts are so arranged that the successive action of each contributes to produce some one practical result, which result, where attained, is the product of the simultaneous or successive action of all the elementary parts, viewed as one entire whole, a valid claim for thus combining those elementary parts may be made."

Furbush et al. *vs.* Cook et al., ~~10 Mo. L. R.~~  
664, Curtis, 1857.

"Although three elements of a patented combination may all be old and two of them have been combined before, yet he who brings into the combination the third element, and thereby gets a practical advantage, makes a patentable invention."

Ib.

"Although a combination of old devices may be patentable when a new and useful result is produced, no one can, by combining several devices, each of which is old, thereby deprive others of the right to use them separately or the right to use them in new combinations, or the right to use some of them in combinations, omitting others."

Hailes et al. *vs.* Van Wormer et al., 7 Blatchford, 443, Woodruff, 1870.

"The mere addition of an old device, producing a specific result, to another device, producing its own result, in such wise that their combination produces those two same results, and no other, is not invention."

Ib.

"Patents may be granted for combinations in which some of the parts are old and some are new; and whatever in the several parts is new may be separately secured to the inventor; and yet it may be true that only in the combination described or in some similar combination, the new part thus secured to the inventor is of any practical use whatever."

Wheeler, Jr., *vs.* Clipper Mowing and Reaping Co., 10 Blatch., 185, Woodruff, 1872.

"Under the statutes patentee is required to particularly specify what he claims to be new, and if he claims a combination of certain elements or parts, we can not declare that any one of these is immaterial. The patentee makes them all material by the restricted form of his claim."

Union Water Meter Co. *vs.* Desper, 101 U. S., 332, Sup. Ct., 1879.

"A mere aggregation of old things is not patentable, and, in the sense of the patent law, is not a combination. In a combination the elemental parts must be so united that they will dependently co-operate and produce some new and useful result."

Wood et al. *vs.* Packer, 57 Fed. Rep., 651, Nixon, 1883.

(5) X  
(3) X

"A combination is patentable (1) if it produces new and useful results, though all the constituents of the combination were well known and in common use before the combination was made, provided the results are a product of the combination, and not a mere aggregation of several results, each the product of one of the combined elements; (2) if it produces a different force, effect, or result in the combined forces or processes from that given by their separate parts and a new result is produced by their union; (3) if it either forms a new machine of distinct

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X  
character or formation or produces a result which is not the mere aggregate of separate contributions, but is due to the joint and co-operating action of the elements; (4) when the several elements of which it is composed produce, by their joint action, either a new and useful result, or an old result in a cheaper or otherwise more advantageous way."

Niles Tool Works *vs.* Betts Machine Co., 27 Fed. Rep., 691, Wales, 1886.

A  
"A patent for a combination can not be maintained where nothing is done except to bring well-known devices into juxtaposition, each working its own effect, and the aggregate producing no new and useful result."

Kerosene Lamp Heater Co. *vs.* Littell, 3 Banning and Arden, 312, Nixon, 1878.

"There is no patentable combination, properly so called, in an aggregation of devices which have no common purpose or effect, concurrent or successive."

Tower *vs.* Bemis & Call Hardware & Tool Co. et al., 19 Fed. Rep., 498, Lowell, 1884.

"A broad claim can not be sustained for merely putting together two old tools for convenience of manipulation in several and wholly distinct uses—the patent must be limited to some patentable improvement, either in the mode of combining the tools or in one or more of the tools themselves."

Ib.

"To combine the parts of two existing machines, leaving the parts in the new union to work as before does not constitute a patentable combination, but merely an aggregation."

Troy Laundry Machinery Co. et al. *vs.* Bunnell, 23 Blatch., 558, Wallace, 1886.

"A patent for a combination is not invalid because all the parts are old. But merely assembling them together, or placing them in juxtaposition does not indicate invention. Some new or peculiar function produced by such a combination must be developed. Unless this follows, the new arrangement is the mere exhibition of mechanical skill."

Scott Mfg. Co. *vs.* Sayre, 26 Fed. Rep., 153, Nixon, 1885.

"The fact that an article is convenient and has commercial advantages does not render it patentable where it is made up of independent devices, each of which is unaffected by the presence or absence of the other."

Ex parte Davenport, C. D., 1904, 110.

From these it is clear that the patentability of a group of elements does not depend on their individual novelty, but upon their unitedly producing a new and improved result, the product of their combined operation, not the mere sum of their several individual effects. This result may be produced by the simultaneous or sequential operation of the elements, each upon the other or their co-operation in groups. If this united participation in the result is not present, then ordinarily no patentable combination exists, but an unpatentable aggregation, an arrangement lacking invention since based alone on mechanical skill.

The patentability of claims which involve several elements can ordinarily be readily determined by applying these tests.

Let A, B, and C represent several grouped elements. If their relation is  $A + B + C$ , their function or result being merely additive or the sum of their individual results, they constitute an unpatentable combination, whether new or old.

If their relation is  $A \times B \times C$ , each modifying the other or co operating singly or by groups and all mutually tending to produce a unitary result, they form a legitimate combination and, if the result is new and use-

ful, the device is patentable, but it does not follow that all legitimate combinations are patentable.

$A \times B \times C$  is old in the art, and  $C^1$ , a modification or specific form of  $C$ , is substituted for that element.

If  $C^1$  is an old and well-known equivalent for  $C$ , no new result is accomplished and the resultant combination is unpatentable.

If a new and improved result follows the substitution and this is due to the modifying influence of the substituted element on all the others, the combination is new and patentable.

If  $C^1$  does not affect the functions of  $A$  and  $B$ , individually or in group, other than did  $C$ , adding only its own peculiar function to the result, the combination is not patentable over  $A \times B \times C$ , the broad combination being exhausted, and  $C^1$  should be claimed by itself since in it alone does the invention lie. This is true whether  $C$  is new or old. It is not a new combination since the only modification of the result rests in the substitute element.

$A \times B \times C$  being old, if  $C$  is omitted while the old result is maintained, a new and patentable combination results.

*Richards vs. Chase Elevator Co.*, 73 O. G., 1710.

In special art tools it may be that each element accomplishes only its own result, but, if the several elements contribute by their operation to the production of a unitary improved result, unattainable in the absence of either, there is a legitimate combination. Such an instance is seen in the ordinary glass cutter, in which the scoring roll of the cutter combines with the breaking notch to produce the complete severance of the glass.

"Lying close to, yet, apart from this clearly defined field of combination and aggregation, is a twilight zone in which there appears to be no well settled practice either in the courts or Patent Office. This resides in that class of cases in which old elements are so positioned with respect to each other that, while each performs its own function, the ultimate effect of grouping the parts is the production of a better, more advantageous or cheaper result. Such cases are discussed in *Burdett-Rountree Mfg. Co. vs. Standard Plunger Elevator Co.*, 196 Fed.

Rep., 43; *Standard Plunger Elevator Co. vs. Burdett-Rountree Mfg. Co.*, 197 Fed. Rep., 743; and *Krell Auto Grand Piano Co. of America vs. Story & Clark Co. et al.*, 207 Fed. Rep., 946, in the last of which it was held that a patent for a mechanism consisting of two or more elements is not necessarily invalid as an aggregation because there is no direct co-action between the elements, where such co-action comes to produce a unitary result through the mediation of the operative or the operating force, but without the court laying down any hard and fast rule of general application."

Perhaps a few concrete illustrations of this type of invention will in part clear the practice. It is old to form a flexible metal tube of small diameter and to form a web or braided cover about such tube by separate machines, also to feed tubes through their forming mechanism by drawing rolls. So positioning these devices as to have a pair of rolls for forming a small flexible walled tube, a means in direct alinement with the delivery outlet of the forming rolls to form a web or casing about the tube, and drawing rolls for feeding the product through the forming and casing mechanism, forms a patentable combination, as the direct line delivery insures the perfection of the tube at the point where the web is placed about it and the feed rolls maintain the direct alinement of the material while being worked upon. The parts work as before, but synchronism of operation is maintained by the tube as drawn through the machine and the perfected product is due to the consecutive operation of the several elementary machines without any deformation of the tube due to intermediate handling.

It is mere aggregation to place an oil can in the handle of a wrench so as to have a handy supply of lubricant in case a nut is rusted on its bolt. Change the position of the oiler, by recessing the inner face of the wrench jaw, fitting the oil can therein with its elastic wall projecting into the space between the jaws and place its jet orifice near the outside of the jaw face, and a new and advantageous result is produced. The first motion of the wrench handle forces the nut against the can, ejecting the oil upon the rusted parts, while continued motion in the same direction loosens the lubricated nut. This



is a clear combination due to the exercise of invention in so arranging or constructing the parts, each old in itself, that an improved result is produced. *Thatcher Heating Co. vs. Burtis*, 121 U. S., 286, justifies the grant of a claim for such a device.

To place a can opener on the handle end of a bottle decapping tool is an aggregation, since each produces its own result and no more.

Change the position of the knife edge to the inner curve of the fulcrum arm of the decapper, where it is protected, by the overhang of the decapper claw and fulcrum point, while the cam shaped back of the fulcrum arm serves as a rolling fulcrum for the can opening blade, and we again have a clear case of patentable combination due to change of position.

In the *Tower vs. Bemis et al.*, decision, above noted, it is stated that there is no patentable invention in broadly combining two forms of wrench in a single tool. So position them that their joint operation is due to a single element and a patentable combination may result. Class 81-77 is made up of just such cases.

The same result follows where an intermediate jaw is placed between the jaws of an ordinary pair of pliers, doubling the efficiency of the tool by its co-operation with each.

While in cases like the above legitimacy of the combination must be admitted, care must be exercised that this positioning is not too freely treated as a ground for allowing claims.

Though the Constitution gives to Congress power to pass enabling legislation, I find neither in the Revised Statutes, nor in the decisions of the Federal Courts any authority for granting patents for structures which possess convenient and commercial advantages, but are made up of independent parts each of which is unaffected by the presence or absence of the other. I refer to aggregated tools or other parts in so-called articles of manufacture. "The beneficiary must be an inventor and he must have made a discovery. The statute has always carried out this idea. . . . So it is not enough that a thing shall be new, in the sense that in the shape or form in which it is produced it shall not have been before known,

and that it shall be useful, but it must under the Constitution and the statutes, amount to an invention or discovery."

Thompson et al. *vs.* Boissellier et al., 31 O. G., 377.

I will mention one more example, illustrating an extreme type, which yet has its advocates.

A ring having an inward extension on which is pivoted a screw-driver, adjacent lugs on the face of the ring with which the ends of the screw-driver may engage to hold the parts in fixed relation, when the screw-driver is not in use, and a twine cutter blade projecting from the exterior of the ring.

Herein is no community of operation, but rather a negation of results. The ring with its lugs protects the pocket of the carrier from being torn by the screw-driver blade, while the projecting blade of the twine cutter insures the opposite result. Graphically stated  $+1-1=0$ , and assuredly in such a case is neither invention nor utility. Each element may be patentable by itself, but where the result of their sequential use is the obliteration of any practical joint result, there can be no justification under the present law for the issue of a patent. For this reason I can find no justification for the theory that were the *Reckendorfer vs. Faber* (92 U. S., 347, Sup. Ct., 1875), case to be retried now, the Supreme Court would reverse its judgment, for there, as in the above illustration, we have as the only result of the alleged combination  $+1-1=0$ , means for making a mark, means for erasing the mark, conjointly producing nothing.

January 14, 1915.



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# ESTABLISHING NOVELTY BY AFFIDAVITS

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*A report read September 24, 1916, before the Examining  
Committee of the United States Patent Office*

by

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U. S. Patent Office

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WASHINGTON, D. C.

1916

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# Establishing Novelty by Affidavits.

By

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It is provided in Rule 76 that, when an application is rejected on reference to an expired or unexpired domestic patent which shows or describes but does not claim the invention, or on reference to a foreign patent, or to a printed publication, or to facts within the personal knowledge of an employee of the Office, affidavits or depositions supporting or traversing these references or objections may be received. There are some other classes of cases in which affidavits may be received to establish novelty but this paper will be confined chiefly to the ones above mentioned.

When claims are rejected on facts within the knowledge of an employee of the office, if the applicant requests it, the employee must make an affidavit supporting the facts. The applicant may then submit affidavits to contradict, explain or antedate the facts recited in the affidavit of the employee. For example, the facts set up in the affidavit of the employee may not carry the anticipation back two years from the filing date of the application in which case applicant will be permitted, if he can do so, to overcome the anticipation by an affidavit similar to those which may be filed under Rule 75, thus establishing the novelty of his device.

The other three classes of references above referred to are domestic patents which show but do not claim the invention, foreign patents, and printed publications. These three classes of references are grouped together

and may be overcome by affidavits filed in accordance with the provisions of Rule 75.

Rule 75 provides that—

“When an original or reissue application is rejected on reference to an expired or unexpired domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, and shall also make oath that he does not know and does not believe that the invention has been in public use or on sale in this country, or patented or described in a printed publication in this or any foreign country for more than two years prior to his application, and that he has never abandoned the invention, then the patent or publication cited shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication be more than two years prior to the date on which application was filed in this country.”

Briefly, the affidavit must state *facts* which show that applicant had invented his device prior to the date of the reference. What is the meaning of the word *facts* as used in this rule? A statement of applicant's own conclusions drawn from the facts within his knowledge without revealing those facts can not be accepted because that would not comply with the terms of the rule. The facts are required in order that it may be ascertained whether applicant's conclusions are warranted.

Suppose a case in which the state of facts is, that applicant had, before the date of the reference, fully evolved in his own mind the device disclosed in the application complete in every detail, one element, then another and so on until he had finally and fully conceived the combination of all the elements together in the completed machine, but that he had never described this to

any one or made any model or drawings thereof, or any other manner of record. This may be a true statement of facts which would seem to comply with the terms of the rule in every detail but he should not be granted a patent. He has furnished no proof, that is, no corroborating evidence to support his own statements. In short, he has furnished no proof except his own unsupported statements of prior conception of the invention.

In the first decision rendered on this subject, *ex parte* Gasser, C. D., 1880, page 94, the general principles were laid down as follows:

"The applicant, therefore, must state on oath facts showing either that a reduction to practice had been made before the filing of the application on which the patent was granted, or that the invention had been conceived before that time and by due diligence connected with a subsequent reduction to practice."

The general principle here stated has been quoted with approval in almost every decision on this subject since that time, so that this seems to be the well-established practice up to the present time. While this indicates clearly in general formula what is required, the application thereof to specific cases as they arise is not entirely unattended with difficulty.

It is the intention here to discuss some of the specific cases which may arise and to indicate what conclusions it is believed should be drawn therefrom. In order to bring out the practical problems as they may be presented in actual experience the decision in the case of *ex parte* Donovan, C. D., 1890, page 109, seems to have gone into considerable detail and the following quoted therefrom will serve our purpose:

"In *ex parte* Hunter (C. D., 1889, 218; 49 O. G., 733) it was stated that the rulings in *ex parte* Gasser and *ex parte* Saunders still governed the practice of the Office. Not only does the Office apply the principles laid down in *ex parte* Gasser in cases where it is sought to overcome a reference by an antedating oath, but it is difficult to see how in proceedings even *quasi* judicial, any



other course is permissible or even possible. It is the tribunal, which is to be satisfied that the applicant made the invention prior to the filing date of the reference. The witness states evidential facts which, when assembled, enable the Office to determine, first, whether the invention referred to in the affidavit was the same as that shown and described by the applicant, and, second, whether it was complete within the meaning of the rule before the filing date of the patent cited as a reference. To permit an applicant to prevail upon his naked statement that he conceived the invention and disclosed it to others, without stating by what agency the disclosure was made and the details of which it consisted, is to transfer the seat of judgment and decision from the tribunal sitting in the case to the mind of the applicant—a transaction radically defective in principle and contrary to all judicial usage. If the applicant made sketches, he should so state, and produce and describe them; if the sketches were made and lost, and their contents are remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made, the witness should state, as nearly as possible, the language used in imparting knowledge of the invention to others. By whatever means the applicant claims to have disclosed the invention he must so present those means to the examiner as to enable him to determine whether or not the invention was present in the disclosure. The mere naked statement of the applicant that he disclosed the invention is of no avail, either to constitute evidence of disclosure or to impart sufficiency to a statement of facts in themselves inadequate.”

The inference from this decision is that in a case in which applicant has lost his sketches or models and their

contents are remembered he may present a transcript from his memory and that will be sufficient to overcome the reference. Of what more evidential value is it to furnish a mental reproduction of a drawing which one has made than to furnish a detailed mental reproduction of what was in one's mind, as in the case of the man who has made no record? Has the examiner any more evidence before him from the man who says I made a sketch and lost it, but here is a sketch of my recollection of what it was, than he has from the man who says I did not make a sketch at the time this device was worked out in my mind but here is a sketch of what I had in my mind at that time? Or, in the other case, when the affiant says, I stated in substance this description of my device to A, but he is now dead and I can not furnish his testimony or affidavit? The inference from the decision above quoted is that the examiner should say to the applicant in the one case, your story may be true but you have not made a record of it or told it to any one and therefore it can not be accepted as sufficient. Shall the examiner then say to the applicant in the other case, you admit that you have no evidence, but you say you have had and it is lost, or your witness is dead, and because you have been so unfortunate, you may have a patent on your own unsupported statement? It should be remembered that these affidavits are not specifically required by statute and the affiant stands in no danger of being prosecuted for perjury, this proceeding not being a judicial one. What would it avail a litigant to come before the court and say, I have had witnesses to corroborate my statements but they are now dead, therefore I hand you herewith my recollections of what they knew and could say if they were here.

It has frequently been said that Rule 75 is not statutory and should be abolished. If it is meant by this that the particular mode of proceedings therein prescribed is not statutory, it is true; and some other process for proving the same thing, that is, priority of invention and right to a patent under the statutes, may be substituted therefor. But, if it is meant that when applicant is confronted with a reference antedating his application less than two years he should not be permitted

any opportunity to show that he is entitled to a patent notwithstanding the reference, then the statement that the rule is not statutory seems to be erroneous.

Section 4886 of the Revised Statutes provides as follows:

“Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor.”

Rule 75 constitutes the practice provided by the Patent Office for establishing certain rights which may accrue under the two-year clauses of this section of the statute. It appears that some adequate practice or process must be provided to carry out this section of the statute when conditions described in Rule 75 arise, because applicant may be able to appeal his case to the court and on a proper showing compel compliance with the statute and the grant of a patent.

In my view, the purpose underlying Rule 75 is not only proper but some such practice is necessary in order to carry out the provisions of the statute and give deserving inventors an opportunity to establish the novelty of their inventions by proper and convincing evidence. The great difficulty about the rule is that there is no opportunity to cross-examine the affiant and the case must rest on a *prima facie* showing.

The applicant who has competent evidence to offer, such as original sketches or drawings, or models, or depositions of others as to what he has disclosed to them, gives little difficulty, because he submits his proofs and would, probably, in a majority of cases, be only too glad

to submit to a cross-examination if opportunity were afforded. He should not be denied a patent because there is no provision in the practice for subjecting him to a rigid and searching inquiry. But the best of methods for securing justice may fail if they are not carefully and strictly enforced, and in these cases in which we can have no opportunity to search the mind of the affiant as to the accuracy of his statements it appears all the more important to require rigid compliance with the fundamentals prerequisite to a *prima facie* showing.

It is believed that excuses for not having corroborating evidence to substantiate an affidavit should never be accepted as sufficient. Such excuses, as the witnesses are dead or out of the jurisdiction and can not be found or the records are lost, but as I remember it here is what I could have proved, would not have the slightest standing in any court as a substitute for evidence. These excuses should only be accepted as a legitimate reason for introducing accurate and properly authenticated, that is, certified or clearly proven, copies of original records. For the examiner to accept these memory stories is to allow the applicant to establish his case by his own unsupported statements of what he has done.

While it might work a hardship to deprive one of a patent because he has been so unfortunate as to lose the evidence which would substantiate his case, it seems entirely unsafe for the Office to go beyond the pale of giving an applicant every opportunity to submit evidence to corroborate his statements. If any other course is followed it would appear to amount to nothing more than accepting an *ex parte* statement of conclusions of the applicant. To lower the standard of evidence to mere memory statements of the applicant is to open wide the door for fictions and fabrications.

It is true that a *prima facie* valid patent may be granted simply on a showing of facts. A preponderance of evidence, for example, is not required. It is not so much the quantity of evidence as the quality of it, that will constitute a *prima facie* showing sufficient to warrant the grant of a patent. The showing should be something that has evidential value in the sense of being corroborative of the statements contained in applicant's affidavit. It should be something independent of ap-

plicant's acts or statements during the time of the prosecution of his application, some record or disclosure he made, or some act he performed at the time alleged in his affidavit, which, if genuine or true, shows by its existence or occurrence the truth of his allegation.

It is submitted that the interests of the public and the inventors would be better served by requiring that an applicant to succeed under Rule 75 must furnish in addition to his own affidavit, corroborating evidence in the form of original drawings, sketches, models, or affidavits of other witnesses, or in other words, such competent and convincing evidence as would be admissible under the ordinary rules of evidence.

September 21, 1916.

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# Combination Claims Employing Terms "Means," "Mechanism," etc., Followed by a Statement of Function with Relation to the Statute.

A paper read September 21, 1916 before the Examining  
Corps of the United States Patent Office

BY  
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WASHINGTON, D. C.  
1916

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# Combination Claims Employing Terms "Means," "Mechanism," etc., Fol- lowed by a Statement of Function with Relation to the Statute.

By

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It is not surprising that different views exist and that the practice of the Office has, to say the least, been vacillating with respect to the proper method of dealing with claims for combinations of mechanical elements which define the real invention by such broad and generic terms as "means" and "mechanism" followed by a statement of function. This lack of uniformity in the Office is apparently due to the same lack of uniformity in the courts in dealing with and discussing this type of claims.

It has been contended that this character of claims should not be allowed for the reason that they are vague, ambiguous, and indefinite. Further than this, it has been urged that they do not cover any particular or definite construction, but, when fairly construed, are merely claims for a function. Again, it is held that such claims are broader than the invention, and that they seek to cover any and all means that may hereafter be devised for effecting the stated result or function. This, it is contended, would close the field of invention, in the particular art, to future inventors, and tend to obstruct the progress of the useful arts, rather than to aid the progress thereof. On the other hand, it is held that this type of claims should be allowed, in the absence of any reference which does not respond to the combina-



tion both as to structure and function. This view is held by those who consider that the courts will give to an inventor, no matter what the breadth of terms used in the claim, only what he has invented and produced, and substantially its equivalents, and if the invention is of a primary or pioneer character, greater liberality will be exercised in the inclusion of equivalents.

The first view, above mentioned, as to this character of claims will now be briefly considered in the light of the statute and various court decisions.

Section 4888, R. S., requires that before any inventor or discoverer shall receive a patent for his invention he shall make application therefor, in writing to the Commissioner of Patents, and—

“he shall particularly point out and distinctly claim the . . . combination which he claims as his invention or discovery.”

Do the class of claims now under consideration meet the requirements of the statute above mentioned, or are they vague and indefinite; and fail to cover any definite construction, but seek to cover any and all means for effecting the stated result or function—or do they merely cover a function?

It is thought that the decision of the United States Supreme Court, in the case of *Morley Sewing Machine Co. et al. vs. Lancaster* (C. D., 1889, page 380) will throw considerable light on this subject. The first and thirteenth claims are the only ones that need be quoted since they are a fair type of the four claims relied upon by the plaintiffs:

“(1) The combination in a machine for sewing shank buttons to fabrics, of button-feeding mechanism, appliances for passing a thread through the eye of the buttons and locking the loop to the fabric, and feeding mechanism substantially as set forth.

“(13) The combination, with button sewing appliances, of a trough, appliances for carrying the buttons successively from the trough to the sewing devices, and mechanisms for operating said appliances and sewing devices as set forth.”

In each of the above-quoted claims, it will be found that not a single element, or group of elements, that enter into the combinations, has been structurally defined. On the contrary, each element, or group of elements, is qualified solely by the function performed.

The court, in discussing this case, stated that—

“Morley, having been the first person who succeeded in producing an automatic machine for sewing buttons of the kind in question upon fabrics, is entitled to a liberal construction of the claims of his patent. He was not a mere improver upon a prior machine which was capable of accomplishing the same result; in which case, his claims would properly receive a narrower interpretation. This principle is well settled in the patent law, both in this country and in England. Where an invention is one of a primary character, and the mechanical functions performed by the machine are, as a whole entirely new, all subsequent machines which employ substantially the same means to accomplish the same result are infringements, although the subsequent machine may contain improvements in the separate mechanisms which go to make up the machine.”

It will be noted that in this decision there was not a dissenting opinion by any member of the court. There was not the faintest hint by the honorable court that the claims sued on were not in proper form. Here was one of the clearest examples of combination claims, wherein the elements or groups of elements, entering into the combinations, were each *solely* qualified by the function or result performed. Not a single structural limitation can be found in the above-quoted claims. If these claims were broader than the invention; vague, ambiguous or indefinite; for a function only; or for any and all means radically differing in structure and operation that in the future might be invented for effecting the stated results, will any one seriously contend that the Supreme Court would, for a moment, hesitate to criticise and put their stamp of disapproval on such a type of claim. The

fact that these claims were approved, in their broadest aspect, consistent with the disclosure in the specification, goes to show that, in form, they responded to the requirements of the statute and met with the approval of the court.

One of the first decisions of the Commissioner of Patents bearing on claims of the character now under consideration was the decision of Commissioner Butterworth in *ex parte* Demming, C. D., 1884, page 18. The first and third claims were before the commissioner for consideration. The first claim is all that need be quoted:

"The combination substantially as set forth, of a lock, a bolt, tumbler or tumblers, a dog or dogs for locking one or more of the tumblers in an abnormal position when it has moved past the proper point to permit the movement of the bolt, and means for acting directly on the dog or dogs with the key to restore the lock to its normal position."

In discussing this claim the commissioner said that the only words that distinguished the claim from the prior art were the words—

"and means for acting directly on the dog or dogs with the key to restore the lock to its normal position,"

and if this claim was construed literally it would embrace all constructions or arrangements whereby a certain desired result could be attained. It was further stated that such a claim would cover—

"not only variations, equivalents and modifications of the invention described, but also means substantially different therefrom if such should in the future be invented."

This literal construction placed on the claim by the commissioner does not agree or conform with the interpretation or construction of claims by the courts for the past quarter of a century.

While this decision was intended to make the practice

of the Office uniform, the actual result was, that by reason of a misunderstanding or misapplication of the doctrine laid down therein, the practice became greatly confused. Some examiners construed this decision as prohibiting the use of the words "means, mechanism," etc., in any claim. This decision was followed by several others, involving the same question. *Ex parte* Holt, C. D., 1884, p. 43; *ex parte* Wilkins, C. D., 1884, p. 71, and *ex parte* Paige, C. D., 1887, p. 71. Commissioner Hall, in the Paige decision, above cited, made it very clear that the words "means" and "mechanism" may be properly employed where they refer to mere adjunctive devices readily understood. In instances, however, where such words were used to designate in the claims that portion of the subject-matter in which the actual invention resided, then such claims were too vague and indefinite.

The decision of the Supreme Court in *Morley vs. Lancaster*, above noted, was rendered two years after the Paige decision.

Commissioner Mitchell, shortly after the Morley decision, in *ex parte* Pacholder (C. D., 1890, p. 55) in considering the same question as was involved in the Paige decision, saw the importance and pertinency of the Morley decision to the question then under consideration and stated as follows:

"If the abundant use of the words 'means, mechanism, and appliances' (in Morley's claims) can invalidate them, in view of the statute which requires the applicant to particularly point out and distinctly claim the part, improvement or combination which he claims as his 'invention or discovery' it will be conceded that the claims of Morley were void for indefiniteness. But the court nowhere intimates that such is the case, and proceeds in a learned opinion to show that the Lancaster machine although differing essentially in matters of construction from the Morley machine, nevertheless employed equivalent mechanisms and appliances for accomplishing the same results, and therefore was an infringement. It is impossible to avoid the conclusion that if Morley

had been held to the doctrine that the words 'means, mechanism, and appliances' may not be used in claims, when suitably qualified, he would have been unable to hold as an infringer one who appropriated the principle of his invention disguised in an organization different from that which he showed in his patent in every other respect.

"No general rule can be laid down for governing the employment in the claims of patents of such words as those under consideration. It is the object of the law, as it is the solicitude of this Office, to protect inventors and guard their inventions. . . . In the case, however, of patents which represent the infancy of an art or the stage of its earliest practical development, this Office is equally solicitous that the inventor should be accorded a breadth of claim which is commensurate with the extent and importance of the invention which he desires and is entitled to protect. . . . Of course, in all such cases while the Office will insist upon as much definiteness in the language of the claim as the statute calls for, it will also, if it properly discharge its function as the protector of the inventor leave something to the salutary and benignant agency of construction in the courts.

"As I have already indicated, the success of the inventor Morley in holding the Lancaster machine as an infringement was due to the fact that the Patent Office while respecting the statute, did not pervert it to the ignoble use of making it deprive the inventor of the very rights which it was designed to protect and foster."

Following this decision, was the decision of *ex parte* Knudsen (C. D., 1895, page 29). In discussing, in this decision, the class of claims, which mention "means" and "mechanism" qualified by the function attained to the exclusion of specific structural definition, the commissioner stated that this is a class of claims—

"which cause the most trouble, as frequently it is a matter of great difficulty to decide whether

such claims are subject to objection or to rejection or to both. The difficulty, too, is often increased by the fact that a broader construction ought to be given the claim, if it covers a new departure in the art.

"The use of the above noted phraseology does not of necessity render a claim objectionable, for when the idea is clearly stated and the combination or relation of parts to produce a desired end is plainly expressed the breadth of the statement of the claim is no reason for objecting to it. It is only necessary that these expressions shall clearly distinguish what is new from what is old in the art, or from fair equivalents thereof. If they do this, the question is then, one of patentable novelty—that is to say, claims of this order are not objectionable in form, on the ground that they are too broad, but only because they are vague or indefinite. When indefinite, they should be objected to; but they can only be rejected on references when these disclose both the complete combination and the functional qualifications covered by the claim."

It is now generally conceded that the courts, in construing a claim when an element of a combination is referred to by the term "means" or "mechanism," followed by a statement of function, treat it as though it was not the intention of the patentee to cover any and all means for attaining the stated function, but only the practical means described in the specification, or the fair equivalents of such means. In discussing the question in the case of *Washer Co. vs. Cramer* (169 Fed., 629; 95 C. C. A., 157, 3d Circuit), Judge Gray said that the language of the claim should not be considered dissociated from the specification, and that—

"no invention can be practically or fairly understood or explained if such dissociation is absolutely adhered to. As we have already shown the element described in the first claim, as 'means for actuating said lever' must not be taken to be any means such as impracticable hand-power

applied to the lever, but the efficient practical means described in the specification. Reading the claim and the specification together, the invention of the patentee was clearly such an application of mechanical power as would oscillate the tub with all the advantages afforded by the resiliency and retardation of the springs of the standard washer preserved."

In the *Century Electric Co. vs. Westinghouse Elec. & Mfg. Co.* (191 Fed., 350, 354; C. C. A., 8, 12), Judge Sanborn, in applying the rule that the court should seek to ascertain from the terms of the patent, in the light of the circumstances, what was the intention of the contract between the government and the patentee said:

"The intention should be deduced from the entire contract, and not from any part of it. The specification, which forms a part of the same application as the claims, must be read and interpreted with them, not for the purpose of limiting or contracting, or of expanding the latter, but, for the purpose of ascertaining from the entire agreement, of which each is a part, the actual intention of the parties, and that intention when ascertained, should prevail over the dry words and inapt expressions of the contract evidenced by the patent, its specification and claims."

The doctrine laid down in the above decision of *Washer Co. et al. vs. Cramer et al.*, and many other court decisions too numerous to mention, to the effect that no patented invention can be practically or fairly understood or explained if the language of the claim is entirely dissociated from the specification, and that the claims and specification should be read together, is a fair and equitable one. Further than this, Judge Shipman, C. C. A., 2d Cir. (57 Fed., 629), in the *Smead Warming & Ventilating Co. vs. Fuller & Warren Co. et al.*, applied this doctrine when he said:

"The construction to be given his patent must correspond with the extent of his invention. The actual invention, if in conformity with the

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language of the claims should control in the construction of patents. A strict construction should not be resorted to, if it becomes a limitation upon the actual invention, unless such construction is required by the claim." (*Merrill vs. Yeomans*, 94 U. S., 568; *Railroad Co. vs. Mellon*, 104 U. S., 117).

It is perfectly clear, therefore, from the above decisions, and many others well known to us, that the courts, in interpreting claims consider it their duty to read the claims in the light of the specification, in order to get a full and clear understanding of what the patentee has actually invented, and the principle and operation of the invention. In many instances, when a patentee through inadvertence or ignorance, has unnecessarily placed structural limitations on his claims, the courts have resorted to the specification in order to enable them to see if the invention was a primary one. If so, they would place a liberal construction on the range of equivalents, and thereby give the patentee an interpretation of his claim, commensurate with the invention disclosed by him.

We are all aware, of course, that it is well established and settled practice of the courts that claims for a "primary" or "pioneer" invention should be given considerable liberality of construction. It is not always a very easy matter, however, to determine what are pioneer inventions, in cases of patents such as the Morse electrical telegraph, the Howe sewing machine or the Bell telephone, no trouble would be experienced in determining their character. Many instances frequently arise, however, which require considerable thought and consideration in order to determine whether or not they should properly be classed as pioneer inventions. Take, for instance, the definition of a "pioneer" invention, as given by Mr. Justice Brown in U. S. Supreme Court decision in case of *Boyden et al. vs. Westinghouse et al.* (C. D., 1898, page 443). In speaking of the word "pioneer" as applied to inventions the court said:

"This word, although used somewhat loosely, is commonly understood to denote a patent



covering a function never before performed, a wholly novel device, or one of such novelty and importance as to mark a distinct step in the progress of the art, as distinguished from a mere improvement or perfection of what had gone before."

Under the above definition, any new combination of elements, or groups of elements (whether such elements are old or new) which effect a new and useful result or function, never before performed, constitutes an invention properly coming within the range of pioneer inventions. An invention, in order to come within the class of "pioneer" inventions, certainly under the Supreme Court definition of the term above given, does not have to be extremely radical or revolutionary in its character, but if it produces a novel and desirable result or function it falls within this class of inventions.

In support of the allowance by the Office of the class of claims under consideration, attention may be called to the following decisions and brief quotations therefrom:

In the *Monash Younger Co. vs. National Steam Specialty Co.*, 208 Fed., 559 C. C. A., 7th Circuit, it was held that "means" qualified by the function performed did not preempt the entire field of invention but that the patentee was entitled only to the means disclosed, or their fair equivalents.

In *Arnold vs. Tyden*, 193 F., 410, the same Circuit Court of Appeals held that: "In the Paper Bag Case, 210 U. S., 405, Sup. Court, 748, the Supreme Court held "that claims for means are valid when the specification clearly discloses the particular means or mechanism having the function indicated in the claims." Under this rule held that the claims of the Tyden patent, No. 675,577, should be sustained.

The C. C. A., 8th Circuit, 1909, in *Demming Wire and Fence Co. vs. American Steel & Wire Co.*, 169 Fed., 793-799, held that the following claim which covered combinations of "means" and "mechanism" qualified

by functional statements to be not void as covering merely a function, or the function of a machine:

“In a wire-fence machine the combination of mechanism for intermittently feeding a plurality of longitudinal strand-wires, mechanism for intermittently feeding a plurality of stay-wires simultaneously and transversely of the strand-wires, mechanism for cutting off suitable length of the stay-wires to span the space between the strand-wires, and mechanism for simultaneously coiling adjacent ends of the lengths of the stay-wires around the strand-wires.”

The U. S. Supreme Court, 1909, Leeds & Catlin Co. *vs.* Victor Talking Mach. Co., and U. S. Gramophone Co., 144, O. G., 1089, held that a claim for a sound-producing apparatus consisting of a traveling tablet having a sound record formed thereon and a reproducing stylus shaped for engagement with said record and free to be vibrated and propelled by the same is not for the function of the machine, but sets forth a valid combination.

It must be admitted that the courts not only consider it their right, but their duty, irrespective of the form of the claim before them, to resort to the specification in order to find out the real invention, in interpreting and construing a claim of a patent. This course they pursue whether the claim is expressed in broad or limited terms, in order to determine whether the invention is of a primary or pioneer character or merely a limited improvement on the prior art, so that the range of equivalents may be broadened or limited in accordance with the character of the invention disclosed. In view of the above facts, therefore, what valid objection can be urged against the allowance by the Office, of claims for a combination of mechanical devices, which effect a desirable result, never heretofore attained, when the devices or elements of the combinations are included in the claims by the generic and all-inclusive terms as “means” or “mechanism” qualified by a statement of function performed? The objections herein above men-

tioned that such claims do not respond to the requirements of section 4888, R. S., and that they are for a "function" and that they are "vague and indefinite" and "broader than the invention" have, it is thought, been disposed of by the decisions of the U. S. Supreme Court and various Circuit Courts of Appeal, herein called to attention. There was another objection to claims of this character that has been urged by the Office, and that was to the effect that the construction covered by a claim should be set forth in such a clear, concise, and exact manner, that the court would not have to be compelled to resort to the specification in order to find out what was the exact invention intended to be covered. This objection, however, is without weight, since the courts have asserted their right and duty to consider the specification in connection with the claim, not to save the claim, faulty in character by reason of its broad and generic terms, or to remove therefrom its apparent structural limitations, but solely for the purpose of discovering the principle and operation of the invention, so that they could then determine the proper range of equivalents to be given to the construction covered by the claim.

We all know how very difficult it is, in view of the limitations of language to place structural limitations on the mechanical elements of a combination that happen to be selected to carry out the principles and operations of a pioneer invention. In doing this how often a meritorious inventor is needlessly deprived of the full measure of his invention. A structural limitation, at the time of drawing the claim, may appear to be broadly expressed, and essential to the carrying out of the principle and operation of the discovery or invention. At a subsequent time, when greater light is thrown on the subject, this limitation may clearly appear to be an unnecessary one. In the absence of any reference showing a combination of elements effecting the new and desirable function, stated in a claim, why should not the broad and all-inclusive terms "means" and "mechanism" followed by a statement of function be permitted?

In view of the decisions of the U. S. Supreme Court as well as the majority of the Courts of Appeal of the different circuits herein mentioned, would any one

(other than a defendant to a suit brought on a claim of the type under consideration, for a broad invention) urge that the claim was for a "function" or for *any* means that might in the future be invented no matter how radically different they might be from the specific means disclosed.

It is thought that the weight of the decisions of the courts, in recent years, tend to support the view above maintained that in the absence of any reference showing the "means" as well as the function, stated in the claim, a patentee will be given and is entitled to protection, only for that which he has invented and produced and the substantial equivalent thereof no matter what the breadth of the terms employed in the claim.

It might be urged upon a cursory reading of the decision in the *Davis Sewing Machine Co. vs. New Departure Mfg. Co.* (C. C. A., 6th Circuit, 217 Fed., 775) rendered by Judge Dennison, who was so kind as to address us here two years ago, that an inventor should be permitted to employ the terms "means" and "mechanism" qualified by function, only when such terms are intended to include elements or parts already well known in the art and designed to cooperate with some new element or parts in order to make a completely operative combination. Such terms, however, qualified as stated, should not be used to include the *real point or gist* of the invention. Upon a careful consideration of this decision in the light of the other court decisions discussed therein, it will be found that the doctrine laid down therein does not differ from that found in the Supreme Court decisions of *Westinghouse vs. Boyden*; *Morley vs. Lancaster and Paper Bag case* (C. D., 1908, page 594). This doctrine, briefly stated, is in effect that when an inventor is merely an improver in an art, and has produced a construction or combination intended to effect some result in a better or more perfect way than it had heretofore been performed, and in order to do this he has produced a specific construction, then the real invention resides in the specific construction and the claim should be couched in such definite and exact terms, as to *structurally* differentiate the invention from inventions of the prior art, designed for effecting the same result or func-

tion. Even in claims for a mere improvement in the prior art, the doctrine of equivalents may be invoked, but, in such instances, the range of equivalents is greatly limited, as compared with a claim for a new combination of mechanical elements, which perform a desirable and useful result never before effected by mechanical means.

It is contended that under the doctrine of construction of claims as laid down by the courts, it is first necessary to ascertain from the description and claim what was the real purpose and intent of the inventor. If the purpose was to accomplish a desirable result or function never before attained by mechanical means, and, in order to do so, he selects a plurality of old or new elements, or groups of elements and cooperatively combines them and thereby effects this result, then the invention falls within the range of "pioneer" inventions. In such a case these new or old "elements," or groups of elements, may be included in a claim by the broad and all-inclusive terms of "means" or "mechanism" properly qualified by a statement of result or function performed. On the other hand, however, if on reading the specification and claim we find that the inventor merely proposes to perform in a simpler and probably more perfect way, some useful and desirable function, heretofore attained by mechanical means, then the inventor should be classed as a mere improver in the art, and his claims should not be permitted to define his specific construction, or *actual* invention by such broad terms as those under consideration, but the terms employed should bring out structural limitations in order to differentiate the construction claimed from the constructions of the prior art.

If an inventor has succeeded in producing a novel machine by cooperatively combining, say, for example, three old elements, or groups of elements, and the mechanical function performed, as a whole, is entirely new, then it is thought no one at this time will question the propriety of these elements or groups of elements being included in a claim by the broad terms of "means" and "mechanism" qualified by function. On the other hand, if before making this new combination of old devices, the inventor desires to go a step further, and

effect, not only the first mentioned new result or function, but an additional new function, and he discovers that by a slight modification in the construction of one or more of the old elements he will effect this *plurality* of new results (as was the case in the Morley machine) will any one contend that he would not be entitled to as much latitude in expression, in protecting his invention or discovery, as he would have been if he had not displayed such a high degree of invention? To hold otherwise would be tantamount to the contention that one who has shown a very high degree of originality should be more limited and restricted in the use of the terms employed in protecting his invention, than one who has disclosed an invention in lesser degree.

September 21, 1916.



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# NON-ANALOGOUS USE

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*Supplies and Delivery of Medicine for Examination  
Copy of the United States Patent Office*

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WASHINGTON, D. C.  
1917

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# Non-Analogous Use

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It is settled by many decisions of the U. S. Supreme Court:

That the application of an old process or machine to a similar or analogous subject, with no change in the manner of application, and no result substantially distinct in its nature, will not sustain a patent, even if the new form of result has not before been contemplated. (Blake vs. San Francisco, 113 U. S., 679-82.)

Such application results in a mere "double use" as defined by Robinson (Vol. 1, p. 354), as follows:

To almost every operative means uses are possible which depart from the inventor's method of employing it in such essential particulars that they could have originated in an inventive act distinct from and posterior to his, and thus, as uses, constitute separate inventions. And there are other uses, even more widely different from his in their appearance, which nevertheless are, in their essence, merely imitations, of his own, and therefore are embraced in his invention. This latter class of uses long ago received the name of "Double Uses."

If, however, there has been any change whatever in the old process or machine its identity is lost and there can be no technical double use under Robinson's rule. In many cases the courts have not applied the rule so strictly and have held patents to be void on the ground of double use where there were some changes in the

original device, but the changes were not material and the device was substantially the same. In cases of double use, therefore, the process or machine, its operation and function and the result must remain substantially unchanged while the arts involved must be similar or analogous. Varying any one of these elements eliminates the possible double use and the device in question may or may not be patentable depending on other rules for the determination of patentability.

In many cases it has been held merely that the "use" under consideration was analogous or non-analogous without applying the terms to the arts.

As indicating the law on the subject, the following decisions are of interest:

*Potts vs. Creager* (155 U. S., 597), as cited in *Stearns vs. Russel* (85 F., 218, 227, 228):

In that case the patentee had taken the cylinder of a wood polishing machine, containing a series of glass bars, fitted into longitudinal grooves in the periphery of the cylinder, and, discarding the glass bars, had substituted others of steel, and provided the cylinder thus changed with an abutting roller, and then used it, not for wood polishing but for disintegrating clay.

The Supreme Court held the patent valid, saying:

If the new use be so nearly analogous to the former one, that the applicability of the device to its new use would occur to a person of ordinary mechanical skill, it is only a case of double use, but if the relations between them be remote, and especially if the use of the old device produce a new result, it may at least involve an exercise of the inventive faculty.

In *Hobbs vs. Beach* (C. D., 1899, 372), the Supreme Court held:

That a machine for attaching gummed strips to the corners of paper boxes is not anticipated by machines for stitching wire or attaching metallic stays, since, although the possibility of adapting

the devices to that use might occur to an ordinary mechanic, it could not be carried into effect without the employment of something more than mechanical skill.

Held further, that a machine for attaching gummed strips to the corners of paper boxes is not anticipated by a machine for feeding, cutting, and pasting addresses, although by strengthening it and changing it in certain particulars it could be adapted for use. While there is analogy there can scarcely be said to be similarity in the functions of the machines.

Held, that the changes in the prior devices to adapt them to perform the wholly different function of the patented machine was a minor part of the work involved, the invention consisting rather in the idea that such change could be made than in making the necessary mechanical alterations.

Where addressing machines had been on the market for many years, and yet it never seems to have occurred to anyone engaged in the manufacture of paper boxes that they could be made available for the purpose of attaching strips to the corners of boxes, Held, that this fact is evidence that the man who discovered the possibility of their adaptation to this new use was gifted with the prescience of an inventor.

In many of the cases as above the result secured in the new application is emphasized as may be seen by the following decisions:

A mere carrying forward, or new or more extended application of the original thought, a change only in form, proportions or degree, the substitution of equivalents, doing substantially the same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent. (*Smith vs. Nichols*, 21 Wall., 112-119.)

(C. C. A., 7th Cir., 1915.) The discovery that a described metal alloy in stated proportions when

used as an electric resistance element is far superior to any previously known except platinum, the cost of which precluded its commercial use, with the result of greatly advancing the art, constitutes patentable invention, although the alloy itself was known. (*General Electric Co. vs. Hoskins Mfg. Co.*, 224 F., 464.)

The use of a structure for an air brush in painting pictures that is old in an injector oil burner is not double use owing to the great difference in the matter of application. The adaptation of the idea of the oil distributing device to the pencil sized air brush involves several inventive steps.

In this case there was also a slight difference in structure but not sufficient to render the structure "new." (*Thayer & Chandler vs. Wold*, C. C. Ill., 142 F., 776.)

The mere fact that it was old to vulcanize together an inner rubber tube, an intervening fabric, and an outer rubber cover, in the rubber hose art and in the rubber gasket art, does not prove that there was no invention in the application of such a method of construction, with such modifications as must be made, to a pneumatic tire. Although hose pipes and gaskets had been manufactured for years prior to the Tillinghast invention, it did not occur to any skilled mechanic that their method of construction could be successfully applied to the production of a pneumatic tire. (Patent No. 497,971.) (*Single Tube Automobile & Bicycle Tire Co. vs. Continental Rubber Works*, 174 F., 50.)

A machine for wrapping an annulus by a mechanism of an annular shuttle is not an anticipation of a machine for wrapping an automobile tire that was made up of several loose and separate parts which had to be compressed and held together tightly while being wrapped, the latter device involving the solution of a new problem which required changes in prior mechanism.

(William R. Thropp & Sons Co. *vs.* De Laski & Thropp Circular Woven Tire Co., 226 F., 941.)

A light transmitter consisting of a pane of glass having a series of parallel triangular projections or prisms on one side and on the other parallel and uniform convex projections or lenses placed edge to edge is not anticipated by a similar pane of glass in which the only significance given to the convex projections is that they afford a "safe and secure foothold for pedestrians when the glass forms part of a sidewalk." (Daylight Prism Co. *vs.* Marcus Prism Co., C. C. Penn., 110 F., 980.)

Held, that coating a metallic wire with gutta percha for the purpose of making an insulated electrical conductor was not a mere double use of a wire similarly coated to prevent mechanical abrasion but a non-analogous use thereof. (U. S. Circuit Court, Southern Dist., N. Y., C. D., 1878, 440, Colgate *vs.* Western Union Telegraph Co.)

A new combination and arrangement of old parts, whereby spinning—spindles instead of running in rigid bearings are flexibly mounted on the rails, so as to allow of greatly increased speed of revolution, held to involve invention and not to be anticipated by the use of similar devices in centrifugal machines for drying sugar or creaming milk. The two devices are so different in size, structure, and uses to which they are adapted that it is not a case of double use. The object of flexibly mounting the hydroextractor was to prevent the jar and concussion which arise from the great weight of the machine and not to increase its speed as in the patent in suit. (Taylor *vs.* Sawyer Spindle Co., C. D., 1896, 546.)

The Barrell patent No. 636,482 for a drier felt for paper machines involving a double-ply fabric held together by binder warps smaller than the face warps of the plies, held to involve invention over the prior art, although the use of a single ply fabric was old in the same art, and similar

binder warps had been used in carpet making to unite a two ply fabric. (*Fitchburg Duck Mills v. Barrell*, 214 F., 777.)

The art of dyeing and of leather making are wholly unallied, and therefore the doctrine of double use has no pertinency. The question is not whether the agents employed and their influence each upon the other are the same, but whether the same practical result, or a sufficiently related one, is produced in the one case as in the other. In "dyeing and printing on fabrics" and in the "treatment of wools" the end finally accomplished is not at all analogous to that of manufactured leather. The same ingredients may be used to reach the one result as the other; but they are not used for a like purpose. They do not affect the different material in the same way, and the product evolved in the one case is wholly unlike the change effected in the other. The fact that hides are substituted for fabrics or wool and that the thing produced is leather and not dyed fabric or treated wool distinguishes the two processes. (*Tannage Patent Co. vs. Zahn, C. D.*, 1896-119.)

But compare:

Where dyes of all kinds, including anilin black, had previously been in public and general use for dyeing all kinds of materials, there was no invention in applying them as distinguished from stains and pigments, to leather. (*Electric Boot & Shoe Finishing Co. vs. Little et al.*, 138 F., 732.)

If an inventor finds a chemical substance devoted to a particular use, conceives the idea of applying it to a new purpose, and on experiment discovers that the substance must be treated in a particular way to suit his purpose, which method of treatment is essential to his end, but of less importance in obtaining the prior art results, he may be a real inventor, even though he selects a specific treatment in an occupied field. (*Perkins Glue Co. vs. Waterproof Glue Co. et al.*, 223 F., 792.)

"It is entirely clear that the respective uses to which the" machines for holding and dispensing cartridges and cork cabinets cited, "were designed to be put are not analogous to the patent in suit," a device for storing and dispensing individual drinking cups. "The relations between them are remote. A new and valuable result has been produced. The device of the patent in suit has gone into general and extensive use and displaced other devices for dispensing individual drinking cups, and for that matter is the only practicable substitute for the public drinking cup which has yet been found, thereby supplying a recognized want. These considerations are sufficient to turn the scale in favor of invention, when it is in doubt." (*Individual Drinking Cup Co. vs. U. S. Drinking Cup Co.*, 220 F., 331.)

The Rembusch patent, No. 937,550, for a screen for use in exhibiting moving pictures and stereopticon views, and consisting of a sheet of plate glass having its back silvered and its front, whereon the picture is thrown by a lantern, ground, was not anticipated by the use in the sign art of mirrors having letters or designs etched or ground on their front. (*Rembusch vs. Benneth et al.*, 214 F., 257.)

The use of a composition as a waterproof lining for a reservoir did not anticipate a subsequent patent for a street pavement made of a similar composition. The conditions involved are so materially different as not by any means to make the solution of one the solution of the other. (*Warren Bros. vs. The City of Owosso*, 166 F., 309.)

Where a process is used under new conditions and produces new and extraordinary as well as highly satisfactory results, Held that it must be regarded as patentable. (*R. Thomas & Sons Co. vs. The Electric Porcelain & Mfg. Co. et al.*, 111 F., 923.)

Old mechanism, fully capable of a use not then observed, anticipates a later patent for the application of that means to that use. Patentability can not rest on the observation in a given device



of a usefulness not before noticed. (*William B. Mershon & Co. vs. Bay City Box & Lumber Co.*, 189 F., 741, 745.)

A device for performing additive subtraction including pivoted levers for throwing carrying pawls out of operation, Held, patentable as involving a new use of old mechanism. The invention resides more in the idea that the change could be made rather than in making the necessary mechanical alterations. (*Comptograph Co. vs. Mechanical Accountant Co.*, 145 F., 331, 336.)

Under special circumstances, as in the conversion of alternating currents of electricity into a continuous current, where a particular practical application of a known principle proves to be of advantage in the arts, and the thought of making it had not occurred to those expert therein, such application, at times, involves invention. (*Westinghouse Electric & Mfg. Co. vs. Stanley Instrument Co.*, 133 F., 167.)

We must not be misled by the apparent resemblance between a device taken from an industry and applied to a new use in another when the original inventor never designed or actually used the device for the purpose to which it has been put. (*National Tube Co. vs. Aiken*, 163 F., 254.)

The use of tenons for securing cover strips to the buckets of a turbine held not anticipated by the prior use of a similar construction in a propeller wheel and in vehicle wheels. "Under the patent law, the inventive faculty resides in the reduction of an idea to practice as distinguished from merely making mechanical alterations, and whenever an old device is put to a new use, and such use produces a new result, a question of fact arises as to whether such adaptation would occur to a person of ordinary mechanical skill." (*General Electric Co. vs. City of Dunkirk et al.*, 211 F., 658, 662.)

In others the remoteness of the arts is emphasized.

Where an instrument for measuring alternating currents differs from an alleged anticipatory device

only in proportioning the coils and various parts of the apparatus and reducing to a negligible amount the disturbing effect of self-induction, but thereby the direct current double coil instrument could be so adapted to the peculiar conditions characteristic of the alternating current as to result in a practical instrument for measuring the differences of potential in an alternating current circuit, invention is involved. (*Weston Electrical Instrument Co. vs. Stevens et al.*, 134 F., 574.)

Although it is well established that where a particular device is used in one art to accomplish a specific purpose, it is not invention to transfer the same device to another art and there employ it to accomplish a similar purpose, yet this doctrine does not apply where the device sued upon is a glass body for administering volatile liquids and adapted to be held in the hand until the heat thereof volatilizes the liquid, and the alleged anticipation is a laboratory device for determining the specific gravity of highly volatile liquids which, through a defect in the instrument, may discharge a jet of volatilized liquid when held too long in the hand. (*Fries et al. vs. Leeming et al.*, 131 F., 765.)

Where the invention relates to finger rings, Held that the expedient of forming shoulders within holes in the band with which shoulders on the stud engage would not be suggested to one skilled in the art by a similar construction in street-signs. Street-signs and finger-rings are not in analogous or correlated arts. A large wooden sign would not naturally be taken as a model for the construction of a delicate finger-ring. (*In re Weiss*, C. D., 1903, 546.)

But compare with the following:

It does not involve invention to apply to a stick-pin, for the purpose of holding it and preventing its accidental withdrawal, a combination of element which has been used to hold or fasten a hatpin,

window fittings, sockets, straps, lines, brooms, tools, and implements, although it required considerable mechanical taste and skill to reduce the size of the elements of those old devices and change the form of construction so as to produce a small, neat, and, in a sense, useful device to serve a useful purpose in combination with a stickpin. (*Capewell vs. Goldsmith et al.*, 138 F., 682, N. Y., 1905.)

A patent covering a successful and useful panel section in a metallic ceiling is not to be defeated by showing a prior bird-cage bottom, tea tray, or coal-vase cover, resembling in mere outline of form the patented panel; these things being wholly foreign to, and not suggestive of, the use to which the patent relates. (*Kinnear and Gager Co. vs. Capitol Sheet Metal Co.*, 81 F., 491.)

Whiffletrees and bridges are in arts so remote from brake beams for cars that trusses for either of the former purposes can not be permitted to anticipate or limit the scope of patents for the latter. (*National Hollow Brake-Beam Co. vs. Interchangeable Brake-Beam Co.*, C. C. A., 8 Cir., 100 F., 693.)

Certain devices (as nut locks) are common to the arts as a whole because they are adapted for use in many situations. In *re Morgan C. D.*, 1912-481.

In a suit on patent No. 1,052,270, for a demountable automobile wheel rim, it was held:

Patent No. 4,447, 1846, and No. 405,710, 1889, showing railway car wheel structures with rims intended for being mounted permanently ought not to be regarded as fairly in the prior art under examination. It strikes me that such structures apply to a foreign art. But, if I am wrong in so regarding them, still they could not be claimed to disclose a solution of a problem in the art of automobile wheels. In the car wheel art the object was to get the rim on just as tight as it could be put on and to mount it nearly with

permanency, and in doing so the greatest amount of contact surface was provided between the rim and the wheel body of the car wheel. (*Perlman vs. Standard Welding Co.*, 231 F., 453-734.)

As further examples the following devices have been held to be in remote or non-analogous arts:

Railway frogs and suspended electrical conductors. (*Thomson-Houston Electric Co. vs. Ohio Brass Co.*, 130 F., 542.)

Lamps and stoves and furnaces. (*Schlicht Heat, Light and Power Co. vs. Aeolipyle Co.*, 117 F., 299.)

Clothes driers and tilting drawers. (*Rosenblatt vs. Fiorer Tablet Trit. Mfg. Co.*, 106 F., 733.)

Horse rakes and weeding machines. (*Hallock vs. Davison*, 107 F., 482.)

Mechanical and electrical arts. (*Gen. Electric Co. vs. Bullock Electric Mfg. Co.*, 152 F., 427.)

Weaving and music. (*Kip-Armstrong Co. vs. King Philip Mills Co.* 130 F. 28.)

A railroad journal and an ancient coin. (*Ajax Metal Co. vs. Brady Brass Co.*, 155 F., 409.)

Motors used in steam engines and those used in piano players. (*Aeolian Co. vs. Hallet & Davis*, 134 F., 872.)

A gas pipe in a house and a water or gas pipe under ground. (*Worcester County Gas Co. vs. Dresser*, 153 F., 903.)

Boilers and cooking vessels or soda water tanks. (*Monroe vs. Erie C. I. Works*, 143 F., 989.)

A process of making steel and a process of making nickel and cobalt and their compounds. (*A. S. Mitis Co. vs. Midvale Steel Co.*, 135 F., 103.)

A carpet duster and a chimney of a blast furnace. (*Patents Selling & Exporting Co., vs. Dunn*, 204 F., 99.)

A cap for a talcum powder bottle and a cap on a dredge for salt. (*Westmorland vs. Hogan*, 167 F., 327.)

Lamp sockets and bottle caps or thimbles. (*General Electric Co. vs. Freeman*, 190 F., 34.)

Pneumatic tires and hose pipes or gaskets. (*S. T. A. & B. T. Co. vs. C. R. Works*, 174 F., 50.)

The revolving bowl of a cuspidor and a water motor (*Justi vs. Clark*, 108 F., 659.)

Shape rolling and plate rolling of steel (branches but not analogous). (*Donner vs. A. M. S. & T. Plate Co.*, 160 F., 971.)

A steel pavement and a lining for a reservoir, a floor or a concrete foundation. (*Warren Bros. vs. Owosso*, 166 F., 309.)

Lathes and drill frames. (*Ex parte Sheldon*, 135 O. G., 1585 (1908)), and—

Devices for topping onions and husking corn. (*Vrooman vs. Penhallow*, 179 F., 296.)

On the other hand the following devices, etc., have been held to be in analogous arts:

Mangles and washing machines. (*Benbow-Brammer Mfg. Co. vs. Richmond Cedar Works*, 149 F., 430.)

Blast furnaces and air locks. (*O'Rourke Engineering Construction Co. vs. McMullen*, 150 F., 338.)

Cutlery polishing and cutlery grinding machines. (*Dieg vs. Borgfelt*, 189 F., 588.)

Resawing and hub mortising machines. (*Mershon & Co. vs. B. C. B. & L. Co.*, 189 F., 741.)

Edger and resawing machines. (*Ibid.*)

A reenforcing band for a phonograph horn and a hoop for a barrel. (*Excelsior Drum Works vs. Sheip & Vandergrift*, 173 F., 312.)

Display rack and meat tree. (*Fitzgerald Meat Tree Co. vs. Nelson Morris & Co.*, 142 F., 763.)

A bed slat and a bath seat. (*Silver vs. Eustis*, 142 F., 525.)

Photography and blueprinting. (*Elliott vs. Youngstown Car Mfg. Co.*, 181 F., 345.)

Toy banks and animal traps. (*Burns vs. Mills*, 143 F., 325.)

A revolving billiard cue rack and a revolving table or bottle caster. (*St. Germain vs. Brunswick, C. D.*, 1890, 333.)

A workman's time card and a car mileage indicator. (*International Time Recording Co. vs. Bundy Recording Co.*, 177 F., 933.)

Propulsion of vessels through water and locomotion on land. (*In re Faure, C. D.*, 1890, 425.)

A device for lowering and fastening a window sash and a similar one for similarly operating a grain platform. (*Deering vs. McCormick, C. D.*, 1890, 434.)

Whether the arts involved are or are not analogous is frequently a somewhat difficult question to answer. We must be guided by the decisions in particular cases (which usually relate to but two arts) and apply the principles brought out to the case under consideration.

In determining whether arts are or are not analogous the meaning of the word "art" is material. There appears to be but a very general relation between the term and the Patent Office classification. It is commonly used in a much more limited sense than to indicate a main or general class of patents, while in many subclasses there are devices having widely different structure operation and function. We can not safely take a completed device as a guide for if we did there would be few if any arts that would be held to be non-analogous. For example, a modern fully equipped automobile involves features and details coming from a myriad of sources and having but little relation to each other except as steps in the manufacture and parts of the completed machine. It must obviously, therefore, be used in a quite limited sense. Here lies one great difficulty in determining what are analogous arts. How far down shall we go in the dissection of a completed machine to reach a point where we can safely say that we have separated all of the arts involved? (After having settled the matter to our own satisfaction the next higher tribunal may say that we went one step too far or a court in passing on the patent may say that we stopped one step too soon.)

For example take a child's cariole which involves the use of both bed springs and screens of wire netting in certain types of which there are many points of similarity. Such a device would bring together the two arts considered in *Locklin vs. Buck* (C. C. 148 F., 715), in which it was held that:

The use of a structure to bind the edges of a fabric made of woven coiled wire springs that was old to bind the edges of a window screen is not double use owing to the great difference in the character of the fabrics and the difficulty in application.

The court also noted the fact that six years had

elapsed between the two applications as evidently indicating that the arts were too remote for the transfer to be readily suggestive.

In 159 F., 434, this case was reversed, the court holding that:

Although the wire fabrics are different, the bed-spring consisting of a series of coils which are flattened in the binding strip, while the fly screen is composed of wires in the same plane, they are not in remote but analogous arts; both relate to woven wire fabrics. The real function of the metallic strip—to bind and hold—is the same in both cases.

Evidently the lower court extended the term “art” in each case to cover the entire manufacture of that particular type of wire fabric while the appellate court limited the term to the binding of the edges thereof. A good example of a limited sense in the use of the word “art” is found in *Eisenstein vs. Fibiger* (160 F., 686), in which it was held that claims for a method of finishing canes of bamboo, etc., by coating them with varnish and baking them, is anticipated by the same method used for japanning other articles, as egg shells, clay pipes, porcelain, steel, iron, and wood. Here the court evidently considered “japanning” an art and not a mere step in making the various articles enumerated, so while limited in one sense it is broad in another, thus covering similar operations wherever found.

Another example is found in the *Ransome Concrete Co. vs. United Concrete Machinery Co.* (165 F., 914), the Circuit Court holding that:

There is no particular analogy between an apparatus for mixing tea and a machine for efficiently mixing concrete.

This case was reversed by the appellate court in 177 F., 413, which held that:

The use of a tea mixer for mixing concrete is a mere double use. The changes made in adapting the device for the purpose indicated do not involve invention but mere mechanical skill.

Here the scope of the art as indicated by the result to be attained was evidently viewed from different stand-points by the two courts.

Another example is the *National Meter Co. vs. Neptune Meter Co.* (122 F., 75), in which the Circuit Court held:

As a matter of applied art, and as affecting the question of anticipation, a water meter and a water motor are not the same—being designed for different purposes—although in structure and general mode of operation they may be the same.

Also:

The conditions to be met in the case of excessive fluid pressure, such as that from water or steam, and that caused by the expanding power of ice at the moment of freezing, are by no means the same due to the fact that water on freezing loses its mobility, and exerts its force, not as a fluid but as a solid.

But the Circuit Court of Appeals in 127 F., 563, in reversing the lower court said:

In both instances, however, relief from the injurious effect of undue interior pressure is the object sought, and in each instance an annular groove or recess is formed in the inclosing head to weaken it.

Also compare *Jones vs. Cyphers* (C. C. A., 2 Cir., 126 F., 753):

The devising of systems of ventilation belongs to a single art, whether such systems are to be applied to a hospital, a sewer, a ship's hold, a cold storage box, an incubator, or any other structure where circulation of air is sought to be secured. Whether houses and incubators are or are not in the same class is unimportant;

and *Seegar Refrigerator Co. vs. American Car & Foundry Co.* (C. C. N. J., 171 F., 416):

The ventilation of sleeping apartments and state rooms, of sheds for storing coal, and other



like compartments are too remote to be considered in connection with the art of refrigeration and freezing.

## EVIDENCE INDICATING REMOTENESS OF ARTS.

The time elapsing between the first use of a device and its transfer to another art is frequently held to be important in indicating the remoteness of the arts. In *El. Con. and Supply Co. vs. Westinghouse Electric and Mfg. Co.*, it was held that:

"The fact that, for eleven years following Beardslee's commutator wheel patent, it does not seem to have occurred to any of those actively engaged in experiments to prevent destructive arcing in electric railway controllers to apply to the solution of the problem the segmented and insulated commutator wheel construction, is convincing evidence that the commutator art and the controller art are not so analogous as to preclude invention in the adoption by Lange & Lamme of their sleeve construction for the purpose of preventing electric arcing in controller drums." 171 F., 83.

Also, in the *Drinking Cup* case, *supra*, it was held that as the references were granted in 1891 and 1896, while the patent in suit not until 1912, this fact indicated invention, citing *Hobbs vs. Beach, supra*.

The patentee may by statements in the specification as to the uses of his invention define or limit the art as indicated in the following decisions:

Where the specification of a patent for a throttle valve designed primarily as a stop for a steam engine states that the device may be applied to shutting off "steam, air, gas or water," the patentee ought not to object to the citation, as an anticipation, of a patent showing a similar valve used in a water pipe. (*Consolidated Engine Stop Co. vs. Landers, Frary & Clark*, 151 F., 775 (Conn., 1907).

The transfer of a registering device from a gas

meter to an electric meter, Held, to involve a mere double use. The objection that the uses were not analogous entitled to little weight in view of applicant's statements in the specification that the device was adapted for use with gas meters, and one claim was broad enough to cover the registering device for whatever purpose it could be used. (Scrafford, 18 Gour., 4-8, Jan. 1906.)

Claims for a staple forming mechanism, designed particularly for making wire fence but not limited in terms thereto, may be anticipated by machines for making and driving staples in the manufacture of boxes, shoes, brushes, or other arts; the field of prior art must be as broad as the field of infringement. (Decree 226, F., 774, affirmed. *Jackson Fence Co. vs. Peerless Wire Fence Co.*, 228 F., 691.)

A patent for a material for making steam packing may involve invention, although a similar material had previously been used for other and wholly different purposes.

Where a patent for a material to be used for a stated purpose involved invention, it is not necessarily rendered invalid by the fact that the patentee also suggests its use for a different purpose, for which alone it would not be patentable.

The Forsyth patent No. 622,889, for a sheet material for packing, matting, and the like, was not anticipated and discloses invention in so far as it relates to a packing material.

While the claim in this case was broadly for a sheet material of certain structure without specifying the use, the case was presented as limiting the use of the sheet to steam packing. In that view the patent was sustained. A patent disclosing a matting for doorsteps, etc., having in part at least a very similar structure was cited as anticipatory. In regard to it the court said:

Even if the complainant's material, as described in his specification and claim would have

been anticipated if used before him for matting, Potts did not strictly anticipate because he did not use it for the matting itself, as a part of the body thereof.

The complainant's material may be of very little use as matting; and very likely, were that the only purpose to which it could be applied, the invention could not be sustained. As, however, in view of its use as steam packing, it involves invention, as we have explained, the mere fact that it might also be used for matting, or that the patentee suggested that it might be so used, would not deprive him of his right to a patent. *Forsyth vs. Garlock*, 142 F., 461.

Knowledge of the two arts by the same set of workmen has been held immaterial. (*Rogers vs. Fitch*, 81 F., 959.)

### **EFFECT OF HOLDING THAT CERTAIN ARTS ARE NOT ANALOGOUS.**

One question that frequently arises is what effect should a court decision that certain arts are remote or not analogous have upon future actions in the Patent Office in considering the question of double use involving these arts? Does such a decision settle the matter and following such a decision should the Examiner at once discard a reference involving a transfer from one of such arts to the other?

As a rule the patents belonging to a single art cover a much broader field than can possibly be reviewed by the court in such a case. It is assumed, however, that the most pertinent patents referring to the particular feature of the arts under consideration are before the court.

It may perhaps be that while certain features of two arts held to be non-analogous are remote from each other, certain other features of the same two arts may approach each other so closely as to be analogous. This points again to the importance of the scope of the term in each particular case, for while a certain art may be broadly referred to, what the court really had in mind may have been much more limited in extent.

Care should be taken not to enlarge the scope of any

art under consideration beyond what the court had in mind. To determine this requires careful study of the case involved. Much difficulty arises from the fact that in many cases the court merely holds that certain arts are remote or not analogous and discards the references without going into details.

As indicating the importance of such decisions in guiding the Examiner the following cases are cited:

When a desired result is sought by those working in the art and skilled therein, but not obtained for lack of efficient means, which such persons are unable to devise, that another, by some seemingly simple change or adoption of an old means as an element of a combination, accomplishes the desired result or a better one, and his device proves commercially successful and largely displaces all others, it constitutes patentable invention.

The art of paint can construction, or can construction in general, is not an art at all analogous to that of electric lamp socket construction. While an inventor in the latter art is presumed to know what has been done before in that art, he is not required or presumed to be familiar with can construction of any sort, especially those designed for some special use. (*Weber Electric Co. vs. National Gas and Electric Fixture Co.* (204 F., 79.)

This case would appear to indicate that if the arts are non-analogous the matter is settled. In *Standard Caster and Wheel Co. vs. Caster Socket Co., Ltd.* (113 F., 162), it was held that:

The transfer of a device from one art to another does not amount to invention, although the arts may not be analogous, where such device performs the same function as it did before, if no substantial change were necessary in order to adapt it to its new use.

See also *Herman vs. Youngstown*, 191 F., 579, in which it was held:

Such a question is essentially one of fact, and, in its solution, we get little help from the decided cases. They lay down general rules which are familiar, but the application of these rules to specific facts depends upon the force which those facts carry to those who determine the issue.

It would appear, therefore, that while if in any case the arts are held to be non-analogous or remote, the court usually discards the reference under consideration, it would be unsafe to lay down a general rule to this effect.

Apparently in each case where it has been held that certain arts are either analogous or non-analogous, as distinguished from those where the decision has been directed merely to the particular use under consideration, the court has first considered the structure, function, operation and result of the devices involved, and also in some cases as cumulative evidence, the time elapsing between two patents.

From this a decision has been reached. If the evidence is sufficient to indicate that the arts are non-analogous, the particular use under consideration will be non-analogous. This is the question that must be settled in any case whether a holding in regard to the arts is made or not. As the same line of reasoning is followed in either case it would appear that the logical way to proceed in any case is to consider the particular use involved as above indicated, decide as to it and let the question of the arts being analogous or non-analogous take care of itself.

February 15, 1917.

*Recd July 1/08*

*also  
set of early  
Pat Office Rules*

UNITED STATES STATUTES

CONCERNING THE

Registration of Trade-Marks,

WITH THE

RULES OF THE PATENT OFFICE RELATING THERETO.

Revised August 1, 1906.  
(Third Revised June 12, 1908.)

*Taber & P. Smith - Boston & New York  
O. G. 2. 21. 1. 2. 3. 4. 5. 6. 7. 8. 9. 10.*

*of Act of March 1878, and of the  
of the Statute of 1878, and of the*



*Revised July 8<sup>th</sup>, 1908.*

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REVISED AUGUST 1, 1906.  
(Third reprint June 12, 1908.)

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First edition, April 1, 1905.

First reprint, April 20, 1905, under which Rules 17, 30, 34, and 62, and Forms 2, 3, 4, 5, 6, 7, and 8 were amended, and an appendix was added containing Circular of the Treasury Department relating to trade-marks, and an extract from the "Red Cross" act.

First revised edition, December 1, 1905, under which sections (a) and (e) of Rule 11 were cancelled and the remaining sections relettered to correspond therewith; Rule 17 was amended; original Rule 44 was cancelled and a new Rule 44 substituted therefor; new Rules 45 to 48 inclusive were inserted, and the numbering of original Rules 45 to 69 inclusive was changed to correspond therewith.

Second revised edition, August 1, 1906, under which section 1 of the Act of February 20, 1905, was amended in accordance with the Act of May 4, 1906, and the Act of May 4, 1906, was added; Rule 17 was cancelled and new Rules 17 and 18 were substituted therefor; Rule 18 was amended and renumbered as Rule 19; Rules 19 and 20 were renumbered as Rules 20 and 21; Rule 21 was renumbered as Rule 22, and sections (b) and (c) were amended; Rule 22 was renumbered as Rule 23; Rule 23 was amended and renumbered as Rule 24; Rules 24 to 28 inclusive were renumbered as Rules 25 to 29 inclusive; a new Rule 30 was inserted; Rule 29 was amended and renumbered as Rule 31; Rule 30 was renumbered as Rule 32; Rule 31 was amended and renumbered as Rule 33; Rules 32 to 65 inclusive were renumbered as Rules 34 to 67 inclusive, Rule 66 was cancelled and a new Rule 68 was substituted therefor, and Rules 67 to 73 inclusive were renumbered as Rules 69 to 75 inclusive.

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TRADE-MARK LAW  
OF  
THE UNITED STATES.

AN ACT To authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That the owner of a trade-mark used in commerce with foreign nations, or among the several States, or with Indian tribes, provided such owner shall be domiciled within the territory of the United States, or resides in or is located in any foreign country which, by treaty, convention, or law, affords similar privileges to the citizens of the United States, may obtain registration for such trade-mark by complying with the following requirements: First, by filing in the Patent Office an application therefor, in writing, addressed to the Commissioner of Patents, signed by the applicant, specifying his name, domicile, location, and citizenship; the class of merchandise and the particular description of goods comprised in such class to which the trade-mark is appropriated; (~~a description of the trade mark itself, only~~

Act of May 4, 1906.

*when needed to express colors not shown in the drawing,*  
~~and~~ *a* statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade-mark has been used,<sup>6</sup> With this statement shall be filed a drawing of the trade-mark, signed by the applicant, or his attorney, and such number of specimens of the trade-mark, as actually used, as may be required by the Commissioner of Patents. Second, by paying into the Treasury of the United States the sum of ten dollars, and otherwise complying with the requirements of this Act and such regulations as may be prescribed by the Commissioner of Patents.

SEC. 2. That the application prescribed in the foregoing section, in order to create any right whatever in favor of the party filing it, must be accompanied by a written declaration verified by the applicant, or by a member of the firm or an officer of the corporation or association applying, to the effect that the applicant believes himself or the firm, corporation, or association in whose behalf he makes the application to be the owner of the trade-mark sought to be registered, and that

7-311  
Source of the Currier,  
Cork Feb. 14, 1907  
The Currier is a drawing of a woman with a crown and a dress.

*Del. York.  
8, 1909*

no other person, firm, corporation, or association, to the best of the applicant's knowledge and belief, has the right to ~~such use~~ *such trade-mark in U. S.* either in the identical form or in such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in commerce among the several States, or with foreign nations, or with Indian tribes, and that the description and drawing presented truly represent the trade-mark sought to be registered. If the applicant resides or is located in a foreign country, the statement required shall, in addition to the foregoing, set forth that the trade-mark has been registered by the applicant, or that an application for the registration thereof has been filed by him in the foreign country in which he resides or is located, and shall give the date of such registration, or the application therefor, as the case may be, except that in the application in such cases it shall not be necessary to state that the mark has been used in commerce with the United States or among the States thereof. The verification required by this section may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States.

SEC. 3. That every applicant for registration of a trade-mark, or for renewal of registration of a trade-mark, who is not domiciled within the United States, shall, before the issuance of the certificate of registration, as hereinafter provided for, designate, by a notice in writing, filed in the Patent Office, some person residing within the United States on whom process or notice of proceedings affecting the right of ownership of the trade-mark of which such applicant may claim to be the owner, brought under the provisions of this Act or under other laws of the United States, may be served, with the same force and effect as if served upon the applicant or registrant in person. For the purposes of this Act it shall be deemed sufficient to serve such notice upon such applicant, registrant, or representative by leaving a copy of such process or notice addressed to him at the last address of which the Commissioner of Patents has been notified.

SEC. 4. That an application for registration of a trade-mark filed in this country by any person who has previously regularly filed in any foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States an application for registration of the same trade-mark shall be accorded the same force and effect as would be accorded to the same application if filed in this country on the date on which application for registration of the same

trade-mark was first filed in such foreign country: *Provided*, That such application is filed in this country within four months from the date on which the application was first filed in such foreign country: *And provided*, That certificate of registration shall not be issued for any mark for registration of which application has been filed by an applicant located in a foreign country until such mark has been actually registered by the applicant in the country in which he is located.

*as amended*  
*to 5 in*  
*supplement*  
*5*  
SEC. 5. That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—

(a) Consists of or comprises immoral or scandalous matter;  
(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or any simulation thereof, or of any State or municipality, or of any foreign nation: *Provided*, That trade-marks which are identical with a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers, shall not be registered: *Provided*, That no mark which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act: *Provided further*, That no portrait of a living individual may be registered as a trade-mark, except by the consent of such individual, evidenced by an instrument in writing: *And provided further*, That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States, or with Indian tribes, which was in actual and exclusive use as a trade-mark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of this Act.

*as amended*  
*and Sec.*  
*Supplement*  
SEC. 6. That on the filing of an application for registration of a trade-mark which complies with the requirements of this Act, and the payment of the fees herein provided for, the Commissioner of Patents shall cause an examination thereof to be made; and if on such examination it shall appear that the applicant is entitled to have his trade-mark registered under the provisions of this Act, the Commissioner shall cause the mark to be published at least once in the Official Gazette

of the Patent Office. Any person who believes he would be damaged by the registration of a mark may oppose the same by filing notice of opposition, stating the grounds therefor, in the Patent Office within thirty days after the publication of the mark sought to be registered, which said notice of opposition shall be verified by the person filing the same before one of the officers mentioned in section two of this Act. If no notice of opposition is filed within said time the Commissioner shall issue a certificate of registration therefor, as hereinafter provided for. If on examination an application is refused, the Commissioner shall notify the applicant, giving him his reasons therefor.

SEC. 7. That in all cases where notice of opposition has been filed the Commissioner of Patents shall notify the applicant thereof and the grounds therefor.

Whenever application is made for the registration of a trade-mark which is substantially identical with a trade-mark appropriated to goods of the same descriptive properties, for which a certificate of registration has been previously issued to another, or for registration of which another has previously made application, or which so nearly resembles such trade-mark, or a known trade-mark owned and used by another, as, in the opinion of the Commissioner, to be likely to be mistaken therefor by the public, he may declare that an interference exists as to such trade-mark, and in every case of interference or opposition to registration he shall direct the examiner in charge of interferences to determine the question of the right of registration to such trade-mark, and of the sufficiency of objections to registration, in such manner and upon such notice to those interested as the Commissioner may by rules prescribe.

The Commissioner may refuse to register the mark against the registration of which objection is filed, or may refuse to register both of two interfering marks, or may register the mark, as a trade-mark, for the person first to adopt and use the mark, if otherwise entitled to register the same, unless an appeal is taken, as hereinafter provided for, from his decision, by a party interested in the proceeding, within such time (not less than twenty days) as the Commissioner may prescribe.

SEC. 8. That every applicant for the registration of a trade-mark, or for the renewal of the registration of a trade-mark, which application is refused, or a party to an interference against whom a decision has been rendered, or a party who has filed a notice of opposition as to a trade-mark, may appeal from the decision of the examiner in charge of trade-marks, or the examiner in charge of interferences, as the case may be, to the Commissioner in person, having once paid the fee for such appeal.

SEC. 9. That if an applicant for registration of a trade-mark, or a party to an interference as to a trade-mark, or a party who has filed

opposition to the registration of a trade-mark, or party to an application for the cancellation of the registration of a trade-mark, is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the court of appeals of the District of Columbia, on complying with the conditions required in case of an appeal from the decision of the Commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable.

SEC. 10. That every registered trade-mark, and every mark for the registration of which application has been made, together with the application for registration of the same, shall be assignable in connection with the good will of the business in which the mark is used. Such assignment must be by an instrument in writing and duly acknowledged according to the laws of the country or State in which the same is executed; any such assignment shall be void as against any subsequent purchaser for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from date thereof. The Commissioner shall keep a record of such assignments.

SEC. 11. That certificates of registration of trade-marks shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner of Patents, and a record thereof, together with printed copies of the drawing and statement of the applicant, shall be kept in books for that purpose. The certificate shall state the date on which the application for registration was received in the Patent Office. Certificates of registration of trade-marks may be issued to the assignee of the applicant, but the assignment must first be entered of record in the Patent Office.

Written or printed copies of any records, books, papers, or drawings relating to trade-marks belonging to the Patent Office, and of certificates of registration, authenticated by the seal of the Patent Office and certified by the Commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor and paying the fee required by law shall have certified copies thereof.

SEC. 12. That a certificate of registration shall remain in force for twenty years, except that in the case of trade-marks previously registered in a foreign country such certificates shall cease to be in force on the day on which the trade-mark ceases to be protected in such foreign country, and shall in no case remain in force more than twenty years, unless renewed. Certificates of registration may be from time to time renewed for like periods on payment of the renewal fees required by this Act, upon request by the registrant, his legal representatives, or transferees of record in the Patent Office, and such request may be



made at any time not more than six months prior to the expiration of the period for which the certificates of registration were issued or renewed. Certificates of registration in force at the date at which this Act takes effect shall remain in force for the period for which they were issued, but shall be renewable on the same conditions and for the same periods as certificates issued under the provisions of this Act, and when so renewed shall have the same force and effect as certificates issued under this Act.

SEC. 13. That whenever any person shall deem himself injured by the registration of a trade-mark in the Patent Office he may at any time apply to the Commissioner of Patents to cancel the registration thereof. The Commissioner shall refer such application to the examiner in charge of interferences, who is empowered to hear and determine this question and who shall give notice thereof to the registrant. If it appear after a hearing before the examiner that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the examiner shall so decide, the Commissioner shall cancel the registration. Appeal may be taken to the Commissioner in person from the decision of examiner of interferences.

SEC. 14. That the following shall be the rates for trade-mark fees:

On filing each original application for registration of a trade-mark, ten dollars: *Provided*, That an application for registration of a trade-mark pending at the date of the passage of this Act, and on which certificate of registration shall not have issued at such date, may, at the option of the applicant, be proceeded with and registered under the provisions of this Act without the payment of further fee.

On filing each application for renewal of the registration of a trade-mark, ten dollars.

On filing notice of opposition to the registration of a trade-mark, ten dollars.

On an appeal from the examiner in charge of trade-marks to the Commissioner of Patents, fifteen dollars.

On an appeal from the decision of the examiner in charge of interferences, awarding ownership of a trade-mark or cancelling the registration of a trade-mark, to the Commissioner of Patents, fifteen dollars.

For certified and uncertified copies of certificates of registration and other papers, and for recording transfers and other papers, the same fees as required by law for such copies of patents and for recording assignments and other papers relating to patents.

SEC. 15. That sections forty-nine hundred and thirty-five and forty-nine hundred and thirty-six of the Revised Statutes, relating to the payment of patent fees and to the repayment of fees paid by mistake, hereby made applicable to trade-mark fees.

SEC. 16. That the registration of a trade-mark under the provisions of this Act shall be prima facie evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade-mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several States, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

SEC. 17. That the circuit and territorial courts of the United States and the supreme court of the District of Columbia shall have original jurisdiction, and the circuit courts of appeal of the United States and the court of appeals of the District of Columbia shall have appellate jurisdiction of all suits at law or in equity respecting trade-marks registered in accordance with the provisions of this Act, arising under the present Act, without regard to the amount in controversy.

SEC. 18. That writs of certiorari may be granted by the Supreme Court of the United States for the review of cases arising under this Act in the same manner as provided for patent cases by the Act creating the circuit court of appeals.

SEC. 19. That the several courts vested with jurisdiction of cases arising under the present Act shall have power to grant injunctions, according to the course and principles of equity, to prevent the violation of any right of the owner of a trade-mark registered under this Act, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for wrongful use of a trade-mark the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction. The court shall have the same power to increase such damages, in its discretion, as is given by section sixteen of this Act for increasing damages found by verdict in actions of law; and in assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost which are claimed.

SEC. 20. That in any case involving the right to a trade-mark registered in accordance with the provisions of this Act, in which the verdict has been found for the plaintiff, or an injunction issued, the court may order that all labels, signs, prints, packages, wrappers, or receptacles in the possession of the defendant, bearing the trade-mark of the plaintiff or complainant, or any reproduction, counterfeit, copy, or colorable imitation thereof, shall be delivered up and destroyed. Any injunction that may be granted upon hearing, after notice to the defendant, to prevent the violation of any right of the owner of a trade-mark registered in accordance with the provisions of this Act, by any circuit court of the United States, or by a judge thereof, may be served on the parties against whom such injunction may be granted anywhere in the United States where they may be found, and shall be operative, and may be enforced by proceedings to punish for contempt, or otherwise, by the court by which such injunction was granted, or by any other circuit court, or judge thereof, in the United States, or by the supreme court of the District of Columbia, or a judge thereof. The said courts, or judges thereof, shall have jurisdiction to enforce said injunction, as herein provided, as fully as if the injunction had been granted by the circuit court in which it is sought to be enforced. The clerk of the court or judge granting the injunction shall, when required to do so by the court before which application to enforce said injunction is made, transfer without delay to said court a certified copy of all the papers on which the said injunction was granted that are on file in his office.

SEC. 21. That no action or suit shall be maintained under the provisions of this Act in any case when the trade-mark is used in unlawful business, or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or has been abandoned, or upon any certificate of registration fraudulently obtained.

SEC. 22. That whenever there are interfering registered trade-marks, any person interested in any one of them may have relief against the interfering registrant, and all persons interested under him, by suit in equity against the said registrant; and the court, on notice to adverse parties and other due proceedings had according to the course of equity, may adjudge and declare either of the registrations void in whole or in part according to the interest of the parties in the trade-mark, and may order the certificate of registration to be delivered up to the Commissioner of Patents for cancellation.

SEC. 23. That nothing in this Act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this Act had not been passed.

SEC. 24. That all applications for registration pending in the office

of the Commissioner of Patents at the time of the passage of this Act may be amended with a view to bringing them, and the certificate issued upon such applications, under its provisions, and the prosecution of such applications may be proceeded with under the provisions of this Act.

SEC. 25. That any person who shall procure registration of a trade-mark, or entry thereof, in the office of the Commissioner of Patents by a false or fraudulent declaration or representation, oral or in writing, or by any false means, shall be liable to pay any damages sustained in consequence thereof to the injured party, to be recovered by an action on the case.

SEC. 26. That the Commissioner of Patents is authorized to make rules and regulations, not inconsistent with law, for the conduct of proceedings in reference to the registration of trade-marks provided for by this Act.

SEC. 27. That no article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trade-mark registered in accordance with the provisions of this Act, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any custom-house of the United States; and, in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader, and any foreign manufacturer or trader, who is entitled under the provisions of a treaty, convention, declaration, or agreement between the United States and any foreign country to the advantages afforded by law to citizens of the United States in respect to trade-marks and commercial names, may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trade-mark, issued in accordance with the provisions of this Act, to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department facsimiles of his name, the name of the locality in which his goods are manufactured, or of his registered trade-mark; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs.

SEC. 28. That it shall be the duty of the registrant to give notice to the public that a trade-mark is registered, either by affixing thereon

the words "Registered in U. S. Patent Office," or abbreviated thus, "Reg. U. S. Pat. Off.," or when, from the character or size of the trade-mark, or from its manner of attachment to the article to which it is appropriated, this can not be done, then by affixing a label containing a like notice to the package or receptacle wherein the article or articles are inclosed; and in any suit for infringement by a party failing so to give notice of registration no damages shall be recovered, except on proof that the defendant was duly notified of infringement, and continued the same after such notice.

SEC. 29. That in construing this Act the following rules must be observed, except where the contrary intent is plainly apparent from the context thereof: The United States includes and embraces all territory which is under the jurisdiction and control of the United States. The word "States" includes and embraces the District of Columbia, the Territories of the United States, and such other territory as shall be under the jurisdiction and control of the United States. The terms "person" and "owner," and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this Act, include a firm, corporation, or association as well as a natural person. The term "applicant" and "registrant" embrace the successors and assigns of such applicant or registrant. The term "trade-mark" includes any mark which is entitled to registration under the terms of this Act, and whether registered or not, and a trade-mark shall be deemed to be "affixed" to an article when it is placed in any manner in or upon either the article itself or the receptacle or package or upon the envelope or other thing in, by, or with which the goods are packed or inclosed or otherwise prepared for sale or distribution.

SEC. 30. That this Act shall be in force and take effect April first, nineteen hundred and five. All Acts and parts of Acts inconsistent with this Act are hereby repealed except so far as the same may apply to certificates of registration issued under the Act of Congress approved March third, eighteen hundred and eighty-one, entitled "An Act to authorize the registration of trade-marks and protect the same," or under the Act approved August fifth, eighteen hundred and eighty-two, entitled "An Act relating to the registration of trade-marks."

Approved, February 20, 1905.

AN ACT To amend the laws of the United States relating to the registration of trade-marks.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That section one of the Act entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same," approved February twentieth, nineteen hundred and five, be, and is hereby, amended by inserting after the words "description of the trade-mark itself" the words "only when needed to express colors not shown in the drawing," so that the section, as amended, shall read as follows:

"That the owner of a trade-mark used in commerce with foreign nations, or among the several States, or with Indian tribes, provided such owner shall be domiciled within the territory of the United States or resides in or is located in any foreign country which, by treaty, convention, or law, affords similar privileges to the citizens of the United States, may obtain registration for such trade-mark by complying with the following requirements: First, by filing in the Patent Office an application therefor, in writing, addressed to the Commissioner of Patents, signed by the applicant, specifying his name, domicile, location, and citizenship; the class of merchandise and the particular description of goods comprised in such class to which the trade-mark is appropriated; a description of the trade-mark itself, only when needed to express colors not shown in the drawing, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade-mark has been used. With this statement shall be filed a drawing of the trade-mark, signed by the applicant, or his attorney, and such number of specimens of the trade-mark as actually used as may be required by the Commissioner of Patents. Second, by paying into the Treasury of the United States the sum of ten dollars, and otherwise complying with the requirements of this Act and such regulations as may be prescribed by the Commissioner of Patents."

SEC. 2. That the Commissioner of Patents shall establish classes of merchandise for the purpose of trade-mark registration, and shall determine the particular descriptions of goods comprised in each class. On a single application for registration of a trade-mark the trade-mark may be registered at the option of the applicant for any or all goods upon which the mark has actually been used comprised in a single class of merchandise, provided the particular descriptions of goods be stated.

SEC. 3. That any owner of a trade-mark who shall have a manufacturing establishment within the territory of the United States shall be accorded, so far as the registration and protection of trade-marks used on the products of such establishment are concerned, the same rights and privileges that are accorded to owners of trade-marks domiciled within the territory of the United States by the Act entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same," approved February twentieth, nineteen hundred and five.

SEC. 4. That this Act shall take effect July first, nineteen hundred and six.

Approved, May 4, 1906.

## LIST OF TRADE-MARK LAWS OF FOREIGN NATIONS.

The trade-mark laws of the following countries have been published in the Official Gazette:

Country.	Volume.	Page.	Date.
Argentine Republic .....	42	383	Jan. 24, 1888
Austria-Hungary .....	52	1539	Sept. 2, 1890
Do .....	59	1611	June 14, 1892
Bulgaria .....	65	137	Oct. 3, 1893
Brazil .....	45	235	Oct. 9, 1888
China .....	112	2095	Oct. 25, 1904
Cuba .....	100	1114	July 29, 1902
Do .....	108	800	Jan. 19, 1904
Denmark .....	54	1419	Mar. 10, 1891
Ecuador .....	93	361	Oct. 9, 1900
England .....	25	90	Oct. 2, 1883
Do .....	46	1395	Mar. 12, 1889
Germany .....	31	1447	June 23, 1885
Do .....	71	145	Apr. 2, 1895
Greece .....	69	126	Oct. 2, 1894
Guatemala .....	93	360	Oct. 9, 1900
Italy .....	24	102	July 3, 1883
Japan .....	48	1402	Sept. 3, 1889
Do .....	70	1503	Mar. 12, 1895
Do .....	78	1744	Mar. 16, 1897
Do .....	83	598	Apr. 26, 1898
Do .....	88	1899	Sept. 5, 1899
Luxemburg .....	115	1332	Apr. 4, 1905
Mexico .....	51	809	May 6, 1890
Netherlands .....	23	1334	Apr. 3, 1883
Do .....	66	174	Jan. 2, 1894
Do .....	66	321	Jan. 16, 1894
Panama .....	115	1852	Apr. 18, 1905
Portugal .....	70	279	Jan. 8, 1895
Roumania .....	55	1653	June 23, 1891
Servia .....	75	1035	May 12, 1896
Switzerland .....	23	2237	June 8, 1883
Transvaal (British) .....	101	3110	Dec. 30, 1902
Victoria .....	33	501	Oct. 27, 1885

## TRADE-MARK TREATIES WITH FOREIGN NATIONS.

The following is a list of the Governments with which conventions for the reciprocal registration and protection of trade-marks have been entered into by the United States, with the dates of the respective conventions. For the full text, reference is made to the Official Gazette. The laws of Switzerland and the Netherlands being so framed as to afford reciprocal privileges to the citizens or subjects of any Government which affords similar privileges to the people of those countries, the mere exchange of diplomatic notes, giving notice of the fact, accomplishes all the purposes of a formal convention:

Country.	Vol- ume.	Page.	Date.
Austria-Hungary .....	2	418	Oct. 8, 1872
Belgium .....	2	417	Do.
Do .....	29	452	Nov. 4, 1884
Denmark .....	61	571	Nov. 1, 1892
France .....	2	416	Oct. 8, 1872
Germany .....	2	418	Do.
Great Britain .....	14	233	Aug. 13, 1878
Italy .....	27	304	Apr. 22, 1884
Japan .....	78	1744	Mar. 16, 1897
Roumania .....	123	1288	July 24, 1906
Russia .....	2	416	Oct. 8, 1872
Servia .....	28	1191	Sept. 30, 1884
Spain .....	25	98	Oct. 9, 1883

The declaration with Great Britain is drawn so as to confer mutual trade-mark rights upon the subjects and citizens of each of the contracting parties throughout the dominions and possessions of the other. Citizens or residents of British colonies are therefore permitted to register their trade-marks under this treaty whenever it is satisfactorily shown that, in the respective colonies, similar protection is afforded to citizens of the United States.

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**RULES GOVERNING THE REGISTRATION OF TRADE-MARKS  
UNDER THE ACT APPROVED FEBRUARY 20, 1905, TO TAKE  
EFFECT APRIL 1, 1905, AND UNDER THE ACT APPROVED  
MAY 4, 1906, TO TAKE EFFECT JULY 1, 1906.**

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UNITED STATES PATENT OFFICE,  
*Washington, D. C., August 1, 1906.*

The following rules, designed to be in strict accordance with the provisions of the acts approved February 20, 1905, and May 4, 1906, for the registration of trade-marks, are published for gratuitous distribution.

Applicants for registration and their attorneys are advised that their business will be facilitated by the observance of the forms on pages 35 to 42.

FREDERICK I. ALLEN,  
*Commissioner of Patents.*

**CORRESPONDENCE.**

1. All business with the Office should be transacted in writing. Unless by the consent of all parties, the action of the Office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

2. Applicants and attorneys will be required to conduct their business with the Office with decorum and courtesy. Papers presented in violation of this requirement will be returned; but all such papers will first be submitted to the Commissioner, and only be returned by his direct order.

3. All letters should be addressed to "The Commissioner of Patents;" and all remittances by money order, check, or draft should be to his order.

4. A separate letter should, in every case, be written in relation to each distinct subject of inquiry or application. Complaints against the examiner in charge of trade-marks, assignments for record, fees, and orders for copies or abstracts must be sent to the Office in separate letters.

5. Letters relating to pending applications should refer to the name of the applicant, the serial number of the application, and the date of

filing. Letters relating to registered trade-marks should refer to the name of the registrant, the number and date of the certificate, and the merchandise to which the trade-mark is applied.

6. The personal attendance of applicants at the Patent Office is unnecessary. Their business can be transacted by correspondence.

7. When an attorney shall have filed his power of attorney duly executed, the correspondence will be held with him.

8. A double correspondence with an applicant and his attorney, or with two attorneys, can not, generally, be allowed.

9. The Office can not undertake to respond to inquiries propounded with a view to ascertain whether certain trade-marks have been registered, or, if so, to whom, or for what goods; nor can it give advice as to the nature and extent of the protection afforded by the law, or act as its expounder, except as questions may arise upon applications regularly filed.

10. Express, freight, postage, and all other charges on matter sent to the Patent Office must be prepaid in full; otherwise it will not be received.

#### ATTORNEYS.

*Cancelled see new Rule 11 in Sup-plement, p. 1.* 11. An applicant or an assignee of the entire interest may prosecute his own case, but he is advised, unless familiar with such matters, to employ a competent attorney. The Office can not aid in the selection of any attorney.

A register of attorneys is kept in this Office, on which will be entered the names of all persons entitled to represent applicants before the Patent Office. The names of persons in the following classes will, upon their written request, be entered on this register:

(a) Any attorney at law who is in good standing in any court of record in the United States or any of the States or Territories thereof and who shall furnish a certificate of the clerk of such United States, State, or Territorial court, duly authenticated under the seal of the court, that he is an attorney in good standing.

(b) Any person who has been regularly recognized as an attorney or agent to represent claimants before the Department of the Interior, or any bureau thereof, and is in good standing, provided that such person shall furnish a statement of the date of his admission to practice as such attorney or agent, and shall further show, if required by the Commissioner, that he is possessed of the necessary qualifications to render applicants valuable service, and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office.

(c) Any person, not an attorney at law, who shall file a certificate from a judge of a United States, State, or Territorial court, duly authenticated under the seal of the court, that such person is of good

moral character and of good repute and possessed of the necessary qualifications to enable him to render applicants valuable service, and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office.

(d) Any firm, not entitled to registration under the preceding sections, which shall show that the individuals composing the firm are each and all recognized as patent attorneys or agents, or are each and all entitled to be so recognized under the preceding sections of this rule.

The Commissioner may demand additional proof of qualifications, and reserves the right to decline to recognize any attorney, agent, or other person applying for registration under this rule.

Any person or firm, not registered and not entitled to be recognized under this rule as an attorney or agent to represent applicants generally, may, upon a showing of circumstances which render it necessary or justifiable, be recognized by the Commissioner to prosecute as attorney or agent any certain specified application or applications, but this limited recognition shall not extend further than the application or applications named.

No person, not registered as above provided, will be permitted to prosecute, as attorney, applications before the Patent Office.

12. Before any attorney, original or associate, will be allowed to inspect papers or take action of any kind, his power of attorney must be filed. General powers given by a principal to an associate can not be considered. In each application, the written authorization must be filed. A power of attorney purporting to have been given to a firm or copartnership will not be recognized, either in favor of the firm or of any of its members, unless all its members shall be named in such power of attorney.

13. Substitution or association may be made by an attorney upon the written authorization of his principal; but such authorization will not empower the second attorney to appoint a third.

14. Powers of attorney may be revoked at any stage in the proceedings of a case upon application to and approval by the Commissioner; and, when so revoked, the Office will communicate directly with the applicant, or such other attorney as he may appoint. An attorney will be promptly notified, by the docket clerk, of the revocation of his power of attorney.

15. For gross misconduct, the Commissioner may refuse to recognize any person as an attorney, either generally or in any particular case; but the reasons for such refusal will be duly recorded and be subject to the approval of the Secretary of the Interior.

## WHO MAY REGISTER A TRADE-MARK.

16. A trade-mark may be registered by any person, firm, corporation, or association domiciled within the territory of the United States, or residing in or located in any foreign country which, by treaty, convention, or law, affords similar privileges to the citizens of the United States, and who is <sup>entitled to the use of any</sup> ~~entitled to the use of any~~ trade-mark and uses the same in commerce with foreign nations, or among the several States, or with Indian tribes, upon payment of the fee required by law and other due proceedings had. (See rules 17 and 20.)

17. Except as provided by section 3 of the act of May 4, 1906, no trade-mark will be registered to an applicant residing or located in a foreign country unless such country, by treaty, convention, or law, affords similar privileges to the citizens of the United States, nor unless the trade-mark has been registered by the applicant in the foreign country in which he resides or is located, nor until such applicant has filed in this Office a certified copy of the certificate of registration of his trade-mark in the country where he resides or is located. In such cases, it is not necessary to state, in the application, that the trade-mark has been used in commerce with the United States or among the several States thereof.

18. The owner of a trade-mark, residing or located in a foreign country and who shall have a manufacturing establishment within the territory of the United States, may register a trade-mark used on the products of such establishment upon complying with the provisions of the act of February 20, 1905, as prescribed for owners of trade-marks domiciled within the territory of the United States.

## WHAT MAY BE REGISTERED AS A TRADE-MARK.

19. No trade-mark will be registered to an owner domiciled within the territory of the United States unless it shall be made to appear that the same is used as such by said owner in commerce among the several States, or between the United States and some foreign nation or Indian tribe: no trade-mark, except as provided by section 3 of the act of May 4, 1906, will be registered to an owner residing in or located in a foreign country unless said country, by treaty, convention, or law, affords similar privileges to the citizens of the United States: no trade-mark will be registered which consists of or comprises immoral or scandalous matter, or which consists of or comprises the flag or coat of arms or other insignia of the United States, or any simulation thereof, or of any State or municipality, or of any foreign nation, or which is identical with a registered



see insertion

See O. G. 141-1-p. 242

Act of Feb. 20, 1905,  
sec. 1.

Act of Feb. 20, 1905,  
secs. 1, 2, and 4.

Act of May 4, 1906,  
sec. 3.

Act of May 4, 1906,  
sec. 3.

Amended  
see change  
in Supple-  
ment - p. 2

or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, or which so nearly resembles a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers; or which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term: no portrait of a living individual will be registered as a trade-mark, except by the consent of such individual, evidenced by an instrument in writing: and no trade-mark will be registered which is used in unlawful business, or upon any article injurious in itself, or which has been used with the design of deceiving the public in the purchase of merchandise, or which has been abandoned.

20. Any mark, used in commerce with foreign nations or among the several States or with Indian tribes, may be registered if it has been in actual and exclusive use as a trade-mark of the applicant, or his predecessors from whom he derived title, for ten years next preceding the passage of the act of February 20, 1905. (See Rule 32.)

Act of Feb. 20, 1905,  
sec. 5.

#### THE APPLICATION.

21. An application for the registration of a trade-mark must be made to the Commissioner of Patents and must be signed by the applicant.

Act of Feb. 20, 1905,  
sec. 1.

22. A complete application comprises:

Act of Feb. 20, 1905,  
sec. 1.  
Act of May 4, 1906,  
sec. 1.

(a) A petition, requesting registration, signed by the applicant. (See Form 1, p. 35.)  
(b) A statement specifying the name, domicile, location, and citizenship of the party applying; the class of merchandise, and the particular description of goods comprised in such class, to which the trade-mark is appropriated; a description of the trade-mark itself, only when needed to express colors not shown in the drawing; and a statement of the mode in which the same is applied and affixed to the goods, and of the length of time during which the trade-mark has been used, and, if the applicant be a corporation or association, it must be set forth under the laws of what State or nation organized. (See sec. 29 of the act of February 20, 1905, and Forms 2, 4, 6, and 10, pp. 35, 36, 37, and 40.)

(c) A declaration complying with section 2 of the act of February 20, 1905. (See Forms 3, 5, 7, 8, 9, and 11, pp. 36, 37, 38, 39, and 40.)

unamended by Act of Feb. 18, 1909. Digitized by Google

see new rule 22 -  
O. G. 141-1-6288

(d) A drawing of the trade-mark,<sup>o</sup> which shall be a facsimile of the same as actually used upon the goods. (See Rules 36 and 37 and specimen drawing between pp. 38 and 39.)

(e) Five specimens *(or facsimiles, when, from the mode of applying or affixing the trade-mark to the goods, specimens can not be furnished)* of the trade-mark as actually used upon the goods.

(f) A fee of ten dollars.

23. The petition, the statement, and the declaration must be in the English language and written on one side of the paper only.

24. The name of the applicant will appear in the certificate of registration precisely as it is signed to the statement of the application, and, therefore, the signature to the statement must be the correct signature of the applicant, and the name of the applicant wherever it appears in the papers of the application will be made to agree with the name as signed to the statement.

25. No information will be given, without authority of the applicant, respecting the filing of an application for the registration of a trade-mark by any person, or the subject-matter thereof, unless it shall, in the opinion of the Commissioner, be necessary to the proper conduct of business before the Office.

26. All applications for registration pending in the Patent Office at the time of the passage of the act of February 20, 1905, may be amended with a view to bringing them and the certificates issued under such applications under the provisions of said act, and the prosecution of such applications may be proceeded with under its provisions without the payment of further fee. When such an application is amended to bring it under the act of February 20, 1905, it will be given a serial number and a date of filing under said act.

A trade-mark, registered under the act of March 3, 1881, may be registered under the act of February 20, 1905, but the application for such registration will be subject to examination in the same manner as other applications filed under said act of February 20, 1905.

27. An application for registration of a trade-mark, filed in this country by any person who has previously regularly filed in any foreign country which, by treaty, convention, or law, affords similar privileges to the citizens of the United States an application for registration of the same trade-mark, shall be accorded the same force and effect as would be accorded to the same application if filed in this country on the date on which application for registration of the same trade-mark was first filed in such foreign country: *Provided*, That such application be filed in this country within four months from the date on which the application was first filed in such foreign country.

Act of Feb. 20, 1905,  
secs. 14 and 24.

Act of Feb. 20, 1905,  
sec. 4.

28. Every applicant for registration of a trade-mark, or for renewal of registration of a trade-mark, who is not domiciled within the United States, shall, before the issuance of the certificate of registration, designate, by a notice in writing, filed in the Patent Office, some person residing within the United States on whom process or notice of proceedings affecting the right of ownership of the trade-mark of which such applicant may claim to be the owner may be served. This notice shall be indorsed upon the file wrapper of the application.

29. In proceedings relating to an application, or to a registration under the act of February 20, 1905, it shall be deemed sufficient to serve notice upon the applicant, registrant, or representative, by leaving a copy of the process or notice of proceedings addressed to him at the last address of which the Commissioner of Patents has been notified.

30. A trade-mark may, at the option of the applicant, be registered on a single application, for any or all goods comprised in a single class of merchandise, provided the particular description of goods be stated, and provided that the mark has been actually used upon all of the goods specified. (See classification of merchandise, pp. 43 and 44.)

31. The application must be accompanied by a written declaration, verified by the applicant, or by a member of the firm, or by an officer of the corporation or association applying, to the effect that he believes himself, or the firm, corporation, or association in whose behalf he makes the application, to be the owner of the trade-mark sought to be registered, and that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use the trade-mark, either in the identical form or <sup>in</sup> any such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in commerce among the several States, or with foreign nations, or with Indian tribes; that the <sup>drawing</sup> ~~drawing~~ truly represents the trade-mark sought to be registered; that the specimens (or facsimiles) show the mark as actually used upon the goods; and that the facts set forth in the statement are true. (See Rule 17 and Forms 3, 5, 7, 8, 9, and 11, pp. 36 to 40.)

32. Where application is made under section 5 of the act of February 20, 1905, on the ground that the mark has been in actual and exclusive use as a trade-mark by the applicant, or his predecessors from whom he derived title, for ten years next preceding the passage of said act, the applicant shall, in addition to the requirements of section 2 of said act, make oath to such actual use of the mark as a trade-mark by himself, or his predecessors, or by those from whom title to the same is derived, for the period specified, and that, to the

See O.G. 141-1 p. 259



best of his knowledge and belief, such use has been exclusive. (See Form 8, page 39.)

33. If the applicant resides or is located in a foreign country, the declaration required, unless the application be presented under the provisions of section 3 of the act of May 4, 1906, shall also set forth that the trade-mark has been registered by the applicant, or that an application for the registration thereof has been filed by him in the foreign country in which he resides or is located, and shall give the date of such registration, or of the application therefor, as the case may be. In such cases, it shall not be necessary to state that the mark has been used in commerce with the United States or among the States thereof.

If the application be presented under the provisions of section 3 of the act of May 4, 1906, the declaration, in addition to the requirements of Rule 31, must state that the applicant has a manufacturing establishment within the territory of the United States and that the goods upon which the trade-mark is used are the product of such establishment.

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in p. 2.* 34. The declaration may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by the certificate of a diplomatic or consular officer of the United States, the declaration being attested in all cases, in this and other countries, by the proper official seal of the officer before whom the same is made, *See also  
section*

35. Amendment of the declaration will not be permitted. If that filed with the application be faulty or defective, a substitute declaration must be filed.

#### DRAWING.

36. (1) The drawing must be made upon pure white paper of a thickness corresponding to two-sheet Bristol board. The surface of the paper must be calendered and smooth. India ink alone must be used, to secure perfectly black and solid lines.

(2) The size of a sheet on which a drawing is made must be exactly 10 by 15 inches. One inch from its edges, a single marginal line is to be drawn, leaving the "sight" precisely 8 by 13 inches. Within this margin, all work and signatures must be included. One of the shorter sides of the sheet is regarded as its top, and, measuring downwardly from the marginal line, a space of not less than 1½ inches

is to be left blank for the heading of title, name, number, and date. (See specimen drawing between pages 38 and 39.)

(3) All drawings must be made with the pen only. Every line and letter, signatures included, must be absolutely black. This direction applies to all lines, however fine, and to shading. All lines must be clean, sharp, and solid, and they must not be too fine or crowded. Surface shading, when used, should be open.

(4) The name of the proprietor of the trade-mark, signed by himself or by his attorney of record, must be placed at the lower right-hand corner of the sheet within the marginal lines, but, in no instance, should it encroach upon the drawing.

(5) When the view is longer than the width of the sheet, the sheet should be turned on its side and the heading should be placed at the right and the signature at the left, occupying the same space and position as in an upright view and being horizontal when the sheet is held in an upright position.

(6) Drawings transmitted to the Office should be sent flat, protected by a sheet of heavy binder's board, ~~They should not be rolled or folded.~~ *in addition*

(7) An agent's or attorney's stamp, or advertisement, or written address will not be permitted upon the face of a drawing, within or without the marginal line.

37. The Office, at the request of applicants, will furnish the drawings at cost.

#### EXAMINATION OF APPLICATIONS.

38. All complete applications for registration are considered, in the first instance, by the examiner in charge of trade-marks. Whenever, on examination of an application, registration is refused for any reason whatever, the applicant will be notified thereof. The reasons for such refusal will be stated, and such information and references will be given as may be useful in aiding the applicant to judge of the propriety of further prosecuting his application.

39. The examination of an application and the action thereon will be directed throughout to the merits, but, in each letter, the examiner shall state or refer to all his objections.

40. If, on examination of an application for the registration of a trade-mark, it shall appear that the applicant is entitled to have his trade-mark registered under the provisions of the law, the mark will be published in the Official Gazette at least once. Such publication shall be at least thirty days prior to the date of registration.

If no notice of opposition be filed within thirty days after such publication the applicant or his attorney will be duly notified of the allowance of his application, and a certificate of registration will be issued as provided in Rule 58.

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The weekly issue closes on Thursday, and the certificates of registration of that issue bear date as of the ~~third~~ <sup>fourth</sup> Tuesday thereafter.

#### AMENDMENTS.

41. The statement may be amended to correct informalities, or to avoid objections made by the Office, or for other reasons arising in the course of examination, but no amendments to the description or drawing of the trade-mark will be permitted unless warranted by something in the specimens (*or facsimiles*) as originally filed.

42. In every amendment, the exact word or words to be stricken out or inserted in the statement must be specified, and the precise point indicated where the erasure or insertion is to be made. All such amendments must be on sheets of paper separate from the papers previously filed, and written on but one side of the paper.

Erasures, additions, insertions, or mutilations of the papers and records must not be made by the applicant or attorney.

43. When an amendatory clause is amended, it must be wholly rewritten, so that no interlineation or erasure shall appear in the clause, as finally amended, when the application is passed to issue. If the number or nature of the amendments shall render it otherwise difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire statement to be rewritten.

44. After allowance, the examiner will exercise jurisdiction over an application only by special authority from the Commissioner.

Amendments may be made after the allowance of an application, if the case has not been printed, on the recommendation of the examiner, approved by the Commissioner, without withdrawing the case from issue.

45. After the completion of the application, the Office will not return the papers for any purpose whatever. If the applicant has not preserved copies of the papers which he wishes to amend, the Office will furnish them on the usual terms.

#### INTERFERENCE, OPPOSITION, AND CANCELLATION.

46. Whenever application is made for the registration of a trade-mark which is substantially identical with a trade-mark appropriated to goods of the same descriptive properties, for which a certificate of registration has been previously issued to another, ~~or~~ for registration of which another had previously made application, or which so nearly resembles such trade-mark, or a known trade-mark owned and used

by another, as, in the opinion of the Commissioner, to be likely to be mistaken therefor by the public,) an interference will be declared.

The practice in trade-mark interferences will follow, as nearly as practicable, the practice in interferences between applications for patents.

47. Before the declaration of interference, all preliminary questions must have been settled by the examiner in charge of trade-marks, and the trade-mark which is to form the subject-matter of the controversy must have been decided to be registrable, and must have been published at least once in the Official Gazette of the Patent Office.

Whenever two or more applicants are found to be claiming <sup>substantially</sup> the same registrable trade-mark, ~~the examiner of trade-marks, when the application of one of the applicants is ready for publication, may require the other applicants to put their applications in condition for publication within a time specified, in order that an interference may be declared. If any party fail to put his application in condition for publication within such time specified, the declaration of interference will not be delayed, but, after judgment of priority, the application of such party will be held for revision and restriction, subject to interference with other applications or registered trade-marks.~~ <sup>and then the examiner in charge of trade-marks</sup>

48. The examiner in charge of interferences may, either before or in his decision <sup>in an order or proceeding</sup> on the question of priority, direct the attention of the Commissioner to any matter ~~not relating to priority~~ <sup>which cannot be called upon by him</sup> which may have come to his notice, and which, in his opinion, establishes the fact that ~~no interference exists, or that there has been such irregularity in declaring the same as will preclude a proper determination of the question of priority, or which amounts to a statutory bar to registration of the mark to any or all of the parties to the interference.~~ <sup>in the proceedings</sup> The Commissioner may, before judgment on the question of priority, suspend the interference and remand the same to the examiner of trade-marks for his consideration of the matters to which attention has been directed. If the case be not so remanded, the examiner in charge of trade-marks will, after judgment, consider any matter affecting the rights of either party to registration which may have been brought to his attention, unless the same shall have been previously disposed of by the Commissioner. From the decision of the examiner of trade-marks, appeals may be taken, as in other cases.

49. Motions to dissolve an interference upon the ground that no interference in fact exists, or that there has been such irregularity in declaring the same as will preclude a proper determination of the question of priority, or which deny the registrability of an applicant's mark, should, if possible, be made not later than the <sup>30</sup>twentieth day after the notices of the interference have been mailed. Such motions, and all motions of a similar character, should be accompanied by a motion to transmit the same to the examiner in charge of trade-marks, and such

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application  
See application

② note

motion to transmit will be noticed for hearing upon a day certain before the examiner in charge of interferences. When in proper form, the motion presented will, with the files and papers, be transmitted, by the examiner in charge of interferences, for determination, to the examiner in charge of trade-marks, who will thereupon fix a day certain when said motion will be heard before him upon the merits, and give notice thereof to all the parties. If a stay of proceedings be desired, a motion therefor should accompany the motion for transmission. <sup>reversed</sup>

Motions to shift the burden of proof should be made before, and will be determined by, the examiner in charge of interferences. No appeal from the decision on such motion will be entertained, but the matter may be reviewed on appeal from the final decision upon the question of priority.

50. The decision of the examiner in charge of trade-marks, upon a motion for dissolution, will be binding upon the examiner in charge of interferences unless reversed or modified on appeal. Unless appeal be taken within the time limited for appeal, the examiner in charge of trade-marks will return the files and papers with his decision to the examiner in charge of interferences.

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- sub. p. 4.* 51. Any person who believes he would be damaged by the registration of a mark may oppose the same by filing, in duplicate, a written notice of opposition (see Form 12, page 41), stating the grounds therefor, within thirty days after the publication (see Rule 40) of the mark sought to be registered, which notice of opposition shall be accompanied by the fee required by law, and shall be verified by the person filing the same, before one of the officers mentioned in section 2 of the act of February 20, 1905. (See Rule 34.) <sup>⊕ addition</sup>

<sup>Act of Feb. 20, 1905,  
sec. 13.</sup> 52. Any person, deeming himself to be injured by the registration of a trade-mark in the Patent Office, may, at any time, make application (see Form 13, page 42) to the Commissioner to cancel the registration thereof. Such application shall be filed in duplicate, shall state the grounds for cancellation, and shall be verified by the person filing the same, before one of the officers mentioned in section 2 of the act of February 20, 1905. (See Rule 34.)

<sup>Act of Feb. 20, 1905,  
sec. 13.</sup> 53. If it shall appear, after a hearing before the examiner of interferences, that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the examiner in charge of interferences shall so decide, the Commissioner shall cancel the registration of the mark, unless appeal be taken within the limit fixed.

54. In cases of opposition, and of applications for cancellation, the

examiner in charge of trade-marks shall forward the files and papers to the examiner in charge of interferences, who shall give notice thereof to the applicant or registrant. The applicant or registrant must make answer at such time, not less than thirty days from the date of the notice, as shall be fixed by the examiner in charge of interferences.

55. The proceedings, on oppositions, and on applications for cancellation, shall follow, as nearly as practicable, the practice, in interferences between applications for patents.

#### APPEALS.

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*4.* 56. From an adverse decision of the examiner in charge of trade-marks upon an applicant's right to register a trade-mark, or to renew the registration of a trade-mark, or from a decision of the examiner in charge of interferences, an appeal may be taken to the Commissioner in person, upon payment of the fee required by law. *Added*

57. From the adverse decision of the Commissioner of Patents upon the right of an applicant to register a trade-mark, or to renew the registration of a trade-mark, or from the decision of the Commissioner in cases of interference, opposition, or cancellation, an appeal may be taken to the Court of Appeals of the District of Columbia in the manner prescribed by the rules of that court.

#### ISSUE, DATE, AND DURATION OF CERTIFICATES.

58. When the requirements of the law and of the rules have been complied with, and the Office has adjudged a trade-mark registrable, a certificate will be issued, signed by the Commissioner, under the seal of the Patent Office, to the effect that the applicant has complied with the law and that he is entitled to registration of his trade-mark. The certificate shall state the date on which the application for registration was received in the Patent Office. Attached to the certificate will be a photolithographed copy of the drawing of the trade-mark and a printed copy of the statement and of the declaration.

59. A certificate of registration shall remain in force twenty years from its date, except that, in case a trade-mark be previously registered in a foreign country, such certificate shall cease to be in force on the day on which the trade-mark ceases to be protected in such foreign country, and shall, in no case, remain in force more than twenty years, unless renewed.

60. A certificate of registration may be, from time to time, renewed for like periods on payment of the renewal fees Act of Feb. 20, 1905, secs. 12 and 14. required, upon request by the registrant, his legal representatives, or transferees of record in the Patent Office, and such request may be made at any time not more than six months prior to the expiration of the period for which the certificate of registration was issued or renewed.

61. Certificates of registration in force on the 1st day of April, 1905, shall remain in force for the periods for which they Act of Feb. 20, 1905, sec. 12. were issued, and shall be renewable on the same conditions and for the same periods as certificates issued under the provisions of the act of February 20, 1905, and, when so renewed, shall have the same force and effect as certificates issued thereunder.

62. A certificate of registration shall not be issued to an applicant located in a foreign country for any trade-mark, for Act of Feb. 20, 1905, sec. 4. registration of which he has filed an application in such foreign country, until such mark has been actually registered by him in the country in which he is located.

#### ASSIGNMENTS.

63. Every registered trade-mark and every mark for the registration of which application has been made, together Act of Feb. 20, 1905, sec. 10. with the application for registration thereof, shall be assignable in connection with the good-will of the business in which the mark is used. Such assignment must be by an instrument in writing and duly acknowledged according to the laws of the country or State in which the same is executed. Provision is made for recording such assignments in the Patent Office; but no such assignment will be recorded unless it is in the English language, nor unless an application for the registration of the mark shall have been first filed in the Patent Office, and such assignment must identify the application by serial number and date of filing, or, when the mark has been registered, by the certificate number and the date thereof. No particular form of assignment is prescribed.

64. An assignment shall be void as against any subsequent purchaser for a valuable consideration, without notice, unless it Act of Feb. 20, 1905, sec. 10. be recorded in the Patent Office within three months from the date thereof.

65. The certificate of registration may be issued to the assignee of the applicant, but the assignment must first be entered of record in the Patent Office. Act of Feb. 20, 1905, sec. 11.

## COPIES AND PUBLICATIONS.

66. After a trade-mark has been registered, printed copies of the statement and declaration in each case, with a photolithographed copy of the drawing of the trade-mark, may be furnished by the Office upon the payment of the fee. (See Rule 69.)

67. An order for a copy of an assignment must give the liber and page of the record, as well as the name of the applicant; otherwise an extra charge will be made for the time consumed in making a search for such assignment.

68. The Official Gazette of the Patent Office will contain a list of all trade-marks registered, giving, in each case, a statement of the goods to which the trade-mark is applied, the name and address of the applicant, the date of filing and serial number of the application, and the date of the publication of the trade-mark in the Official Gazette.

## FEES.

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*a new Rule*  
*Supp.*  
*to p. 5-*

*see new Rule in supplement*

69. On filing each original application for the registration of a trade-mark	\$10. 00
On filing each application for renewal of the registration of a trade-mark	10. 00
On filing notice of opposition to the registration of a trade-mark	10. 00
On appeal from the examiner in charge of trade-marks to the Commissioner of Patents	15. 00
On appeal from the decision of the examiner in charge of interferences, awarding ownership of a trade-mark or cancelling the registration of a trade-mark, to the Commissioner of Patents	15. 00
For manuscript copies, for every 100 words or fraction thereof	. 10
For recording every assignment, agreement, power of attorney, or other paper, of 300 words or less	1. 00
For recording every assignment, agreement, power of attorney, or other paper of more than 300 words, and less than 1,000 words	2. 00
For recording every assignment, agreement, power of attorney, or other paper of more than 1,000 words	3. 00
For abstracts of title:	
For the certificate of search	1. 00
For each brief from the digest of assignments	. 20
For searching titles or records, one hour or less	. 50
Each additional hour or fraction thereof	. 50



For a single printed copy of statement, declaration, and drawing .....	\$0. 05
If certified, for the grant, additional .....	. 50
For the certificate .....	. 25

70. Money required for office fees may be paid to the Commissioner of Patents, or to the Treasurer, or to any of the assistant treasurers of the United States, or to

Rev. Stat., 4985.

any of the depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose, and such officer shall give the depositor a receipt or certificate of deposit therefor, which shall be transmitted to the Patent Office. When this can not be done without inconvenience, the money may be remitted by mail, and, in every such case, the letter should state the exact amount inclosed. All money orders, drafts, and checks should be made payable to the "Commissioner of Patents."

71. ~~All money sent by mail to the Patent Office will be at the risk of the sender. All payments to the Office must be made in specie, Treasury notes, national bank notes, certificates of deposit, money orders, or certified checks. Letters containing money should be registered.~~

#### REPAYMENT OF MONEY.

72. Money paid by actual mistake, such as a payment in excess, or when not required by law, or by neglect or misinformation on the part of the Office, will be refunded; but a mere change of purpose after the payment of money, as when a party desires to withdraw his application for the registration of a trade-mark, or to withdraw an appeal, will not entitle a party to demand such a return.

Rev. Stat., 4986; act of Feb 20, 1905, sec. 15.

#### NOTICE OF REGISTRATION.

73. It shall be the duty of the registrant to give notice to the public that a trade-mark is registered, either by affixing thereon the words "Registered in U. S. Patent Office," or "Reg. U. S. Pat. Off.," or, when from the character and size of the trade-mark, or from its manner of attachment to the article to which it is appropriated, this can not be done, then by affixing a label containing a like notice to the package or receptacle wherein the article or articles are inclosed; otherwise, on a suit for infringement, no damages shall be recovered except on proof that the defendant was duly notified of infringement, and continued the same after such notice.

Act of Feb. 20, 1905, sec. 28.

#### AMENDMENTS OF THE RULES.

74. All amendments of the foregoing rules will be published in the Official Gazette.

## QUESTIONS NOT SPECIFICALLY PROVIDED FOR.

75. All cases not specifically defined and provided for in these rules will be decided in accordance with the merits of each case under the authority of the Commissioner, and such decision will be communicated to the interested parties in writing.

FREDERICK I. ALLEN,  
Commissioner of Patents.

DEPARTMENT OF THE INTERIOR.

Approved, November 16, 1905.

E. A. HITCHCOCK,  
Secretary.

## FORMS.

The following forms illustrate the manner of preparing papers for applications for registration of trade-marks. Applicants will find their business facilitated by following them closely.

## (1) PETITION.

*To the Commissioner of Patents:*

The undersigned presents herewith a drawing and five *specimens* (Or facsimiles) of his trade-mark, and requests that the same, together with the accompanying statement and declaration, may be registered in the United States Patent Office in accordance with the law in such cases made and provided.

Dated *June 15, 1906*.  
(Date of execution.)

JOHN DOE.  
(Signature of applicant.)

## (2) STATEMENT FOR AN INDIVIDUAL.

To all whom it may concern:

Be it known that I, *John Doe*, a citizen of the United States of America, residing at *Philadelphia*, county of *Philadelphia*, State of *Pennsylvania*, and doing business at *No. 1300 Chestnut street*, in said city, have adopted for my use the trade-mark shown in the accompanying drawing, *the triangle being printed in red, for canned fruits and vegetables*, in class No. *50*, *Foods not otherwise classified*.  
(Name of applicant.) (Citizenship of applicant.)  
(Applicant's residence.)  
(Business address.)  
(Description of colors not shown in the drawing.)<sup>a</sup> (Particular description of goods.) (Number and title of class—see classification.)

The trade-mark has been continuously used in my business (and in the business of my predecessor, *Richard Roe*,<sup>b</sup>) since *February 1, 1899*.  
(Name of predecessor, if any.) (Earliest date of use.)

The trade-mark is applied or affixed to the goods, or to the packages containing the same, by *placing thereon a printed label on which the trade-mark is shown*.  
(Or state other mode or modes of application.)

JOHN DOE.  
(Signature of applicant.)  
(First name must be given in full.)

<sup>a</sup> If colors do not form a material feature of the mark, no description will be permitted.

<sup>b</sup> If applicant has had no predecessors, omit this clause.

## (3) DECLARATION FOR AN INDIVIDUAL.

State of *Pennsylvania*, }  
 County of *Philadelphia*, } ss:

*John Doe*, being duly sworn, deposes and says that he is the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes himself to be the owner of the trade-mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trade-mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trade-mark is used by him in commerce among the several States of the United States (and between the United States and foreign nations or Indian tribes, and particularly with *England and Germany*<sup>a</sup>); that the drawing presented truly represents the trade-mark sought to be registered; and that the *specimens* show the trade-mark as actually used upon the goods.

JOHN DOE.  
 (Signature of applicant)

Subscribed and sworn to before me, a *notary public*, this *15th* day of *June, 1906*.  
 (Official title) (Date of execution.)

(L. S.)

RICHARD JONES,  
*Notary Public*.  
 (Official title.)

## (4) STATEMENT FOR A FIRM.

To all whom it may concern:

Be it known that we, *John Doe & Company*, a firm domiciled in *New York, county of New York, State of New York*, doing business at *No. 36 Fulton street*, in said city, and composed of the following members, *John Doe, Richard Roe, and Henry Poe*, citizens of the United States of America, have adopted for our use the trade-mark shown in the accompanying drawing, *the cross being printed in red*, for surgical bandages and antiseptic dressings, in class No. 64, *Medical and surgical apparatus, appliances, and instruments*.

The trade-mark has been continuously used in our business (and in the business of our predecessors, *Doe & Roe*,<sup>c</sup>) since *January 1, 1902*.

<sup>a</sup> If applicant does not have commerce with foreign nations or Indian tribes, this clause should be omitted.

<sup>b</sup> If colors do not form a material feature of the mark, no description will be permitted.

<sup>c</sup> If applicant has had no predecessors, omit this clause.

The trade-mark is applied or affixed to the goods, or to the packages containing the same, by *placing thereon a printed label on which the trade-mark is shown.*  
(Or state other mode or modes of application)

JOHN DOE & COMPANY.

(Firm name)

By RICHARD ROE,

(Signature of a member of the firm)

*A Member of the Firm.*

(5) DECLARATION FOR A FIRM.

State of *Ohio*. }  
 County of *Hamilton*, } ss:

*Richard Roe*, being duly sworn, deposes and says that he is a member  
(Name of affiant.)

of the firm, the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes said firm is the owner of the trade-mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trade-mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trade-mark is used by said firm in commerce among the several States of the United States (and between the United States and foreign nations or Indian tribes, and particularly with *France and Spain*<sup>a</sup>); that the drawing presented truly represents the  
(Names of foreign countries or Indian tribes.)

trade-mark sought to be registered; and that the *specimens* show the  
(Or facsimiles.)  
 trade-mark as actually used upon the goods.

RICHARD ROE.

(Signature of affiant.)

Subscribed and sworn to before me, a *notary public*, this *15th* day  
(Official title.)

of *January*, 1906.

(Date of execution.)

[L. S.]

HARRY BROWN,

*Notary Public.*

(Official title.)

(6) STATEMENT FOR A CORPORATION OR ASSOCIATION.

To all whom it may concern:

Be it known that *Union Manufacturing Company*, a corporation<sup>b</sup>  
(Name of applicant.)  
 duly organized under the laws of *the State of Maine*, and located in  
(State or country under the laws of which organized.)  
*the city of Brunswick, county of Cumberland, in said State*, and doing  
(Location of corporation.)  
 business at *No. 326 Atlantic avenue, in the city of Boston, State of*  
(Business address.)  
*Massachusetts*, has adopted for its use the trade-mark shown in the accompanying drawing, *the circle being printed in green, for arc and*  
(Description of colors not shown in the drawing.) (Particular

<sup>a</sup> If applicant does not have commerce with foreign nations or Indian tribes, this clause should be omitted.

<sup>b</sup> If the applicant be an association, the word "association" should be substituted for the word "corporation."

<sup>c</sup> If colors do not form a material feature of the mark, no description will be permitted.

*incandescent electric lamps and electric heaters, in Class No. 21, Electro-  
description of goods.)*

*trical apparatus, machines, and supplies.*

(Number and title of class. See classification.)

The trade-mark has been continuously used in the business of said  
*corporation<sup>a</sup> (and in the business of its predecessors, John Doe Com-*

(Name of predecessors, if any.)

*pany,<sup>b</sup> since January 30, 1898.*

(Give earliest date of use.)

The trade-mark is applied or affixed to the goods, or to the packages  
containing the same, by *placing thereon a printed label on which the*

(Or state other mode or modes of

*trade-mark is shown.*

application.)

UNION MANUFACTURING COMPANY,

(Name of applicant.)

By JOHN E. SMITH,

(Signature of officer.)

*Secretary.*

(Official title.)

### (7) DECLARATION FOR A CORPORATION OR ASSOCIATION.

State of *Missouri,* }  
County of *St. Louis.* } ss:

*Edward C. Carter,* being duly sworn, deposes and says that he is

(Name of affiant.)

the *secretary* of the *corporation,<sup>a</sup>* the applicant named in the foregoing

(Official title.)

statement; that he believes the foregoing statement is true;  
that he believes said *corporation<sup>a</sup>* is the owner of the trade-mark  
sought to be registered; that no other person, firm, corporation,  
or association, to the best of his knowledge and belief, has the right  
to use said trade-mark, either in the identical form or in any such  
near resemblance thereto as might be calculated to deceive; that said  
trade-mark is used by said *corporation<sup>a</sup>* in commerce among the several  
States of the United States (and between the United States and foreign  
nations or Indian tribes and particularly with *Italy and France<sup>c</sup>*); that

(Names of foreign nations  
or Indian tribes.)

the drawing presented truly represents the trade-mark sought to be  
registered; and that the *specimens* show the trade-mark as actually

(Or facsimiles.)

used upon the goods.

EDWARD C. CARTER.

(Signature of affiant.)

Subscribed and sworn to before me, a *notary public,* this *20th* day of

(Official title.)

(Date of

*February, 1906.*

execution.)

[L. S.]

WILLIAM GRANE,

*Notary Public.*

(Official title.)

<sup>a</sup> If applicant be an association, the word "association" should be substituted for the word "corporation."

<sup>b</sup> If applicant has had no predecessors, omit this clause.

<sup>c</sup> If the applicant does not have commerce with foreign nations or Indian tribes, this clause should be omitted.

*The size of the sheet must be  
exactly 10x15 inches. See rule 36 (2).*

*This space must be thirteen inches.*



*Proprietor.*

*By.*

*Attorney.*

*This space must be eight inches.*



(8) DECLARATION FOR APPLICANTS UNDER THE TEN-YEAR PROVISOR.<sup>a</sup>

State of *Connecticut*, }  
 County of *Fairfield*, } ss:

*Richard Roe*, being duly sworn, deposes and says that he is the  
 (Name of applicant.)  
 applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes himself to be the owner of the mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said mark is used by him in commerce among the several States of the United States (and between the United States and foreign nations, or Indian tribes, and particularly with *Russia and Turkey*<sup>b</sup>); that the  
 (Names of foreign nations or Indian tribes.)  
 drawing presented truly represents the mark sought to be registered; that the *specimens* show the mark as actually used upon the goods;  
 (Or facsimiles)  
 and that the mark has been in actual use as a trade-mark of the applicant (and applicant's predecessors from whom title was derived<sup>c</sup>) for ten years next preceding the passage of the act of February 20, 1905, and that, to the best of his knowledge and belief, such use has been exclusive.

RICHARD ROE.  
 (Signature of affiant.)

Subscribed and sworn to before me, a *notary public*, this *15th* day  
 (Official title.) (Date)  
 of *February*, 1906.  
 of execution.)

[L. S.]

CHARLES MASON,  
*Notary Public*.  
 (Official title.)

(9) DECLARATION FOR FOREIGNER.<sup>a</sup>

*United States Consulate*, }  
*London, England*, } ss:

*William E. Brown*, being duly sworn, deposes and says that he is  
 (Name of affiant.)  
 the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes himself to be the owner of the trade-mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trade-mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; (that said trade-mark has been registered in *England*, on *June 1, 1900*,  
 (Name of country.) (Date.)

<sup>a</sup> In case the applicant is a firm, corporation, or association, the declaration should be modified accordingly.

<sup>b</sup> If applicant does not have commerce with foreign nations or Indian tribes, this clause should be omitted.

<sup>c</sup> If applicant has had no predecessors, this clause should be omitted.



No. 49316;<sup>a</sup>) that the drawing presented truly represents the trade-  
(Number of registration.)  
 mark sought to be registered; and that the *specimens* show the trade-  
(Or facsimiles.)  
 mark as actually used upon the goods.

WILLIAM E. BROWN.  
(Signature of affiant.)

Subscribed and sworn to before me, a *notary public*, this 20th day  
(Official title.) (Date of  
 of January, 1900.  
execution.)  
 [SEAL.]

RICHARD JONES,  
*Notary Public.*  
(Official title.)

(10.) STATEMENT FOR AN INDIVIDUAL UNDER SECTION 3 OF THE ACT  
 OF MAY 4, 1906.<sup>b</sup>

To all whom it may concern:

Be it known that I, *Richard Roe*, a *subject of the King of Eng-*  
(Name of applicant.) (Citizenship of applicant.)  
*land*, residing at *London, England*, and doing business at *No. 26*  
(Applicant's residence.)  
*Threadneedle street, in said city*, and having a manufacturing establish-  
(Business address.)  
 ment at *Hartford, State of Connecticut*, have adopted for my use the  
 trade-mark shown in the accompanying drawing, *the triangle being*  
(Description of colors not  
*printed in blue*, for the following products of such manufacturing  
shown in the drawing.)  
 establishment, namely, *rubber vehicle tires and rubber boots and shoes*,  
(Particular description of goods.)  
 in Class No. 38, *Rubber and minor plastics not otherwise classified.*  
(Number and title of class. See classification.)

The trade-mark has been continuously used in my business, (and in  
*the business of my predecessor, John W. Brown<sup>a</sup>*), since *January 1, 1901*.  
(Name of predecessor, if any.) (Earliest date of use.)

The trade-mark is applied or affixed to the goods, or to the packages  
 containing the same, *by placing thereon a printed label on which the*  
(Or state other mode or modes of  
*trade-mark is shown.*  
application.)

RICHARD ROE.  
(Signature of applicant.)

(11) DECLARATION FOR FOREIGNERS UNDER SECTION 3 OF THE ACT  
 OF MAY 4, 1906.<sup>b</sup>

*United States Consulate,* {  
*London, England,* } ss:

*Richard Roe*, being duly sworn, deposes and says that he is the  
(Name of affiant.)  
 applicant named in the foregoing statement; that he believes the fore

<sup>a</sup> If the trade-mark has not yet been registered, but an application for registra-  
 tion has been filed in the country where applicant resides or is located, this clause  
 should be omitted and the following substituted therefor:

"that an application for registration of said trade-mark was filed by him on the  
*20th day of January, 1900, in England;*"  
(Date of filing.) (Name of country.)

<sup>b</sup> In case applicant be a firm, corporation, or association, the statement should be  
 modified accordingly.

<sup>c</sup> If colors do not form a material feature of the mark, no description will be per-  
 mitted.

<sup>d</sup> If applicant has had no predecessor, omit this clause.

going statement is true; that he believes himself to be the owner of the trade-mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trade-mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trade-mark is used by him in commerce among the several States of the United States (and between the United States and foreign nations or Indian tribes, and particularly with *England and Ger-*  
(Names of foreign countries or Indian tribes.)  
*many*<sup>a</sup>); that the drawing presented truly represents the trade-mark sought to be registered; that the *specimens* show the trade-mark as  
(Or facsimiles)  
 actually used upon the goods; that his manufacturing establishment is located at *Hartford, State of Connecticut*; and that the goods claimed  
(Location of manufacturing establishment.)  
 in this application are the products of such establishment.

RICHARD ROE.  
(Signature of affiant.)

Subscribed and sworn to before me, a *notary public*, this *15th* day of *June, 1906*.  
(Official title.) (Date of execution.)

[SEAL.]

RICHARD JONES,  
*Notary Public*.  
(Official title.)

## (12) NOTICE OF OPPOSITION.<sup>b</sup>

*To the Commissioner of Patents:*

In the matter of an application for the registration of a trade-mark for *sewing machines*, Serial No. 1906, *filed April 15, 1906*, by *John Doe*,  
(Particular goods.) (Number and date of application.) (Name of applicant.)  
 of *San Francisco, Cal., I, Richard Roe, residing at No. 12 Clarke*  
(Location or residence of applicant.) (Name of party opposing.) (Residence or location of the party opposing.)  
 street, city of Chicago, State of Illinois, hereby give notice of my intention to oppose the registration of said trade-mark which was published on page 1746, Vol. 120, No. 13, of the Official Gazette of June 13, 1906.  
(Page, volume, number, and date of the Official Gazette.)

The grounds for opposition are as follows:  
(Here state the grounds for opposing registration.)

Dated this *23d* day of *June, 1906*.  
(Date of execution.)

RICHARD ROE.  
(Signature of opposing party.)

State of *Illinois*, } ss:  
 County of *Cook*, }

On this *23d* day of *June, 1906*, before me, a *notary public*, in and  
(Date of execution.) (Official title.)  
 for *Cook County, State of Illinois*, personally appeared *Richard Roe*,  
(Name of party opposing.)  
 who, being by me duly *sworn*, deposes and says that he has read the  
(Or affirmed.)  
 foregoing notice of opposition, and knows the contents thereof, and that the same is true of his own knowledge, except as to the matters

<sup>a</sup> If applicant does not have commerce with foreign nations or Indian tribes this clause should be omitted.

<sup>b</sup> If the opposing party be a firm, corporation, or association, the notice of opposition should be modified accordingly.

therein stated on information and belief, and as to those matters he believes it to be true.

[L. s.]

CHARLES KINGMAN,  
Notary Public.  
(Official title.)

(13) APPLICATION FOR CANCELLATION OF TRADE-MARK.<sup>a</sup>

To the Commissioner of Patents:

In the matter of trade-mark No. 1898, registered May 23, 1906,  
(Number of registration.) (Date of registration.)  
by Richard Roe, of the city of Portland, county of Cumberland, state  
(Name of registrant.) (Residence or location of registrant.)  
of Maine, I, John Doe, residing at No. 113 Fayette street, in the city of  
(Name of party applying for cancellation.) (Residence or location of the  
party applying for cancellation.)  
Baltimore, State of Maryland, hereby apply for the cancellation of  
the registration of the above-noted trade-mark.

The grounds for cancellation are as follows:

(Here state the grounds for cancellation.)

JOHN DOE.  
(Signature of party applying for cancellation.)

State of Maryland, }  
County of Baltimore City, } ss:

On this 26th day of June, 1906, before me, a notary public, in and  
(Date of execution.) (Official title.)  
for Baltimore City County, State of Maryland, personally appeared  
John Doe, who, being by me duly sworn, deposes and says that he has  
(Name of party applying for cancellation.) (Or affirmed)  
read the foregoing application for cancellation, and knows the con-  
tents thereof, and that the same is true of his own knowledge, except  
as to the matters therein stated on information and belief, and as to  
those matters he believes it to be true.

[L. s.]

JOHN JONES,  
Notary Public.  
(Official title.)

---

<sup>a</sup> If the party applying for cancellation be a firm, corporation, or association, the application for cancellation should be modified accordingly.

CLASSIFICATION OF MERCHANDISE UNDER THE ACT OF  
MAY 4, 1906.

DEPARTMENT OF THE INTERIOR,  
UNITED STATES PATENT OFFICE,  
Washington, D. C., December 14, 1907.

The classes of merchandise contained in the following schedule are approved and will take effect upon the 18th day of March, 1908, with respect to all applications registered after that date, in lieu of the classification of merchandise established July 2, 1906, under the provisions of section 2 of the act of May 4, 1906, entitled "An act to amend the laws of the United States relating to the registration of trade-marks."

EDWARD B. MOORE, *Commissioner*.

1. Raw or partly prepared materials.
2. Receptacles.
3. Baggage, horse equipments, portfolios, and pocketbooks.
4. Abrasive, detergent, and polishing materials.
5. Adhesives.
6. Chemicals, medicines, and pharmaceutical preparations.
7. Cordage.
8. Smokers' articles, not including tobacco products.
9. Explosives, firearms, equipments, and projectiles.
10. Fertilizers.
11. Inks and inking materials.
12. ~~Masonry materials.~~ *Construction Materials (O.G. 140-259)*
13. Hardware and plumbing and steam-fitting supplies.
14. Metals and metal castings and forgings.
15. Oils and greases ~~not intended for food.~~ *(O.G. 140-259)*
16. Paints and painters' materials, ~~not including oils and polishes.~~ *(O.G. 140-259)*
17. Tobacco products.
18. ~~Agricultural and dairy machinery and parts thereof.~~ *(O.G. 140-259)*
19. Vehicles, not including engines.
20. Linoleum and oiled cloth.
21. Electrical apparatus, machines, and supplies.
22. Games, toys, and sporting goods.
23. Cutlery, machinery, and tools, and parts thereof.
24. Laundry appliances and machines.
25. Locks and safes.
26. Measuring and scientific appliances.
27. Horological instruments.
28. Jewelry and precious-metal ware.
29. Brooms, brushes, and dusters.
30. Crockery, earthenware, and porcelain.
31. Filters and refrigerators.
32. Furniture and upholstery.
33. Glassware.
34. Heating, lighting, and ventilating apparatus, not including electrical apparatus.
35. Belting, hose, machinery packing, and nonmetallic tires.
36. Musical instruments and supplies.
37. Paper and stationery.
38. ~~Publications.~~ *Prints and Publications (O.G. 140-259)*
39. Clothing.
40. Fancy goods, furnishings, and notions.
41. Canes, parasols, and umbrellas.
42. Knitted, netted, and textile fabrics.
43. Thread and yarn.
44. Dental, medical, and surgical appliances.
45. Beverages, nonalcoholic.
46. Foods and ingredients of foods.
47. Wines, except medicated.
48. Malt extracts and liquors.
49. Distilled alcoholic liquors.
50. Merchandise not otherwise classified.



## APPENDIX.

### TRADE-MARKS.

[1905—Department Circular No. 40—Division of Customs.]

TREASURY DEPARTMENT,  
OFFICE OF THE SECRETARY,  
*Washington, March 21, 1905.*

*To collectors of customs and others concerned:*

The attention of officers of the customs and others is invited to the following provisions of section 27 of the act approved February 20, 1905, effective April 1, 1905:

"SECTION 27. That no article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trade-mark registered in accordance with the provisions of this act, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any custom-house of the United States; and, in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader, and any foreign manufacturer or trader, who is entitled under the provisions of a treaty, convention, declaration, or agreement between the United States and any foreign country to the advantages afforded by law to citizens of the United States in respect to trade-marks and commercial names, may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trade-mark, issued in accordance with the provisions of this act, to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department facsimiles of his name, the name of the locality in which his goods are manufactured, or of his registered trade-mark; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs."

The provisions of this section give to manufacturers and traders located in foreign countries which, by treaty stipulations, give similar privileges to the United States, the same advantages as are given to domestic manufacturers and traders. The act does not affect names or trade-marks heretofore recorded in the Treasury Department, and as to them the protection granted so far as concerns prohibition of

importation will continue. Nor does the act appear to make it compulsory on the part of domestic manufacturers or traders, or foreign manufacturers or traders, to register names (not trade-marks) with the Commissioner of Patents, in order to prevent illegal importations.

Domestic manufacturers and traders, and foreign manufacturers and traders, to avail themselves of the privileges of the act, so far as concerns trade-marks, are required to register their trade-marks with the Commissioner of Patents before the Treasury Department can act.

Applications for recording the names and trade-marks in this Department under section 27 will state the name of the owner, his residence, and the locality in which his goods are manufactured, and in the case of trade-marks should be accompanied with a certified copy of the certificate of registration of his trade-mark issued in accordance with the provisions of the act and the names of the ports to which facsimiles should be sent. In the case of the name of a domestic manufacture, manufacturer, or trader (not registered as a trade-mark in the Patent Office) the application must be accompanied by the proper proof of ownership and proof as to the country or locality in which his goods are manufactured, which must consist of the affidavit of the owner or one of the owners, certified by an officer entitled to administer oaths and having a seal.

On the receipt by a customs officer of any such facsimiles, with information from the Department that they have been recorded therein, he will properly record and file them and will exercise care to prevent the entry at the custom-house of any article of foreign manufacture copying or simulating such mark.

No fees are charged for recording trade-marks in the Treasury Department and custom-houses.

A sufficient number of facsimiles should be forwarded to enable the Department to send one copy to each port named in the application, with ten additional copies for the files of the Department.

Especial attention is invited to the provision in said section prohibiting the entry of articles "which shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured," and collectors and other officers of the customs are instructed to use due diligence to prevent violations of this provision.

The provisions of the act also apply to Porto Rico, the Philippine Islands, Hawaii, and any other territory under the jurisdiction and control of the United States.

LESLIE M. SHAW, *Secretary.*

**AN ACT To incorporate the American National Red Cross.**

\* \* \* \* \*

SEC. 4. That from and after the passage of this Act it shall be unlawful for any person within the jurisdiction of the United States to falsely and fraudulently hold himself out as, or represent or pretend himself to be, a member of, or an agent for, the American National Red Cross, for the purpose of soliciting, collecting, or receiving money or material; or for any person to wear or display the sign of the Red Cross, or any insignia colored in imitation thereof for the fraudulent purpose of inducing the belief that he is a member of, or an agent for, the American National Red Cross. Nor shall it be lawful for any person or corporation, other than the Red Cross of America, not now lawfully entitled to use the sign of the Red Cross, hereafter to use such sign or any insignia colored in imitation thereof for the purposes of trade or as an advertisement to induce the sale of any article whatsoever. If any person violates the provisions of this section, he shall be guilty of a misdemeanor and shall be liable to a fine of not less than one nor more than five hundred dollars, or imprisonment for a term not exceeding one year, or both, for each and every offense. The fine so collected shall be paid to the American National Red Cross.

\* \* \* \* \*

Approved, January 5, 1905.





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## CHANGES IN TRADE-MARK RULES.

DEPARTMENT OF THE INTERIOR,  
UNITED STATES PATENT OFFICE,  
*Washington, D. C., June 12, 1908.*

The following changes in the Trade-Mark Rules of this Office, subsequent to the revised edition of August 1, 1906, have been made with the approval of the Secretary of the Interior.

EDWARD B. MOORE,  
*Commissioner.*

Rule 11 is canceled and the following substituted in lieu thereof:

11. An applicant or an assignee may prosecute his own case, but he is advised, unless familiar with such matters, to employ a competent patent attorney. The Office can not aid in the selection of an attorney.

A register of attorneys will be kept in this Office, on which will be entered the names of all persons entitled to represent applicants before the Patent Office in the presentation and prosecution of applications for patent. The names of persons in the following classes will, upon their written request, be entered upon this register:

(a) Any attorney at law who is in good standing in any court of record in the United States or any of the States or Territories thereof and who shall furnish a certificate of the clerk of such United States, State, or Territorial court, duly authenticated under the seal of the court, that he is an attorney in good standing.

(b) Any person not an attorney at law who is a citizen or resident of the United States and who shall file proof to the satisfaction of the Commissioner that such person is of good moral character and of good repute and possessed of the necessary legal and technical qualifications to enable him to render applicants for patents valuable service and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office.

(c) Any foreign patent attorney not a resident of the United States, who is a citizen or subject of a country granting the same reciprocal rights to citizens of the United States, who shall file proof to the satisfaction of the Commissioner that he is registered and in good standing before the Patent Office of the country of which he is a citizen or subject, and is possessed of the qualifications stated in paragraph (b).

No foreign patent attorney will be recognized in any application filed after June 30, 1908, unless entitled to registration under the provisions of this rule.

(d) Any firm will be registered which shall show that the individual members composing such firm are each and all registered under the provisions of the preceding sections.

The Commissioner may require proof of qualifications other than those specified in paragraph (a) and reserves the right to decline to recognize any attorney, agent, or other person applying for registration under this rule.



~~Any person or firm not registered and not entitled to be recognized under this rule as an attorney or agent to represent applicants generally may, upon a showing of circumstances which render it necessary or justifiable, be recognized by the Commissioner to prosecute as attorney or agent certain specified application or applications, but this limited recognition shall not extend further than the application or applications named.~~

~~No person not registered or entitled to recognition as above provided will be permitted to prosecute applications before the Patent Office.~~

In Rule 19 the words "or which," line 13, have been canceled and the following inserted in lieu thereof:

or which consists of or comprises any design or picture that has been adopted by any fraternal society as its emblem, unless it shall be shown to the satisfaction of the Commissioner of Patents that the mark was adopted and used as a trade-mark by applicant or applicant's predecessors, from whom title is derived, at a date prior to the date of its adoption by such fraternal society as its emblem, or which trade-mark

The rule so amended reads as follows:

19. No trade-mark will be registered to an owner domiciled within the territory of the United States unless it shall be made to appear that the same is used as such by said owner in commerce among the several States, or between the United States and some foreign nation or Indian tribe: no trade-mark, except as provided by section 3 of the act of May 4, 1906, will be registered to an owner residing in or located in a foreign country unless said country, by treaty, convention, or law, affords similar privileges to the citizens of the United States: no trade-mark will be registered which consists of or comprises immoral or scandalous matter, or which consists of or comprises the flag or coat of arms or other insignia of the United States, or any simulation thereof, or of any State or municipality, or of any foreign nation, or which consists of or comprises any design or picture that has been adopted by any fraternal society as its emblem, unless it shall be shown to the satisfaction of the Commissioner of Patents that the mark was adopted and used as a trade-mark by the applicant or applicant's predecessors, from whom title is derived, at a date prior to the date of its adoption by such fraternal society as its emblem, or which trade-mark is identical with a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, or which so nearly resembles a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers; or which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term: no portrait of a living individual will be registered as a trade-mark, except by the consent of such individual, evidenced by an instrument in writing: and no trade-mark will be registered which is used in unlawful business, or upon any article injurious in itself, or which has been used with the design of deceiving the public in the purchase of merchandise, or which has been abandoned.

Rule 34 is amended by changing the period after the word "made," in line 11 thereof, to a comma, and inserting thereafter the following:

except that no acknowledgment may be taken before any attorney appearing in the case. When the person before whom the declaration is made is not provided with a seal, his official character shall be established by competent evidence, as by a certificate of a clerk of a court of record, or other proper officer having a seal.

so that the rule as amended shall read:

34. The declaration may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by the certificate of a diplomatic or consular officer of the United States, the declaration being attested in all cases, in this and other countries, by the proper official seal of the officer before whom the same is made, except that no acknowledgment may be taken before any attorney appearing in the case. When the person before whom the declaration is made is not provided with a seal, his official character shall be established by competent evidence, as by a certificate of a clerk of a court of record, or other proper officer having a seal.

Section 6 of Rule 36 is amended by canceling the words "They should not be rolled or folded," in lines 2 and 3, and by changing the period after the word "board," in line 2, to a comma and by inserting thereafter the following:

or should be rolled for transmission in a suitable mailing tube. They should never be folded.

so that section 6 of the rule as amended shall read:

(6) Drawings transmitted to the Office should be sent flat, protected by a sheet of heavy binder's board, or should be rolled for transmission in a suitable mailing tube. They should never be folded.

Rule 49 is amended by inserting after the word "mark," in line 4 thereof, the words *should contain a full statement of the grounds relied upon, and,* and by canceling the word "twentieth," in line 5 of said rule, and substituting therefor the word *thirtieth*, and by inserting after line 16 the following paragraph:

When the motion has been decided by the Examiner in charge of trade-marks, the files and papers, with his decision, will be sent at once to the docket clerk.

so that the rule as amended shall read:

49. Motions to dissolve an interference upon the ground that no interference in fact exists, or that there has been such irregularity in declaring the same as will preclude a proper determination of the question of *priority*, or which deny the registrability of an applicant's mark, should contain a full statement of the grounds relied upon, and should, if possible, be made not later than the thirtieth day after the notices of the interference have been mailed. Such motions, and all motions of a similar character, should be accompanied by a motion to transmit the same to the Examiner in charge of trade-marks, and such motion to trans-

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mit will be noticed for hearing upon a day certain before the Examiner in charge of interferences. When in proper form, the motion presented will, with the files and papers, be transmitted, by the Examiner in charge of interferences, for determination, to the Examiner in charge of trade-marks, who will thereupon fix a day certain when said motion will be heard before him upon the merits, and give notice thereof to all the parties. If a stay of proceedings be desired, a motion therefor should accompany the motion for transmission.

When the motion has been decided by the Examiner in charge of trade-marks, the files and papers, with his decision, will be sent at once to the docket clerk.

Motions to shift the burden of proof should be made before, and will be determined by, the Examiner in charge of interferences. No appeal from the decision on such motion will be entertained, but the matter may be reviewed on appeal from the final decision upon the question of priority.

The following has been added to Rule 51:

An opposition may be filed by a duly authorized attorney, but said opposition shall be null and void unless copies, in duplicate, be furnished, duly verified by the opposer, within a reasonable time after such filing.

The rule so amended reads as follows:

51. Any person who believes he would be damaged by the registration of a mark may oppose the same by filing, in duplicate, a written notice of opposition, stating the grounds therefor, within thirty days after the publication of the mark sought to be registered, which notice of opposition shall be accompanied by the fee required by law, and shall be verified by the person filing the same, before one of the officers mentioned in section 2 of the act of February 20, 1905. An opposition may be filed by a duly authorized attorney, but said opposition shall be null and void unless ~~copies, in duplicate, be furnished~~, duly verified by the opposer, within a reasonable time after such filing. (*dup. copy required*)

The following has been added to Rule 56:

Upon receiving a petition stating concisely and clearly any proper question which has been acted upon by the Examiner in charge of trade-marks and which does not involve the merits of the trade-mark claimed, the refusal of registration of the trade-mark, or a requirement for division, and also stating the facts involved and the point or points to be reviewed, an order will be made fixing a time for hearing such petition by the Commissioner, and directing the Examiner to furnish a written statement of the grounds of his decision upon the matters averred in such petition within five days after being notified of the order fixing the day of hearing. The Examiner shall, at the time of making such statement, furnish a copy thereof to the petitioner. No fee is required for such a petition.

The rule so amended reads as follows:

56. From an adverse decision of the Examiner in charge of trade-marks upon an applicant's right to register a trade-mark, or to renew the registration of a trade-mark, or from the decision of the Examiner in charge of interferences, an appeal may be taken to the Commissioner in person, upon payment of the fee required by law.

Upon receiving a petition stating concisely and clearly any proper question which has been acted upon by the Examiner in charge of trade-marks and which does not involve the merits of the trade-mark claimed, the refusal of registration of the trade-mark, or a requirement for division, and also stating the facts involved and the point or points to be reviewed, an order will be made fix-

ing a time for hearing such petition by the Commissioner, and directing the Examiner to furnish a written statement of the grounds of his decision upon the matters averred in such petition within five days after being notified of the order fixing the day of hearing. The Examiner shall, at the time of making such statement, furnish a copy thereof to the petitioner. No fee is required for such a petition.

Rule 69 is canceled and the following substituted in lieu thereof:

69. On filing each original application for registration of a trade-mark..	\$10. 00
On filing each application for renewal of the registration of a trade-mark.....	10. 00
On filing notice of opposition to the registration of a trade-mark.....	10. 00
On appeal from the Examiner in charge of trade-marks to the Commissioner of Patents.....	15. 00
On appeal from the decision of the Examiner in charge of Interferences, awarding ownership of a trade-mark or canceling the registration of a trade-mark, to the Commissioner of Patents.....	15. 00
On appeal from the decision of the Examiner in charge of trade-marks, on a motion for the dissolution of an interference on the ground of non-interference in fact or non-registrability of a mark, to the Commissioner of Patents.....	15. 00
For manuscript copies, for every 100 words or fraction thereof.....	. 10
For recording every assignment, power of attorney, or other paper of three hundred words or under.....	1. 00
Of over three hundred and under one thousand words.....	2. 00
And for each additional thousand words or fraction thereof.....	1. 00
For abstracts of title:	
For the search, one hour or less, and certificate.....	1. 00
Each additional hour or fraction thereof.....	. 50
For each brief from the digest of assignments of two hundred words or less.....	. 20
Each additional hundred words or fraction thereof.....	. 10
For searching titles or records, one hour or less.....	. 50
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## AMENDMENT TO TRADE-MARK LAW.

[Public—No. 232.]

AN ACT To amend sections five and six of an Act entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same."

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That section five of the act entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same," approved February twentieth, nineteen hundred and five, be, and is hereby, amended to read as follows:

"SEC. 5. That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—

"(a) Consists of or comprises immoral or scandalous matter.

"(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or any simulation thereof, or of any State, or municipality, or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem. *Provided*, That trade-marks which are identical with a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers, shall not be registered: *Provided*, That no mark which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act: *Provided further*, That no portrait of a living individual may be registered as a trade-mark, except by the consent of such individual, evidenced by an instrument in writing: *And provided further*, That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States, or with Indian tribes, which was in actual and exclusive use as a trade-mark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of this Act." Feb. 20, 1905: *Provided further* \*

Sec. 2. That section six of said Act be, and the same is hereby, amended to read as follows:

"Sec. 6. That on the filing of an application for registration of a trade-mark which complies with the requirements of this Act, and the payment of the fees herein provided for, the Commissioner of Patents shall cause an examination thereof to be made; and if on such examination it shall appear that the applicant is entitled to have his trade-mark registered under the provisions of this Act, the Commissioner shall cause the mark to be published at least once in the OFFICIAL GAZETTE of the Patent Office. Any person who believes he would be damaged by the registration of a mark may oppose the same by filing notice of opposition, stating the grounds therefor, in the Patent Office within thirty days after the publication of the mark sought to be registered, which said notice of opposition shall be verified by the person filing the same before one of the officers mentioned in section two of this Act. An opposition may be filed by a duly-authorized attorney, but such opposition shall be null and void unless verified by the opposer within a reasonable time after such filing. If no notice of opposition is filed within said time, the Commissioner shall issue a certificate of registration therefor, as hereinafter provided for. If on examination an application is refused, the Commissioner shall notify the applicant, giving him his reasons therefor."

Approved, March 2, 1907.

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\* That nothing herein shall prevent the registration of a trade-mark otherwise registrable because of its being the name of the applicant or a person thereof.

O.G. 163-4  
Feb. 28, 1911  
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, or of any name, distinguishing mark, character, emblem, colors, flag, or banner adopted by any institution, organization, club, or society which was incorporated in any State in the United States prior to the date of the adoption and use by the applicant: PROVIDED, That said name, distinguishing mark, character, emblem, colors, flag, or banner was adopted and publicly used by said institution, organization, club, or society prior to the date of adoption and use by the applicant:









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